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Reputation as the Key Link Amongst Moral Rights, Prohibited Marks, and Geographical Indications

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A thesis submitted in partial fulfillment of the requirements for the Doctor of Philosophy degree in Law

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Abstract

Moral rights, prohibited marks, and geographical indications (GI) appear in Canadian intellectual property (IP) statutes and international IP instruments – but do not mirror the characteristics of the classic IP triad (patents, copyrights, and trademarks). The classic triad are alienable (tradeable, licensable, able to be transferred away by their owners). Moral rights, prohibited marks, and GI are inalienable (not able to be transferred to others by the persons entitled to them) and thus distinguishable from classic IP. This research demonstrates another characteristic setting moral rights, prohibited marks, and GI apart from classic IP: a common preoccupation with reputation or esteem.

The *Copyright Act*'s moral rights exist in performances and literary, dramatic, musical and artistic works, linking works and performances to their creators' identities (rights of paternity) and giving creators non-transferable rights to maintain their works' and performances' integrity. Listed in the *Trademarks Act*, prohibited marks are not to be used as trademarks, being reserved for designated persons, institutions, and governments to use.

Found in the *Trademarks Act*, GI are not trademarks but symbols linked to quality and reputation which indicate place of origin on certain types of products.

Protecting people's reputations is the tort of defamation's historic role, however, studying reputation in defamation is hampered by the continuing role of juries in Canadian civil and criminal defamation proceedings. Because Canadian jury deliberations are secret, even judges presiding over jury trials do not learn how juries use evidence when making findings involving reputation. The preponderance of Canadian

defamation decisions arise from jury trials and discuss reputation only in generalities and abstract terms. In the judge-alone trials studied, no more specific reputation findings were found than in jury trials. Theoretical work on reputation in defamation (including that of Robert C. Post), then, was found not transferable to moral rights, prohibited marks or GI. Analyzing reputation in defamation, therefore, is not helpful to understanding reputation across moral rights, prohibited marks, and GI. Nonetheless, examination of moral rights, prohibited marks, and GI themselves demonstrates reputation in the sense of esteem and uniquely distinguishes the set of moral rights, prohibited marks, and GI from classic IP.

Keywords: Reputation, Intellectual Property, Moral Rights, Prohibited Marks, Official Marks, Geographical Indications, Defamation, Paris Convention, Reputation.

Summary for Lay Audience

Copyright, trademark, and patent are classic intellectual property: tradeable, licensable, and transferable. As well as including copyright, Canada's *Copyright Act* includes moral rights, giving authors and performers rights to be named on works and performances, to insist on the integrity of works and performances, and to decide if works or performances can be used with products, services, causes or institutions. In addition to trademarks, Canada's *Trademarks Act* protects both prohibited marks (like the Red Cross or any country's flag) that Parliament designates as unavailable for trademark use, and geographical indications (names and symbols stemming from their place of origin protecting the quality and reputation of products). These three types of protection appeared much later than copyright, trademark, or patent. Not one of them is tradeable, licensable, or transferable, clearly distinguishing them from classic intellectual property, but do they form a unique set of their own? If they do, is their common characteristic 'reputation'? This research determined that reputation is involved in all three: in moral rights, in the concept of integrity; in prohibited marks, in the history of the marks' protection; in geographical indications, as one of the set of characteristics that can create a geographical indication.

Reputation in law is most consistently linked with the concept of reputation identified in the common law of defamation: can this 'reputation' be connected with that found in moral rights, prohibited marks and geographical indications? Exploring reputation in Canadian jurisprudence, this research shows the preponderance of jury trials in defamation, and the secrecy to which Canadian juries are bound, means reputation's

meaning in Canadian defamation jurisprudence is largely undiscoverable. In the more rare non-jury actions, judges did not link discussion on reputation to specific evidence. Asking whether legal theory scholarship about reputation in defamation could be linked to moral rights, prohibited marks or geographical indications led to the finding it could not. Nonetheless, exploring moral rights, prohibited marks, and geographical indications each in its own historical, international, and Canadian jurisprudential context led to the finding that reputation as ‘esteem’ links all three, creating a common set distinguished from classic intellectual property.

Acknowledgements

This doctoral dissertation emerged during a multitude of worldwide challenges. Yet, it would not be presented here if it were not for the extraordinary support, encouragement, and academic guidance of my supervisor Dr. Margaret Ann Wilkinson. I am humbled and grateful for her unselfishness in sharing her outstanding knowledge of the law, but, above all, for her caring human support when I needed it most: making this a unique academic experience without precedent.

I extend my gratitude to Dr. Alfonso Nocilla, my second reader, for his excellent support and valuable comments on my thesis proposal and the thesis first draft.

My special thank you to all my examiners, Dr. Lyndsay Campbell (Law and History, Calgary University), Dr. Robert MacDougall (History, Western University), Dr. Tesh Dagne (Law, Thompson Rivers University), and again Dr. Alfonso Nocilla (Law, Western University), for dedicating their time to reviewing my thesis submission, being exceptionally engaging examiners, and providing insightful comments on my thesis after the defence.

I also thank Dr. Corey Dyck (Philosophy, Western University) for chairing the virtual Zoom thesis defence with such great ease.

I am thankful to Western University School of Graduate and Post-Doctoral Studies for the generous scholarship. I also thank the Faculty of Law Dean, Dr. Erika Chamberlain, and Associate Dean, Research and Graduate Studies, Dr. Andrew Botterell, for their support, especially during the pandemic crisis.

I thank the staff of Western Law Library, especially Duncan Archibald, for great assistance over the many years of my research.

Finally, I thank Mary Morris, Western Law Student Services Co-ordinator, Graduate Programs, a tireless graduate students' pillar, for taking away my fear of administrative procedures on many occasions and for, without hesitation, taking extra time to provide her expertise in the formatting of this thesis.

I thank Western Law Systems Administrator Corey Meingarten (and Max) and all Administration staff for their outstanding assistance and for making this thesis process feel natural despite the complexity of the Covid-19 pandemic uncertainty.

Lastly, I thank my family and friends for always finding wonderful words of encouragement and support.

Thank you all!

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CHAPTER 1 - INTRODUCTION TO THE THESIS

A - Introduction

(a) Context

Canadian intellectual property enactments include at least two different types of protection: firstly, classic intellectual property devices (patents, copyright, and trademarks),¹ which are known to be monopolies that bring economic benefits to their owners and are characterized as tradeable, licensable, and transferable (and are therefore *alienable* rights); secondly, devices such as moral rights (associated with copyright), prohibited marks, and geographical indications (associated with trademarks), that are not tradeable, not licensable, and not transferable (and are therefore *inalienable* rights). There are other devices legislated in intellectual property statutes in Canada that are also not tradeable, licensable, or transferable: data exclusivity² associated with patent came with

¹ The classic intellectual property triad is comprised of patent, copyright, and trademark. (This thesis does not concern patents.) In the Introduction to *The Future of Intellectual Property*, Daniel J Gervais points out that "[t]he term *primary* IP rights can be used to refer to rights in copyright, trademark, design and patent law ... [while] ... [a]dding new rights to those primary rights instead of changing them produces *secondary* rights." (Daniel J Gervais, ed, *The Future of Intellectual Property* [ATRIP Intellectual Property Series] (Cheltenham, UK: Edward Elgar, 2021) at 1 [emphasis in original]. This thesis will not follow the classification of intellectual property rights into primary and secondary rights. Instead, it will refer to copyright, patent, and trademark as classic rights, while moral rights, prohibited marks, and geographical indications will be discussed as newer additions.

² Data exclusivity (known as 'data protection' in Europe) is a concept that arose in the late twentieth century in connection with the regulatory systems that nation states have put in place to ensure that dangerous drugs are not distributed within their borders. In order to get the permission of Health Canada to distribute a drug, whether in or out of patent, those seeking to distribute the drug must provide to Health Canada evidence of the safety of the drug. This evidence includes evidence gained through clinical trials of the drug on patients. Data exclusivity protection is linked to that health and safety data. Although data exclusivity protection often comes to the drug manufacturer who holds the patent on a new drug (typically referred to as the "brand" company) - because it is that manufacturer that often does the extensive testing that Health Canada requires to be allowed to be the first to distribute the drug in Canada - data exclusivity protection is completely independent of patent: data exclusivity protection is given to the drug manufacturer who first collects the data through clinical trials, demonstrating the safety of the drug, and submits the data to Health Canada. The monopoly created by data exclusivity is on the data, not on the drug.

the international intellectual property trade law requirement; technological protection measures (TPM) and Rights Management Information (RMI) are found in the *Copyright Act*³ (*Copyright Act*, RSC 1985, c C-42, ss 41.21 and 41.22, respectively). This thesis argues that it is the aspect of reputation that appears in the law of moral rights,⁴ prohibited marks, and geographical indications that links these three devices uniquely together.⁵

Each of moral rights, prohibited marks (also known as official marks), and geographical indications has, to varying degrees, been analyzed in the scholarly literature,⁶ but no study has examined all three together. One rationale for grouping these three devices together in this thesis is based on the observation that each of these devices appears to be an exception to the classic form of intellectual property with which it has been associated: moral rights appear with, but is distinct from, copyright and both prohibited marks and geographical indications appear with, but are distinct from, trademark.

³ *Copyright Act*, RSC 1985, c C-42.

⁴ ‘Moral’ in the expression ‘moral rights’ in the protection of the literary and artistic works of authors is different from the meaning of ‘moral’ in the sense of morality or ethics. For discussion of the earliest origin of *droits moraux* (moral rights), see Susan P Liemer, “On the Origins of *Le Droit Moral*: How Non-Economic Rights Came to Be Protected in French IP Law,” (2011) 19:65 *J Intell Prop L* 65.

⁵ Of the three classic intellectual property devices, trademark does involve reputation, but reputation is involved in trademark law from the perspective of being an element in deciding whether a trademark has a public presence in association with goods or services – not in the sense of being of the essence in creating the protection, as it is in the cases of the moral rights, geographical indications, and prohibited marks.

⁶ As will be demonstrated in the chapters below, there has been some scholarly literature exploring the concept of reputation in association with moral rights (see Chapter 4). There is no previous literature about the concept of reputation in association with prohibited marks (see Chapter 5). Finally, although ‘reputation’ is statutorily embedded within the definition of ‘geographical indication’ in Canada’s *Trademarks Act*, as is described in Chapter 6, this area of law is newer to Canada than moral rights or prohibited marks and is perhaps the least studied.

The idea of closely focussing on provisions that appear to be other than the classic triad of patent, copyright, and trademark and yet have come to be considered in the context of intellectual property (either in statutes or in international instruments) has been the source of work done by Margaret Ann Wilkinson.

Wilkinson first contrasted copyright with personal data protection.⁷ In arguing that personal data protection interests should be prioritized over intellectual property interests, she noted that “the economic interests in copyright [in the *Copyright Act*] must be balanced both with moral rights interests and with users’ rights [both also found in the *Copyright Act*], pointing out that intellectual property does not stand above or apart from, but must be balanced with, other interests.⁸ Later, noting that protection of confidential information was clearly treated as intellectual property in the international context when it was included in the TRIPS Agreement⁹ in 1994, Wilkinson analyzed its functioning and concluded that it does not possess the classic characteristics of intellectual property (tradeable, licensable and transferable) and is better considered amongst legal regimes such as those governing secrecy, personal data protection and access to information.¹⁰

⁷ See Margaret Ann Wilkinson, "Battleground between New and Old Orders: Control Conflicts between Copyright and Personal Data Protection" in Ysolde Gendreau, ed, *An Emerging Intellectual Property Paradigm: Perspectives from Canada* (Cheltenham, UK: Edward Elgar, 2008) (227-266), comparing classic copyright with the emerging protection of what is known as personal data protection.

⁸ *Ibid* at 265, noting that Justice Bastarache, in writing for the majority of the Supreme Court in *Harvard College v Canada (Commissioner of Patents)*, [2002] 4 SCR 45, 2002 SCC 76, a patent case, was certainly prepared to apply the Charter in the context of intellectual property in an appropriate case (at paras 177-182).

⁹ *Agreement on Trade-Related Aspects of Intellectual Property Rights* (TRIPS), 15 April 1994, *Marrakesh Agreement Establishing the World Trade Organization*, Annex 1C, 1869 UNTS 299; 33 ILM 1197 (entered into force 1 January 1995) [TRIPS Agreement]

¹⁰ Margaret Ann Wilkinson, "The Confidentiality of Seclusion: Studying Information Flows to Test Intellectual Property Paradigms" (Ch 3) in Courtney Doagoo, ed *Intellectual Property for the 21st Century: Interdisciplinary Approach* (Toronto: Irwin Law, 2014) (72-94). Wilkinson concludes

Nothing in the legal protection of personal data or privacy or confidentiality encourages the spread of ideas in ways consistent with the basic tenets of IP: analytically, the essence of all three (privacy, PDP, and confidentiality) is to exclude others completely from access. Intellectual

These latter regimes can be analyzed most effectively from the point of view of information flow rather than an intellectual property perspective.¹¹ She has examined and compared confidential information, privacy law, and personal data protection.¹²

More recently, Wilkinson examined data exclusivity,¹³ which is required to be protected under the provisions of TRIPS, noting that “[t]he existence of patent is not necessary to the existence of data exclusivity”¹⁴ She observed, that, in a similar way in the copyright context neither technological protection measures (TPM) nor Rights Management Information (RMI)¹⁵ are dependent upon the existence of copyright in works or other subject-matter. Nor do any of the three (data exclusivity, TPM or RMI)

property, on the other hand, encourages public dissemination of ideas. The tensions between the exploitation of confidential information in a business context, providing appropriate PDP for individuals in the context of those same businesses, and balancing privacy with demands for access are becoming real social economic and political issues. [footnote omitted]. Recognizing that these concepts – and the IP devices – are all facets of information flow and focussing on analysis of situations from that perspective ... will help the law respond to the emerging demands of a changing society, one increasingly challenged by new claims asserted in respect of information and flows of information and yet increasingly dependent upon information and information flow. (at 91-92).

¹¹ *Ibid* at 74. Questions of the flow of information in society, Wilkinson notes, depend upon the reality that “[u]sers seek information and evaluate it to fit their needs based both on availability (access) *and* on the perceived authority of the source of the information.” [emphasis in original]

¹² *Ibid*. Neither the emerging Canadian tort of privacy (in 2012) nor the legislated federal, provincial and territorial personal data protection statutes in Canada are typically seen as intellectual property. Wilkinson concluded that protection of confidential information functions more like the privacy tort and personal data protection legislation than like intellectual property and, therefore, should not be grouped with intellectual property.

¹³ Wilkinson has found that data exclusivity falls outside of the *Patent Act* and is regulated through “the federal *Food and Drugs Act*, and pursuant to it, the *Data Protection Regulation of the Regulations Respecting Food and Drug*.” See Margaret Ann Wilkinson, “Is Protection of Data through Data Exclusivity, Technological Protection Measures or Right Management Information Actually Intellectual Property?” (Ch 9) in Daniel J Gervais, ed *The Future of Intellectual Property* [ATRIP Intellectual Property Series] (Cheltenham, UK: Edward Elgar, 2021) at 185. See also Margaret Ann Wilkinson, “Health Personal Data and Data Exclusivity: Do the Subjects of, and Intellectual Property in, Data Complete?” in Mistrale Goudreau and Margaret Ann Wilkinson, eds *New Paradigms in the Protection of Investments, Data and Signs* (Montreal: Édition Yvon Blais, 2019) (263-285).

¹⁴ Margaret Ann Wilkinson, “Is Protection of Data through Data Exclusivity, Technological Protection Measures or Right Management Information Actually Intellectual Property?”, *supra* note 13 at 190.

¹⁵ *Ibid*.

share the characteristics of classic intellectual property rights of being tradeable, licensable, and transferrable.¹⁶

When the classic intellectual property triad of patents, copyrights and trademarks moved into trade agreements (while remaining still in the public international law sphere as well), they appear to have become empowered. Yet while some associated devices also moved into the trade agreement context (confidential information¹⁷, for instance), moral rights did not, though they have existed in public international law for about a century. The concept of geographical indications, on the other hand (as this thesis will describe), entered Canada's domestic law *because* of international trade obligations, not because of public international law commitments Canada has made. Prohibited marks, as will also be described below, have their origins in public international law even older than that of the provisions establishing the moral rights – and are recognized in TRIPS. Presence or absence in either of public international law or international trade law is not a characteristic that can link the three devices studied in this thesis.

This thesis argues that what conceptually links the three devices of moral rights, prohibited marks, and geographical indications as a unique set is the concept of reputation embedded in each of them. In addition, it will be demonstrated that it is reputation that distinguishes this unique triad of devices (moral rights, prohibited marks and geographic indications) from the classic triad of intellectual property rights (copyright, patent and trademark).

¹⁶ *Ibid.*

¹⁷ Recall that Margaret Ann Wilkinson argues that although the TRIPS Agreement includes protection of confidential information amongst intellectual property protections, it does not possess the classic characteristics of intellectual property and is better considered amongst legal regimes governing secrecy, personal data protection and access to information. See Wilkinson, *supra* note 10.

Although moral rights are associated with copyright as both are connected with works and performances, the moral rights are distinct from copyright¹⁸ and it was the unique presence of reputation in moral rights¹⁹ (and not in copyright) that caught the eye of this researcher.²⁰ Looking for similar devices, this researcher was drawn to the prohibited marks section in Canada's *Trademarks Act*, a listing of symbols that cannot be used as trademarks²¹ embedded in the trademark statute. These symbols include, for example, symbols of royal family members, state and international institutions, and universities. Although not explicitly articulated, reputation appears to have been historically part of their social provenance – but has not been explored in legal scholarship.

This thesis embraced the opportunity to explore the concept of reputation in prohibited marks and to compare it with the concept of reputation as it is embedded in moral rights protection.

A recent addition to the Canadian *Trademarks Act*,²² geographical indications appear in international trade agreements together with trademark protection.²³ As Tesh

¹⁸ It has been said that "while the two systems of copyright and moral rights have been demonstrated to be distinct, they remain integrated by their focus upon works and their respective authors." (Margaret Ann Wilkinson, "The Public Interest in Moral Rights Protection" (2006) Mich St L R 193 at 217).

¹⁹ As will be discussed further in the moral rights section below, s 28.2(1) of the *Copyright Act*, *supra* note 3, speaks of "the prejudice of ... [the work's or performance's] author's or performer's honour or **reputation**" [emphasis added].

²⁰ It has been noticed that "the purpose of moral rights is to protect the reputation of the author" (Margaret Ann Wilkinson & Natasha Gerolami, "The Author as Agent of Information Policy: The Relationship Between Economic and Moral Rights in Copyright" (2009) 26:2 Gov Inf Q 321 at 327.) However, it has not been known that scholars elaborated on how the concept of reputation connects to the specific category of moral rights of integrity, nor has it been explored what aspect of reputation is associated with it.

²¹ Teresa Scassa, *Canadian Trademark Law*, 2nd ed (Toronto: LexisNexis, 2015) at 197.

²² *Trademarks Act*, RSC 1985, c T-13. See Table 1 below.

²³ In the TRIPS Agreement (*supra* footnote 9) geographical indications have a separate section.

Dagne has pointed out "[t]he interaction between GIs and trademarks is described in various terms that indicate a conflicting relationship: 'tempestuous,' 'complex' and 'cobweb like.' ... The two regimes have similarities in their functions, however."²⁴ Dev

Gangjee notes

while GIs are located within intellectual property doctrine as distinctive signs capable of generating a commercially valuable **intangible reputation**, this is in a very different sense from trademark law. They are tethered to place, open to all who satisfy the conditions for production there and therefore do not easily fit within the category of private property.²⁵ [emphasis added]

The term "reputation" in the definition of geographical indications²⁶ indicates that 'reputation' is a core requirement for geographical indication registration (detailed in Chapter 6), whereas reputation is not an initial requirement for registered trademark protection.

Geographical indications and their connection with classic trademarks was the focus of earlier research conducted by Melissa Loucks.²⁷ She concluded that

[a]s trademarks and geographical indications are unique devices that are not interchangeable and it is possible for legislation to simultaneously protect both, ... trademarks and geographical indications are not in conflict and can instead be viewed as harmonious tools.²⁸

²⁴ Tesh W Dagne, "The Narrowing Transatlantic Divide: Geographical Indications in Canada's Trade Agreements" (2016) 10 *European Review of Intellectual Property Law* 598 at 604.

²⁵ Dev Gangjee, "Quibbling Siblings: Conflicts between Trademarks and Geographical Indications" (2007) 82:3 *Chicago-Kent L Rev* 1253 at 1257.

²⁶ See *Trade-marks Act*, SC 1994, c 2, s 2.

²⁷ Melissa A Loucks, *Trademarks and Geographical Indications: Conflict or Coexistence?* (LLM Thesis, University of Western Ontario, Faculty of Law, 2012). Electronic Thesis and Dissertation Repository 850, online: Scholarship@Western <<https://ir.lib.uwo.ca/etd/850>>.

²⁸ *Ibid* at 123.

As noted earlier, the prohibited marks and geographical indications are associated with the Canada's *Trademarks Act*²⁹ whereas the moral rights are found in the *Copyright Act*³⁰ in Canada.³¹ Because there is no definition of reputation in the *Copyright Act*³² or the *Trademarks Act*³³, this thesis looks to the common law tort of defamation, which, as will be demonstrated, is known to protect reputation, for exploration of the concept of reputation. Nonetheless, as will be demonstrated, exploration of reputation in the context of defamation has proven anything but straightforward. For instance, Andrew T Kenyon has said that "it is not reputation but *aspects* of reputation that are protected by defamation law. That is all defamation law has ever protected."³⁴ [emphasis in original]

This thesis therefore looks at scholarly theorizing about reputation in defamation (detailed in Chapter 2) and at evidence of reputation present in the primary legal

²⁹ Currently prohibited marks are in Section 9 of the *Trademarks Act*, *supra* note 22; Geographical indications are in ss 2, 11.1 – 11.24 of the *Trademarks Act*.

³⁰ *Copyright Act*, *supra* note 3, ss 2, 14.1(1), 17.1(1), 28.2(1).

³¹ American author Xiyin Tang demonstrates, however, that moral rights have been considered in connection with trademark principles in the American context. See Xiyin Tang, "The Artist as Brand: Toward a Trademark Conception of Moral Rights" (2012) 122:1 Yale L J 218. This connection made in American legal circles may be further evidence that a commonality between moral rights, prohibited marks and geographical indications exists.

³² *Copyright Act*, *supra* note 3.

³³ *Trademarks Act*, *supra* note 22. Passing off was a common law tort some time before trademarks were enacted in statute in Canada. Passing off remains, to this day, an action protecting the owners of unregistered trademarks who have acquired sufficient goodwill or reputation in marks and whose marks have become distinctive in the marketplace. As noted by Catherine W Ng, in "The Law of Passing Off – Goodwill Beyond Goods" (2016) 47:7 IIC - International Review of Intellectual Property and Competition Law 817 at 825, "the term "pass off" first appeared in the headnote to the 1842 English case of *Perry v Truefitt*" (citing to *Perry v Truefitt* (1842) 5 Beav 66, 49 ER 749 (Ch)). Canada's first trademark legislation was the *Trade Mark and Design Act*, 31 Vict, c 55, enacted in 1868. The concept of 'reputation' as used in trademark-related discourse, whether statutory or in the context of passing off, is inextricably linked directly with products and services. That sense of 'reputation' in trademark is illustrated in the language of Justice Austin, for the Ontario Court of Appeal, in the passing off case of *Ray Plastics Ltd v Dustbane Products Ltd.*, 74 OAC 131, 57 CPR(3d) 474: "that the product had a reputation, that the get-up had a secondary meaning." This language is clearly distinct from the concept of 'reputation' as 'esteem' that is the focus of this thesis.

³⁴ Andrew T Kenyon, "Defamation, Privacy and Aspects of Reputation" (2018) 56:1 Osgoode Hall LJ 59 at 60 [emphasis in original].

instruments of Canadian defamation law: statutes and cases (Chapter 3). Both scholarly theorizing (Chapter 2) and doctrinal analysis (Chapter 3) of defamation law are then used to explore the role of reputation in moral rights (Chapter 4), prohibited marks (Chapter 5) and geographical indications (Chapter 6).

Figure 1, below, “Testing the Role of Reputation in Defamation and Intellectual Property”, illustrates the principal elements of this thesis and the approach this research takes.

Figure 1: Testing the Role of Reputation in Defamation and Intellectual Property

Reputation - known to be protected in			
Common law tort of:	Defamation: libel and slander		
Reputation - testing for role in –			
Intellectual property law:	<i>Copyright Act</i>	<i>Trademarks Act</i>	
	Moral rights	Prohibited marks	Geographical indications

David Vaver has pointed out that "[t]he regulation of patents protecting industrial inventions, the oldest form of IP [intellectual property], goes back to a Venetian decree of 1474 (or to the English *Statute of Monopolies* of 1624)."³⁵ He says copyright was introduced later, "as a response to the protectionist bent of the early eighteenth century London book trade."³⁶ The English *Statute of Anne*³⁷ granted, for the first time, copyright

³⁵ David Vaver, *Intellectual Property Law: Copyright, Patents, Trade-marks*, 2nd ed (Toronto: Irwin Law, 2011) at 1-2. The latter is often cited as *Statute of Monopolies*, 1623 (21) JAC 1, c 3.

³⁶ *Ibid* at 2.

³⁷ *Statute of Anne*, 8 Anne, c 19 (1710).

as a limited, alienable, monopoly for authors. The development of a related system in civil law began not long after, in 1793 (known as "droit d'auteur").³⁸ At this time no theory of the moral rights was associated with copyright law. Margaret Ann Wilkinson has explained that the early emergence of the economic rights in copyright³⁹ was "suited to the advancement of national economies."⁴⁰

Although a form of trade marks was used in ancient times to identify goods, modern trademark law is "a product of the Industrial Revolution, when judges started protecting business names and symbols."⁴¹ Trademarks first appeared as a common law construct enforced through passing off and other tort actions,⁴² but while the common law actions continued, they "led to [statutory] systems of national trade-mark registration in the second half of the nineteenth century."⁴³ No concepts of either prohibited marks or geographical indications were articulated in these early beginnings of trademark law.

Copyright and trademark are different intellectual property regimes, although the two can co-exist in connection with a common physical symbology.⁴⁴ Writing about this phenomenon,⁴⁵ Roger Hughes cites the *Stork* case⁴⁶ in which, based on the same set of

³⁸ See Wilkinson, *supra* note 18, at 195.

³⁹ As discussed further below, the moral rights are a much later addition.

⁴⁰ Wilkinson, *supra* note 18, at 197.

⁴¹ Vaver, *supra* note 35 at 2.

⁴² Scassa, *supra* note 21, at 10.

⁴³ Vaver, *supra* note 35, at 2.

⁴⁴ See Craig S Mende & Belinda Isaac, "When Copyright and Trademark Rights Overlap" (Ch 7) in Neil Wilkof & Shamnad Basheer, eds *Overlapping Intellectual Property Rights* (Oxford: Oxford University Press, 2012)

⁴⁵ Hon Roger T Hughes, "Overlap and Redundancy (Redundancy) in Intellectual Property" (2018) 31:1 IPJ 19.

⁴⁶ *Stork Market Inc v 1736735 Ontario Inc.* (Hello Pink Lawn Cards Inc), 2017 FC 779 (CanLII) [*Stork* case].

facts, "[t]he plaintiff succeeded in trademark infringement but lost in copyright infringement."⁴⁷ Hughes pointed out that the same set of facts can give rise to different causes of action in intellectual property. Hughes concluded that overlap and redundancy in intellectual property not only exists but "[i]t is unnecessary to eliminate overlap and redundancy."⁴⁸

Although moral rights appear in the *Copyright Act* and prohibited marks and geographical indications in the *Trademarks Act* moral rights are separate from copyright and prohibited marks and geographical indications are separate from trademark. This thesis will demonstrate that evidence of reputation can be involved with devices that themselves are associated with different areas of intellectual property.

(b) Scope

(i) About intellectual property

The first known appearance of the term "intellectual property" was in an eighteenth-century British periodical.⁴⁹ At the end of the nineteenth century, the term "intellectual property" appeared in the French name of the first international office uniting the international bureaus administering patent and copyright: "Bureaux

⁴⁷ Hon Roger T Hughes, *supra* note 45, at 22.

⁴⁸ *Ibid* at 22. The overlapping in intellectual property rights was addressed in Neil Wilkof & Shamnad Basheer, eds, *Overlapping Intellectual Property Rights* (Oxford: Oxford University Press, 2012). For this thesis of particular interest are the following chapters: Craig S Mende & Belinda Isaac, "When Copyright and Trademark Rights Overlap" (Ch 7); Mira T Sundara Rajan, "Moral Rights or Economic Rights" (Ch 10); David Llewelyn, "Protection of 'Famous' Marks under Trademark Law and Passing Off" (Ch 11); Dev S Gangjee, "Overlaps between Trademarks and Geographical Indications" (Ch 13).

⁴⁹ The use of the term "intellectual property" occurred in an article entitled "Conclusion of the Account of Dr. Smith's *New and General Systems of Physic*, from the last Review, p.194" in *Monthly Review; or, Literary Journal: by Several Hands*, Volume XLI (London, UK: printed for R. Griffiths: And Sold by T. Becket and P.A. De Hondt, in the Strand. M,DCC,LXIX [1769]).

internationaux réunis pour la protection de la propriété intellectuelle” (known under its French acronym BIRPI) in the second half of the twentieth century.⁵⁰ The term "intellectual property" received broad international acceptance only after it emerged in the *Convention Establishing the World Intellectual Property Organization*⁵¹ in 1967 [known as the WIPO Convention] as a term embracing a list of rights "resulting from intellectual activity in the industrial, scientific, literary or artistic fields."⁵² Article 2(viii) of the WIPO Convention reads in full as follows:

‘intellectual property’ shall include the rights relating to:

- literary, artistic and scientific works,
- performances of performing artists, phonograms, and broadcasts,
- inventions in all fields of human endeavor,
- scientific discoveries,
- industrial designs,
- trademarks, service marks, and commercial names and designations,
- protection against unfair competition,

and all other rights resulting from intellectual activity in the industrial, scientific, literary or artistic fields.⁵³

Multilateral treaties created in Europe at the end of the nineteenth century began to bring international standardization to intellectual property. First, in 1883, the *Paris Convention for the Protection of Industrial Property*⁵⁴ began to standardize patent and

⁵⁰ See Darinka Tomic, "Finding the Role and Definition of Intellectual Property" (Ch 3) in *The Right to Food and the Right to Intellectual Property in the United Nations (including International Human Rights) and International Trade: Finding the Definition* (MSL Thesis, The University of Western Ontario, Faculty of Law, 2017). Electronic Thesis and Dissertation Repository 4672, online: Scholarship@Western <<https://ir.lib.uwo.ca/etd/4672>>.

⁵¹ WIPO, *Convention Establishing the World Intellectual Property Organization* (Signed in Stockholm on July 14, 1967, and as amended on September 28, 1979).

⁵² *Ibid* art 2(viii).

⁵³ *Ibid*.

⁵⁴ *Paris Convention for the Protection of Industrial Property*, 20 March 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967, and as amended on September 28, 1979, 828 UNTS 305 [Paris Convention].

trademark internationally, then three years later, the *Berne Convention for the Protection of Literary and Artistic Works*⁵⁵ began the same process of standardization for copyright.

Intellectual property received enhanced attention across the globe after its historic 'crossover' into international trade through the 1994 *Agreement on Trade-Related Aspects of Intellectual Property Rights* (TRIPS).⁵⁶ Intellectual property law continues to develop internationally both through public international law and in international trade law.

(ii) Moral rights

Conceptions of moral rights

spread into many copyright environments from France and Germany, which, early in the nineteenth century, recognized rights such as the right of divulgation or disclosure (the author's right to control if and when the work will be published), the right of paternity or attribution (the author's right to be identified with the work ...), and the right of withdrawal or repentance (the author's right to withdraw a work from public circulation).⁵⁷

Moral rights originated from the French civil law tradition (*droits moraux*), referring to individual, personal, and thus inalienable rights, of an author of literary or artistic works. Certain moral rights were added to the public international Berne Convention in the 1928 Rome Revision of that treaty.⁵⁸ The article reads as follows:

Independently of the author's economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work, as well as the right to object to any distortion, mutilation or other

⁵⁵ *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) [Berne Convention].

⁵⁶ *Supra* note 9.

⁵⁷ Wilkinson, *supra* note 18 at 195.

⁵⁸ Berne Convention, *supra* note 55 (Article 6*bis* added at Rome in 1928.)

modification of the said work, which would be prejudicial to his **honor or reputation**. [emphasis added]⁵⁹

Canada instantiated moral rights in its *Copyright Act* in 1931.⁶⁰ The added subsection read as follows:

Independently of the author's copyright, and even after the assignment, either wholly or partially, of the said copyright, the author shall have the right to claim authorship of the work, as well as the right to restrain any distortion, mutilation or other modification of the said work which would be prejudicial to his **honour or reputation**. [emphasis added]⁶¹

Margaret Ann Wilkinson has put the creation of moral rights in the following context:

However, the emerging dominance of the corporate business structure over the older sole proprietorships and partnerships led to ownership of the original (economic) rights in copyright lying overwhelmingly with corporate interests. **This, in turn, led many nations to recognise a need for new rights related to, but apart from, the economic rights in copyright: hence the rise of those rights eventually grouped as “the moral rights.”**⁶² [emphasis added]

In addition, and in support of this initial observation, this thesis argues that moral rights are an exception to copyright though associated with it. K E Gover has said that “[m]oral rights are a collection of rights designed to recognize and protect the **non-**

⁵⁹ *Ibid*, art 6bis (1) [emphasis added].

⁶⁰ *An Act to Amend the Copyright Act*, SC (21-22 Geo V), c 8 (assented to 11 June 1931), s 5 [Canada *Copyright Act* 1931].

⁶¹ *Ibid* s 5(5) [emphasis added].

⁶² Margaret Ann Wilkinson, “What is the Role of New Technologies in Tensions in Intellectual Property?” (Ch 1) in Tana Pistorius, ed, *Intellectual Property Perspectives on the Regulation of Technologies* [Intellectual Property Series] (Cheltenham, UK: Edward Elgar, 2018), (8-34) at 16-17 [footnote and illustration omitted, emphasis added]. Wilkinson also pointed out “from a theoretical perspective, it can hardly be argued that non-transferable, individual rights (as moral rights are conceived to be) have a place in trade and therefore in a trade regime or trade agreements.” (at 16).

economic rights of **artists** in their works” [emphasis added].⁶³ Wilkinson also noticed that

it cannot be a coincidence that the conception of these “moral rights” emerged just as corporate law evolved. As a result of the evolution of corporate law, the transfer of the earlier-conceived copyright rights (which were always conceived of as being transferable) could occur, by the end of the nineteenth century, not just between individuals (as had been the case up until the corporate law changes beginning in the mid-nineteenth century, since, before then, all businesses had comprised individuals) but also from individual creators and authors to separate corporate “persons” (and these latter, themselves, could never *be* original authors or creators).⁶⁴

(iii) Prohibited marks

Prohibited marks appeared in public international law in the twentieth century, at the 1925 Hague Revision of the Paris Convention, as a measure to

refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags and other State emblems of the contracting countries, official signs and hallmarks indicating control and warranty adopted by them and all imitations thereof from a heraldic point of view.⁶⁵

In Canada, prohibited marks [then termed “forbidden marks”] were first added to the 1932 *Unfair Competition Act*.⁶⁶ Significant revisions to the 1932 *Unfair Competition Act* followed in 1953, through the enactment of *An Act Relating to Trade Marks and*

⁶³ KE Gover, *Art and Authority: Moral Rights and Meaning in Contemporary Visual Art* (Oxford: Oxford University Press, 2018) at 11 [emphasis added]. It should also be noted that the sense of “moral” in the copyright context is a very different use of “moral” from that found in ethics. (See Rowland Lorimer, “Intellectual Property, Moral Rights, and Trading Regimes: A Publishing Perspective” (1966) 21:2 *Canadian Journal of Communication* 267). These and other characteristics of moral rights differentiating them from classic copyright are detailed in the substantive chapter of this thesis dealing with moral rights (Chapter 4).

⁶⁴ Wilkinson, *supra* note 62, at 16.

⁶⁵ Paris Convention, *supra* note 54, art 6*ter*.

⁶⁶ *Unfair Competition Act*, 1932, 22-23 Geo V, c 38, s 14.

Unfair Competition (known as the *Trade Marks Act*).⁶⁷ This enactment, which termed the former “forbidden marks” as “prohibited marks”, added seven new marks to the list of “prohibited marks” (as will be discussed further in Chapter 5).

Between 1953 and 1990 the prohibited marks section of Canada’s trademark legislation remained unchanged. However, after 1990 several further revisions of the trademark statute occurred.⁶⁸ The prohibited marks in the current version of Canada's *Trademarks Act*⁶⁹ is a list of marks described in twenty-one subparagraphs of subsection 9(1) (see again Chapter 5). These marks, including the flags of countries,⁷⁰ words and emblems of international significance⁷¹ and crests associated with royalty,⁷² symbols of universities,⁷³ and any “matters that may falsely suggest a connection with any living individual”⁷⁴ cannot be used as trademarks in Canada.⁷⁵

⁶⁷ *Trade-Marks Act*, 1952-53, c 49, s 1.

⁶⁸ The amendments to prohibited marks Section 9 of the *Trademarks Act* since the 1985 Revised Statutes of Canada consolidations have occurred in 1990, c 14, s 8; 1993, c 15, s 58; 1993, c 44, ss 226, 236(1)(c), (d); 1994, c 47, s 19; 2007, c 26, s 6; and 2014, c 32, ss 11, 53. The amendments in SC 2018, c 27, s 215 (not yet in force) and s 216 (also not yet in force), will, when brought into force, add s 9(3) and s 9(4) (through s 215), and also (through s 216) add s 11.01 to the Exception section.

⁶⁹ *Supra* note 22, s 9.

⁷⁰ *Ibid* s 9(1)(i).

⁷¹ See, for instance, *ibid* s 9(1)(g) [symbol of the Red Crescent].

⁷² *Ibid* s 9(1)(a), s 9(1)(b).

⁷³ *Ibid* s 9(1)(n)(ii).

⁷⁴ *Ibid* s 9(1)(k).

⁷⁵ In addition to *Trademarks Act*, prohibited marks in Canada are also protected through the *Olympic and Paralympic Marks Act*, SC 2007, c 25. Titled in full “An Act respecting the protection of marks related to the Olympic Games and the Paralympic Games and protection against certain misleading business associations and making a related amendment to the *Trade-marks [Trademarks] Act*” this 2007 statute will not be further discussed in this thesis because the focus of this thesis is on individual's rights and the *Olympic and Paralympic Marks Act* focuses on corporate rights of the type protected as regular trademarks under the *Trademarks Act*. Distinctions differing prohibited marks from trademarks are further detailed in the substantive chapter of this thesis dealing with prohibited marks (Chapter 5).

(iv) Geographical indications

A precursor to the concept of geographical indications, "indications of source," first appeared in the original 1883 Paris Convention.⁷⁶ Where goods were qualified to be able to be labelled with "indications of source" (as created by countries pursuant to the concept of "indications of source" then permitted under the Paris Convention), producers from any other geographic location were prohibited from associating their goods "as an indication of source [with] the name of a specified locality, when such indication is joined to a trade name of a fictitious character or used with fraudulent intention".⁷⁷ This prohibition in the original 1883 Paris Convention is among the earliest, if not the earliest, prohibition on using as a mark particular geographical names. A later term for "indication of source", "appellation of origin", entered the European-based 1958 public international *Lisbon Agreement*.⁷⁸ In modern usage, the terms "indication of source" and "appellation of origin" have become roughly interchangeable with the term "geographical indications".⁷⁹

When in 1994 three nation states came together in the first comprehensive modern international trade agreement, the 1994 *North American Free Trade Agreement* between the Government of Canada, the Government of Mexico and the Government of the United States (NAFTA)⁸⁰, it included a section about geographical indications. Slightly

⁷⁶ Paris Convention, *supra* note 54, art 10.

⁷⁷ *Ibid.*

⁷⁸ *Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration*, (31 October 1958, amended 28 September 1979, entered into force 4 November 1983, last revised 1. January 1994) [Lisbon Agreement]. Canada is not signatory to the Lisbon Agreement.

⁷⁹ These terms are further explored in Chapter 6.

⁸⁰ *North American Free Trade Agreement* between the Government of Canada, the Government of Mexico and the Government of the United States, 17 December 1992, Can TS No 7, 32 ILM 289, 605 (entered into

later, the virtually global multilateral, TRIPS Agreement⁸¹ introduced the first definition of the term “geographical indications” in any international agreement.⁸²

The obligations stemming from the TRIPS Agreement imposed legal obligations for member states to protect geographical indications for wines and spirits.⁸³ Canada amended its *Trademarks Act* accordingly.⁸⁴ Teresa Scassa has noted that geographical indications “have an uneasy relationship with ... trademark law, and there is currently no international consensus on the scope that should be given to the protection of such indications.”⁸⁵ Teshager Dagne, writing in 2014, notes that “[d]espite their inclusion as category of IP in the TRIPS Agreement, some express doubts about GIs as a form of IP.”⁸⁶ He goes on to say,⁸⁷ that while

trademarks 'operate as a kind of shortcut to get consumers to where they want to go.' ... the rights acquired under trademark law are not proprietary in nature per se. A sign or term under trademark law earns proprietary value to the owner if the sign or term has developed a reputation for a product through continuous use in relation to a product.⁸⁸

force 1 January 1994) [NAFTA]. On July 1, 2020, the new Canada-United States-Mexico Agreement (CUSMA) entered into force.

⁸¹ TRIPS Agreement, *supra* note 9.

⁸² *Ibid* art 22.

⁸³ *Ibid* art 23.

⁸⁴ *World Trade Organization Agreement Implementation Act*, SC 1996, c 47.

⁸⁵ Scassa, *supra* note 21, at 230. The characteristics of geographical indications that make them different from trademarks are detailed in the substantive chapter discussing reputation and geographical indications (Chapter 6).

⁸⁶ Teshager W Dagne, "The Identity of Geographical Indications and Their Relation to Traditional Knowledge in Intellectual Property Law" (2014) 5:2 WIPO Journal 137 at 144 [footnote omitted].

⁸⁷ Citing to *Mattel v 3894207 Canada Inc* [2006] 1 SER 772.

⁸⁸ Dagne, "The Identity of Geographical Indications ..." *supra*, note 86 at 146.

Dagne continues, saying "GIs protection for products ... entails the recognition of proprietary interests of its own (even without a reputation developed through use)."⁸⁹ In 2016 Dagne wrote "in essence GIs and trademarks are different legal regimes."⁹⁰

B - Comparisons Between Moral Rights, Prohibited Marks, and Geographical Indications

As set out below in Table 1: " First Appearance in any International Agreement and in Canadian Legislation of Moral Rights, Prohibited Marks, and Geographical Indications", moral rights protection was added to Canada's *Copyright Act* in 1931 following the inclusion of moral rights in the 1928 Rome revision of the Berne Convention. Prohibited marks entered Canada's *Unfair Competition Act* in 1932 after Article 6ter was added to the 1925 Hague Revision of the Paris Convention. Geographical indications for wines and spirits entered Canadian law through amendments to the *Trademarks Act* in 1994, reflecting Canada joining the TRIPS Agreement earlier that year.

Table 1 also demonstrates that all three of moral rights, prohibited marks, and geographical indications are twentieth century devices - much later additions to the Canadian laws of copyright and trademark than are the original devices of copyright and trademark with which these rights are now associated.

⁸⁹ *Ibid.*

⁹⁰ Tesh W Dagne, "The Narrowing Transatlantic Divide: Geographical Indications in Canada's Trade Agreements" (2016) 10 *European Review of Intellectual Property Law* 598 at 604.

Table 1: First Appearance in Any International Agreement and in Canadian Legislation of Moral Rights, Prohibited Marks, and Geographical Indications

	International Agreement	First appearance in Canada
Moral Rights	1928 Rome Revision of the Berne Convention	1931 <i>Copyright Amendment Act</i>, 21-22 Geo V, c 8
	<p>Article 6bis (1) Independently of the authors copyright, and even after the transfer of the said copyright, the author shall have the right to claim authorship of the work, as well as the right to object to any distortion, mutilation or other modification of the said work which would be prejudicial to his honour or reputation. (2) The determination of the conditions under which these rights shall be exercised is reserved for the national legislation of the countries of the Union. The means of redress for safeguarding these rights shall be regulated by the legislation of the country where protection is claimed.</p> <p>Article 11bis (1) Authors of literary and artistic works shall enjoy the exclusive right of authorizing the communication of their works to the public by radiocommunication. (2) The national legislations of the countries of the Union may regulate the conditions under which the right mentioned in the preceding paragraph shall be exercised, but the effect of those conditions will be strictly limited to the countries which have put them in force. Such conditions shall not in any case prejudice the moral right (droit moral) of the author, nor the right which belongs to the author to obtain an equitable remuneration which shall be fixed, failing the agreement, by the competent authority.</p>	<p>s 5(5) - "the author shall have the right to claim authorship of the work, as well as the right to restrain any distortion, mutilation or other modification of the said work"</p> <p>In Schedule A [to the 1931 Copyright Amendment Act] full text of The Rome Copyright Convention, 1928</p>
Prohibited Marks	1925 Hague Revision Conference of the Paris Convention	1932 <i>Unfair Competition Act</i>, 22-23 Geo V, c 38
	<p>(Article 6ter) - "to prohibit ... the use ... either as trademarks or as elements of trademarks, of armorial bearings, flags and other State emblems, ... official signs and hallmarks" ...</p>	<p>s 14.1 -" No person shall be entitled to adopt for use in connection with his business, as a trademark or otherwise, any symbol consisting of, or so nearly resembling as to be likely mistaken for,"... [list of eleven subsections describing symbols that cannot be used as trademarks follows]</p>

Geographical Indications	1994 TRIPS Agreement	<i>World Trade Organization Agreement Implementation Act, SC 1994, c 47</i>
	(Article 23) -"Each Member shall provide the legal means for interested parties to prevent use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating"...	s 190(2)(a) took effect 1 January 1996 <i>Amended Trade-marks Act, SC 1994, c 2, ss 2, 11.11</i>

Following the 1994 TRIPS Agreement, David Vaver said, "[l]obbied by the industries that live off IP [intellectual property], the United States and Europe later embarked on a program of concluding bilateral free trade agreements that invariably increase IP obligations ("TRIPS-plus" treaties)."⁹¹ Of the three devices this thesis focuses upon, geographical indications have been particularly affected by the bilateral and multilateral international trade agreements that Canada has signed since the TRIPS Agreement.⁹² For example, the 2014 *Canada - Korea Free Trade Agreement* (Canada - Korea FTA)⁹³ and the 2017 *Canada - European Union Comprehensive Economic Trade Agreement* (CETA),⁹⁴ each required Canada to amend the geographical indications section in its *Trademarks Act*.⁹⁵

⁹¹ Vaver, *supra* note 35, at 5.

⁹² The TRIPS Agreement (*supra* note 9) has a separate section on geographical indications. Other bilateral or multilateral trade agreements to which Canada is a party (discussed later in this thesis) also deal with geographical indications separately from trademarks.

⁹³ *Canada-Korea Free Trade Agreement*, 22 September 2014 (entered into force 1 January 2015), art 16.10 [Canada-Korea FTA].

⁹⁴ *Canada-European Union Comprehensive Economic and Trade Agreement* (CETA), 30 October 2016 (entered into force 21 September 2017), arts 20.16-20.23 [CETA].

⁹⁵ Currently "Geographical Indications" are enacted in ss 11.1 – 11.24 of the *Trademarks Act*, *supra*, note 22.

Canada has created twenty-four categories of food and agricultural products with which geographical indications can be associated.⁹⁶ The trade agreement between Canada and the European Union specifically requires that Canada protect hundreds of European products in Canada:⁹⁷ these products each fall into one or other of the twenty-four categories just mentioned. Reciprocating provisions have been required by Canada of its international partners in these agreements concerning geographical indications: see, for instance, Korea's agreement to protect "Canadian Whiskey" and "Canadian Rye Whisky" in Korea.⁹⁸

These two trade agreements, the Canada-Korea FTA and CETA,⁹⁹ are examples of "TRIPS-plus" treaties because these trade agreements expand their members' obligations beyond the requirements for the protection of geographical indications these countries have already agreed to in the TRIPS Agreement.¹⁰⁰

Canada has been and is a party to other regional trade agreements that include intellectual property. For example, the *North American Free Trade Agreement* between Canada, Mexico, and the United States (NAFTA)¹⁰¹ came into effect a year before

⁹⁶ The definition of "geographical indication" in s 2 of the *Trademarks Act*, *supra* note 22, states that a "geographical indication" means an indication that identifies a wine or spirit, or an agricultural product or food of a category set out in the schedule..." The Schedule (cited to SC 2017, c 6, s 77 (Sched 2) is titled "Categories of Agricultural Products or Food" and contains 24 categories.

⁹⁷ International trade agreements to which Canada is also signatory include the multilateral *Comprehensive and Progressive Agreement for Trans-Pacific Partnership* (CPTPP) entered into force 30 December 2018, and *Canada - United States - Mexico Agreement* (CUSMA) entered into force 1 July 2020. These free trade agreements include sections on intellectual property, but none are considered to impose new requirements for Canadian intellectual property law beyond those already required by CETA (*supra* note 94). Each will be further discussed *infra*.

⁹⁸ In signing the *Canada-Korea FTA* (*supra* note 93). Details are provided in Chapter 6.

⁹⁹ *Supra* note 94.

¹⁰⁰ TRIPS Agreement, *supra* note 9, art 23.

¹⁰¹ *North American Free Trade Agreement* between the Government of Canada, the Government of Mexico and the Government of the United States, 17 December 1992, Can TS No 7, 32 ILM 289, 605 (entered into force 1 January 1994) [NAFTA].

TRIPS and, like TRIPS, included provisions relating to intellectual property. In 2020 NAFTA was replaced by the *Canada - United States - Mexico Agreement (CUSMA)*,¹⁰² which, compared with NAFTA, contains an expanded and updated section on intellectual property. Another multilateral trade agreement affecting Canada that has a separate section on intellectual property is the 2018 *Comprehensive and Progressive Agreement for Trans-Pacific Partnership (CPTPP)*.¹⁰³

These international trade agreements are discussed further in this thesis only to the extent that they affect Canadian legislation involving one or more of moral rights, prohibited marks or geographical indications.

This thesis argues that the aspect of reputation appearing in the law of moral rights, prohibited marks and geographical indications groups these three devices uniquely together.

C - The Concept of Reputation

(a) Introduction

In the field of ethics, scholar David Oderberg has said that reputation "is simply the general consensus of judgment about a person's character."¹⁰⁴ Oderberg speaks about

¹⁰² *Canada - United States - Mexico Agreement (CUSMA)* entered into force 1 July 2020. Canada-United States-Mexico Free Trade Agreement, <https://www.international.gc.ca/trade-commerce/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.

¹⁰³ *Comprehensive and Progressive Agreement for Trans-Pacific Partnership (CPTPP)* entered into force 30 December 2018.

¹⁰⁴ David S Oderberg, "The Morality of Reputation and the Judgment of Others" (2013) 1:2 *Journal of Practical Ethics* 3 at 6.

reputation normatively (considering reputation can be good, and also bad, but also true or false, in all combinations) and states "that having a good, true reputation is the most prized possession."¹⁰⁵ Reputation, in the sense being considered by Oderberg, led to the declaration of "reputation" as a human right in 1948, in Article 12 of the *Universal Declaration of Human Rights* [UDHR]. Article 12 reads as follows:

No one shall be subjected to arbitrary interference with his privacy, family, home or correspondence, nor to attacks upon his honour and **reputation**. Everyone has **the right to the protection of the law** against such interference or attacks.¹⁰⁶[emphasis added]

Not only does the UDHR declare the reputation of individuals a human right but it also indicates that it is a right to be protected at law. However, the UDHR is not specific about what form legal protection of individuals' reputations should take.¹⁰⁷

The later UN 1966 *International Covenant on Civil and Political Rights* (ICCPR) includes reputation in these provisions:

Article 17

1. No one shall be subjected to arbitrary or unlawful interference with his privacy, family, home or correspondence, nor to unlawful attacks on his honour and **reputation**.
2. Everyone has the right to the protection of the law against such interference or attacks.¹⁰⁸ [emphasis added]

and

Article 19

...

2. Everyone shall have the right to freedom of expression; this right shall include freedom to seek, receive and impart information

¹⁰⁵ *Ibid.*

¹⁰⁶ *Universal Declaration of Human Rights*, 10 December 1948. General Assembly Resolution 217 A (III) (entered into force 16 December 1949) [UDHR], art 12 [emphasis added].

¹⁰⁷ The UDHR does not mention defamation - either libel (written and published defamatory statements damaging a person's reputation) or slander (oral statements diminishing a person's reputation).

¹⁰⁸ *International Covenant on Civil and Political Rights*, 19 December 1966, 999 UNTS 171 (entered into force 23 March 1976, accession by Canada 19 May 1976) art 17 [emphasis added].

and ideas of all kinds, regardless of frontiers, either orally, in writing or in print, in the form of art, or through any other media of his choice.

3. The exercise of the rights provided for in paragraph 2 of this article carries with it special duties and responsibilities. It may therefore be subject to certain restrictions, but these shall only be such as are provided by law and are necessary:

(a) For respect of the rights or **reputations** of others;¹⁰⁹

...

[emphasis added]

While in Article 17 (above), the ICCPR declares individuals should be free from attacks on their reputations, the ICCPR, in Article 19 (3)(a), set out immediately above, declares that the exercise of the right to freedom of expression may restrict individuals' abilities to protect reputation.

The ICCPR, like the UDHR, does not define or mention defamation (either libel or slander). Canadian defamation case law does not cite to either of the above UN documents (the UDHR or ICCPR) except in two instances.¹¹⁰ In the first instance, in 2009 in *Crookes v Newton* (a defamation case which will be further analyzed in Chapter 3 of this thesis), the Court of Appeal for British Columbia delivered judgment on appeal from the order of Justice Kelleher in the Supreme Court of British Columbia.¹¹¹ Justice Prowse in the Court of Appeal delivered dissenting reasons in which she cited the Australian High Court decision in *Dow Jones and Company Inc. v Gutnick* [2002] HCA 56, 210 CLR 575. Justice Prowse noted:

¹⁰⁹ *Ibid.*

¹¹⁰ Searching for defamation caselaw in CanLII and Westlaw Canada resulted in finding two defamation cases mentioning the ICCPR (*Crookes v Newton*, 2009 BCCA 392 and *R v Stevens*, [1993] 82 CCC (3d) 101). There was no mention of either the UDHR or the ICCPR in intellectual property case law dealing with any of moral rights, prohibited marks (including "official marks") or geographical indications.

¹¹¹ *Crookes v Wikimedia Foundation Inc.*, 2008 BCSC 1424.

[i]n his reasons for judgment, Gaudron J. [in *Dow Jones and Company Inc. v Gutnick*] rejected the notion that effective remedies for Internet defamation were not possible. At paras 115-116 of the decision, he [Justice Gaudron] stated: ... [116] The [ICCPR] also provides that "[n]o one shall be subjected to arbitrary or unlawful interference with his privacy, family, home or correspondence, nor to unlawful attacks on his honour and reputation". And that "[e]veryone has the right to the protection of the law against such interference or attack".¹¹²

In the second instance, in 1993 in *R v Stevens*,¹¹³ a Canadian criminal libel case (also discussed below in Chapter 3), Justice Giesbrecht of the Manitoba Provincial Court said:

The importance of reputation is recognized in international human rights agreements. The International Covenant on Civil and Political Rights (I.C.C.P.R.), which was adopted by the United Nations in 1966 and in force in Canada since 1976, in its preamble recognizes the "inherent dignity" and the "equal and inalienable rights of all members of the human family" as the "foundation of freedom, justice and peace in the world". The I.C.C.P.R. deals with reputation in the following two articles:

ARTICLE 17

1. No one shall be subjected to arbitrary or unlawful interference with his privacy ... nor to unlawful attacks on his honour and reputation.
2. Everyone has the right to the protection of law against such interference or attacks.

Article 19 guarantees freedom of expression but provides that this right carries with it "special duties and responsibilities" and is subject to certain restrictions as provided by law and as are necessary "for respect of the rights or reputations of others".¹¹⁴

As noted there is some connection between the international human rights concept of reputation and Canada's defamation law involving reputation (law which involves tortious conduct between persons, including individuals). One would not expect a

¹¹² *Crookes v Newton*, 2009 BCCA 392 at para 26.

¹¹³ *R v Stevens*, [1993] 82 CCC(3d) 181.

¹¹⁴ *Ibid* at 124.

connection concerning reputation as found in international human rights law and reputation as maybe found in intellectual property devices (in this study, the law of moral rights, prohibited marks and geographical indications).

(b) Reputation distinguished from the concepts of goodwill and privacy

(i) Reputation and goodwill

In a 2011 article, Andrea Slane noticed that comparison between reputation, associated with the moral rights in the *Copyright Act*, and goodwill associated with trademarks had not received adequate attention, in her view, in Canadian courts.¹¹⁵ In her article, she explains that she uses the term "goodwill" as a synonym for "reputation" in her discussions about trademark: “[w]hile the term ‘reputation’ is used in both [copyright and trademark], I will use the term ‘goodwill’ to refer to the reputational interests protected by trademark in order to maintain clarity”.¹¹⁶ She continues

[g]oodwill in trademark law, is, in contrast [to reputation in moral rights] a specifically commercial concept: it refers to a positive association with a source of goods or services that brings customers back to these goods or services, rather than to a competitor. As the SCC found in *Mattel*, there is nothing subjective or personal about goodwill [in trademark] – **it is a factual finding that must be established by a plaintiff**, and it is measured entirely by the degree to which consumers associate a mark with a source. [footnote omitted; emphasis added].¹¹⁷

Robert Bone also distinguishes the concept of reputation as goodwill in trademark from the concept of personal reputation. He notes that the change of the economy from

¹¹⁵ Andrea Slane, "Guarding a Cultural Icon: Concurrent Intellectual Property Regimes and the Perpetual Protection of *Anne of Green Gables* in Canada" (2011) 56:4 McGill LJ 1011 at 1036.

¹¹⁶ *Ibid* at 1033.

¹¹⁷ *Ibid* at 1035.

personal to corporate changed the concept of "goodwill" in trademark law and writes that, in modern usage, "[g]oodwill generated by large corporations removed at great distance from the ultimate consumer [is] a very different thing than the paradigmatic form of goodwill as personal reputation."¹¹⁸ The goodwill (or reputation) dealt with in connection with trademark falls outside the scope of this research.

(ii) Reputation and privacy

In recent scholarship, the expansion of the language of reputation towards connecting with privacy (law) has been noticeable, especially since the right to respect private and family life (Article 8) entered the European Convention on Human Rights (ECHR) (drawing the attention of scholars¹¹⁹).

Interestingly, the Law Commission of Ontario (LCO) in 2020 recommended substantive reform of Ontario's defamation law, based on the "seven principles guiding defamation law":¹²⁰

1. Defamation Law Must Re-Balance Protection of Reputation and Freedom of Expression in the Internet Age
2. Defamation Law Needs to Be Updated; Some Statutory Reforms are Necessary
3. Defamation Law is Evolving; New Reforms Must Complement These Developments
4. Access to Justice and Dispute Resolution Must Be Improved
5. Defamation Law Must Specifically Address Online Personal Attacks
6. There Must Be New Obligations for Intermediary Platforms
7. Defamation Law and Privacy Law Have Distinct Objectives and Should Remain Separate

¹¹⁸ Robert G Bone, "Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law" (2006) 86:3 BU L Rev 547 at 578.

¹¹⁹ See for example Tanya Aplin & Jason Bosland, "The Uncertain Landscape of Article 8 of the ECHR: The Protection of Reputation as a Fundamental Human Right?" in Andrew T Kenyon, ed, *Comparative Defamation and Privacy Law*, Cambridge Intellectual Property and Information Law, ed (Cambridge: Cambridge University Press, 2016) 265.

¹²⁰ Law Commission of Ontario, *Defamation Law in the Internet Age: Final Report* (Toronto: March 2020) at 9-14.

The report concluded that "[t]he LCO recommends against significant reform to most of the substantive elements of the tort of defamation."¹²¹ It also recommended "[o]n balance, the LCO believes that the unique substantive elements of defamation law, such as the presumptions of damage and falsity, remain relevant today."¹²² The report noted that "[t]he distinction between truth and falsity, along with an increased focus on opinion, remains crucial to the tort of defamation."¹²³

The LCO clearly points to the need for reputation in defamation law being kept separate from privacy law.¹²⁴ Andrew Kenyon had already said that "defamation and privacy law are largely separate, even though both connect with reputational concerns."¹²⁵ Attention to privacy protection has also been associated with the reputations of celebrities, as in the work of David Rolph.¹²⁶ Privacy law protects an individual's right not to be exposed to the public.¹²⁷ Privacy is a different construct, not one associated with reputation in the sense with which this thesis is concerned.

¹²¹ *Ibid* at 4.

¹²² *Ibid* at 11.

¹²³ *Ibid* at 14.

¹²⁴ *Ibid* ("7. Defamation Law and Privacy Law Have Distinct Objectives and Should Remain Separate").

¹²⁵ *Supra* note 34 at 73.

¹²⁶ Rolph discusses the work of Robert C Post, also discussed in Chapter 2 of this thesis: David Rolph, "Building and Rebuilding Reputations: Reflections on the Role of Defamation Law in the Life of Celebrity" in Kathy Bowrey & Michael Handler, eds, *Law and Creativity in the Age of the Entertainment Franchise* (Cambridge: Cambridge University Press, 2014) at 104 ("Influenced by Robert Post's taxonomy of reputation, defamation scholars have recognized that reputation can be viewed as a social construct (reputation as honour and dignity), an economic construct (reputation as property) and, as has been more recently suggested, a media construct (reputation as celebrity)." [footnotes omitted]).

¹²⁷ *Ibid*.

(c) - Reputation in Canada's defamation law

(i) Framework

When false statements damage an person's reputation, Canadian law has long provided remedies for defamation. Defamation actions often revolve around the use of "words", for instance in a published article in the newspaper. However, the form of a defaming act need not be words: it can be any 'permanent form' that is also visible (libel) or temporary and audible (slander).¹²⁸ For example, a person can be defamed by a pictorial communication such as a caricature.¹²⁹

Canada has included criminal libel in the *Criminal Code*.¹³⁰ Robert Martin explained that "[c]ivil libel is the mechanism whereby individuals may seek to protect

¹²⁸ See Simon Deakin, Angus Johnston & Basil Markesinis, *Markesinis and Deakin's Tort Law*, 6th ed (New York: Oxford University Press, 2008) Ch 21 "Defamation and Injurious Falsehood" (B) Libel and Slander at 756-759.

¹²⁹ A political cartoon in a daily newspaper was defamatory in *Vander Zalm v Times Publishers*, (1980), 109 DLR (3d) 531, (Reasons for judgment delivered by each Chief Justice of the Court of Appeal of British Columbia [Nemetz], Seaton, Hinkson, Aikins, Craig JJA) reversing (1979), 96 DLR (3d) 172 (Justice Munroe judgment for plaintiff).

¹³⁰ *Criminal Code*, RSC 1985, c C-46, s 59(2) (Seditious libel); ss 297-317 (Defamatory libel). Although, in 1984, the Law Reform Commission of Canada recommended the offence of defamatory libel be abolished, it remains in Canada's *Criminal Code* to this day. See Law Reform Commission of Canada. Defamatory Libel, Working Paper 35 (Ottawa, 1984) at 59-60:

IV Conclusion. Undoubtedly, reputation is a fundamental value in our society. An attack upon reputation may well result in serious consequences to the victim. Let us be frank. Deliberate character assassination ought not to be tolerated by society. Nonetheless, as we have emphasized throughout this Paper, the criminal law must be used with restraint. For reasons previously explored at some length, we do not feel that a crime of defamation would be able to do better than which is already done by the civil law of defamation. Nor would it seem to be an effective deterrent. Therefore, we do not feel that a crime of defamation could make a substantial contribution in dealing with the problem of defamatory publications in our society. Accordingly, we recommend that our *Criminal Code* should contain no crime of defamation, even in a restricted form.

In 1993, in *R v Stevens*, [1993] 82 CCC (3d) 101 (discussed at length below, in Chapter 3), Justice Giesbrecht said, at para 123, that "the Law Reform Commission did not adequately address the issue of the harm caused by false defamatory attacks on a person's reputation, and the fact that such attacks are not only private wrongs but are also matters of public interest." Note that Canadian *Criminal Code* does not mention slander.

their reputations"¹³¹ whereas "[t]he broad purpose of criminal libel is to preserve public order. Criminal libel punishes certain forms of expression largely because they are seen as creating threats to public order."¹³²

Martin wrote that the criminal defamatory libel offence "sounds very similar to civil libel, but there are some distinctions."¹³³ Martin noted "that the distinction between civil libel and criminal libel [is] that civil libel [is] a private matter between individuals."¹³⁴ On the other hand, "a [criminal] defamatory libel prosecution is a public matter between the state and the accused."¹³⁵ In civil defamation actions damages are awarded, while if a criminal prosecution for defamatory libel succeeds, the punishment can be a jail sentence.

In 2020, Dylan Williams, himself writing about defamatory libel, noted "in Canada, there is little discussion around criminal defamation ... [t]he offences attract occasional criticism from legal practitioners but almost no academic study."¹³⁶ In 2018 Lisa Taylor and David Pritchard focussed on criminal libel in Canada in an article in which they concluded "the advent of the Internet and social media has changed the environment for reputational harm".¹³⁷

¹³¹ Robert Martin, *Media Law* (Toronto: Irwin Law, 2003) at 70.

¹³² *Ibid.* (In the *Criminal Code*, at the time Martin wrote his book, there were three forms of criminal libel (seditious, defamatory, and blasphemous). However, in 2018, the section 296 about blasphemous libel was repealed from the *Criminal Code*). [Repealed, 2018, c 29, s 30].

¹³³ *Ibid* at 72.

¹³⁴ *Ibid.*

¹³⁵ *Ibid.*

¹³⁶ Dylan J Williams, "If You Do Not Have Anything Nice to Say: *Charter* Issues with the Offence of Defamatory Libel (Section 301)"(2020) Man LJ 43:4 181 at 182. The one academic article he indicated that he had located (see 182, n 4) was Lisa Taylor & David Pritchard, "The Process is the Punishment: Criminal Libel and Political Speech in Canada," (2018) 23:3 Comm L & Pol'y 243.

¹³⁷ Lisa Taylor & David Pritchard, "The Process is the Punishment: Criminal Libel and Political Speech in Canada," (2018) 23:3 Comm L & Pol'y 243 at 249. These authors also pointed to their own discussion of

Civil defamation actions (whether for libel or slander) are private matters between private parties. Plaintiffs can be either individuals or corporations and, as well, defendants can be corporations or individuals.¹³⁸ Civil actions for defamation can be brought for either libel or slander. In modern legal civil actions both libel and slander are included by the term defamation, which is considered, as a civil matter, to be part of the branch of common law known as torts.¹³⁹

For both libel and slander as a civil action, to be defamatory an expression must be in some sort of published form perceived by the public as defamatory. Raymond E Brown has said

[t]he defamatory publication may be published orally or in writing or in some other permanent or transitory form. Where the distinction is maintained, the written or more permanent form is considered to be libel, is actionable per se, and damages are presumed. Where the defamatory statement is made orally or in a more transitory form, its publication is considered a slander. ... Where, as in most Canadian provinces, the distinction is abolished [by statute], slander is treated the same as libel.¹⁴⁰

Although civil libel and slander remain common law actions in all the common law Canadian provinces and in the territories, the common law respecting defamation has been modified by statute in all these jurisdictions.

evaluating the qualitative aspects of criminal libel as “a measure of empirical validation for Robert Post’s often cited but seldom tested hypothesis that the path a defamation case takes depends to a great extent on how the target of the defamation thinks of his or her reputation.” (*Ibid* at 263 (footnote omitted)).

¹³⁸ See Erika Chamberlain & Stephen GA Pitel, eds, *Introduction to the Canadian Law of Torts*, 4th ed (Toronto: Lexis Nexis, 2020) (“[I]t is not only natural persons who may be defamed. A juridical person, that is, a non-profit organization or a business corporation, may also sue for defamation if the defamatory statement affects the reputation of the organization concerned.” [footnotes omitted] at 189).

¹³⁹ GHL Fridman, et al, *The Law of Torts in Canada*, 3rd ed, (Toronto: Carswell, 2010) Ch 2 “Defamation” at 627-628.

¹⁴⁰ Raymond E Brown, *Brown on Defamation: Canada, United Kingdom, Australia, New Zealand, United States*, 22nd ed, vol 1 (Toronto: Thomson Reuters Canada, 2017) (Defamation) (loose-leaf updated 2016, release 3) at 1-56.

(ii) In Québec civil law

Québec is a civil law jurisdiction rooted in the French civil law tradition. In that province defamation currently falls under the Civil Code enacted in 1991,¹⁴¹ enacted in art.1457.¹⁴² In its 2002 judgment in *Prud'homme v Prud'homme*, the Supreme Court of Canada discusses the civil law rules of liability for defamation:¹⁴³

The basis for an action in defamation in Quebec is found in art. 1457 C.C.Q., [] which lays down the general rules that apply to question of civil liability. Thus, in an action in defamation, the plaintiff must establish, on a balance of probabilities, the existence of injury, or a wrongful act, and of a casual connection, as in the case of any other action in civil, delictual or quasi-delictual liability.¹⁴⁴

The Supreme Court continued, pointing out that "Quebec civil law does not provide for a specific form of action for interference with reputation"¹⁴⁵ and explaining "[w]hether remarks are defamatory is determined by applying an objective standard ... whether an ordinary person would believe that the remarks made, when viewed as a whole, brought discredit on the reputation of another person."¹⁴⁶ The Court continued, noting "a person who has made remarks that are deemed to be defamatory will not necessarily be civilly liable for them. The plaintiff must further demonstrate that the person who made the

¹⁴¹ *Civil Code of Québec*, CQLR c CCQ-1991, art 2929.

¹⁴² *Civil Code of Québec*, *supra* note 141, art 1457.

Every person has a duty to abide by the rules of conduct incumbent on him, according to the circumstances, usage or law, so as not to cause injury to another. Where he is endowed with reason and fails in this duty, he is liable for any injury he causes to another by such fault and is bound to make reparation for the injury, whether it be bodily, moral or material in nature. He is also bound, in certain cases, to make reparation for injury caused to another by the act, omission or fault of another person or by the act of things in his custody.

¹⁴³ *Prud'homme v Prud'homme*, 2002 SCC 85 (CanLII), [2002] 4 SCR 663. Judgment delivered by L'Heureux-Dubé and Lebel JJ on appeal from a judgment of the Quebec Court of Appeal, [2000] RRA 607, [2000] QJ No. 2070 (QL), setting aside a decision of the Superior Court. Appeal dismissed.

¹⁴⁴ *Supra* note 140 at para 32.

¹⁴⁵ *Ibid* at para 32.

¹⁴⁶ *Ibid* at para 34 [citation omitted].

remarks committed a wrongful act."¹⁴⁷ In this respect, the Court says

Accordingly, in Quebec civil law, communicating false information is not necessarily a wrongful act. On the other hand, conveying true information may sometimes be a wrongful act. **This is an important difference between civil law and the common law**, in which the falsity of the things said is an element of the tort of defamation. [emphasis added]¹⁴⁸

In light of the difference between civil and common law in the treatment of defamation, highlighted above, the analysis in this thesis will be necessarily restricted to the common law tort of defamation.

D – Research Questions and Approach

(a) Approach

In this thesis, doctrinal and theoretical approaches have been blended with historical analysis in analyzing the statutory devices of moral rights, prohibited marks and geographical indications. The legislative history of each device, for instance, has been shown to be very revealing. As well, though it has been said that "doctrinal methodology is in a period of change and transition",¹⁴⁹ and that its focus on critical analysis and synthesis of law may be "too constricting,"¹⁵⁰ in this thesis, there was no other way of approaching the necessary empirical analysis of defamation law than through a doctrinal analysis. This has also been the case in describing the primary constructs of this thesis – moral rights, prohibited marks and geographical indications. As has been noted, "[d]octrinal research is not simply a case of finding the correct legislation

¹⁴⁷ *Ibid* at para 35 [citation omitted].

¹⁴⁸ *Ibid* at para 37 [citation omitted].

¹⁴⁹ Terry Hutchinson, "The Doctrinal Method: Incorporating Interdisciplinary Methods in Reforming the Law" (2015) 3 *Erasmus Law Review* 130 at 130.

¹⁵⁰ *Ibid*.

and the relevant cases [...]. It is a process of selecting and weighing materials, taking into account hierarchy and authority, as well as understanding social context and interpretation."¹⁵¹

A dynamic methodological approach ideally suited to the research questions in this thesis has been created through describing the primary constructs of this thesis (moral rights, prohibited marks and geographical indications), explaining the origin of the protection of reputation in the common law defamation action (but also analyzing the impact on reputation, if any, of the Canadian statutory framework which has come to modify the common law of defamation across Canada), analyzing Canadian defamation jurisprudence, and exploring the ideational theorizing of Robert C. Post about defamation.

Lyndsay Campbell, writing about the early history of libel law (1820-1840), compared the development of libel law in Massachusetts with that in Nova Scotia. She also used a blend of approaches, situating the law of defamation in these two jurisdictions in this period in the context of the larger history of Massachusetts and Nova Scotia at the time. Her work in the primary sources of defamation law in nineteenth century Massachusetts and Nova Scotia reveals ways in which these two developing societies sometimes shared paths and, in other ways, diverged in social and political development. Campbell “turn[ed] to use of courts themselves through a consideration of civil cases, in which individuals, through their strategic decisions, demonstrated their understandings of the invitation offered by courts as fora for disputes about reputation and expression.”¹⁵²

¹⁵¹ Ian Dobinson & Francis Johns, "Legal Research as Qualitative Research" in Mike McConville & Wing Hong Chui, eds, *Research Methods for Law*, 2nd ed, (Edinburgh: Edinburgh University Press, 2017) at 24.

¹⁵² Lyndsay M Campbell, *Truth and Privilege: Libel Law in Massachusetts and Nova Scotia, 1820-1840* (Cambridge: Cambridge University Press, 2022) at 31.

This thesis uses the law of defamation as an analytic tool to assist in investigating three under-studied areas of law related to intellectual property: moral rights, prohibited marks and geographical indications. Specifically, this thesis explores whether the concept of ‘reputation’ present in Canada’s defamation law could be helpful in understanding the roles of moral rights, prohibited marks or geographical indications in Canadian law.

(b) Research questions

(i) Overall question

Does the concept of ‘reputation’ form a unique link bringing the concepts of moral rights, prohibited marks and geographical indications uniquely together?

(ii) Specific questions

1. Is the concept of reputation involved in each of the moral rights, prohibited marks and geographical indications?
2. Can the concept of reputation in defamation law contribute to an understanding of the concept of reputation involved in moral rights, prohibited marks and geographical indications?
3. Does the concept of reputation distinguish the moral rights, prohibited marks and geographical indications from the classic triad in intellectual property (copyright, patent and trademark)?

CHAPTER 2 - THEORIZING ABOUT REPUTATION

A - Defining Reputation

(a) Literary meaning of "reputation"

In writing about "reputation" legal scholars have tended to quote from Shakespeare's *Othello* (*Othello, The Moor of Venice*, Act III Scene 3) in which Shakespeare's character Iago says that their "[g]ood name in man and woman ... [i]s the immediate jewel of their souls".¹⁵³ However, as Raymond Brown pointed out, there are an "[a]lmost forgotten and rarely quoted ... words"¹⁵⁴ in an earlier Act from this Shakespearian play in which, to Cassio's lament that, having lost his reputation, he has "lost the immortal part of [himself]," Iago responds by saying "[r]eputation is an idle and most false imposition; oft got without merit, and lost without deserving" (*Othello, The Moor of Venice*, Act II Scene 3).¹⁵⁵ It seems that these two different views are put in the mouth of the same character because, as Dario Milo noted, these views "emphasize the difference between reputation and character."¹⁵⁶ In this regard, Milo pointed out that "there are aspects of the law relating to mitigation of damages for harm to reputation that reinforce the proposition that the concept of reputation is different from that of character,

¹⁵³ Iago's lines from Shakespeare's *Othello* were, for example, cited in Raymond E Brown, *Defamation Law: A Primer*, 2nd ed (Toronto: Carswell, 2013) at footnote 16; *Gatley on Libel and Slander*, 11th ed by Patrick Milmo & W.V.H. Rogers (London, UK: Sweet & Maxwell, 2008) at 3, footnote 1; Dario Milo, *Defamation and Freedom of Speech* (New York: Oxford University Press, 2008) at 16; Robert C Post, "The Social Foundations of Defamation Law: Reputation and the Constitution" (1986) 74 Cal L R 691 at 692, footnote 7.

¹⁵⁴ Raymond E Brown, *Defamation Law: A Primer*, 2nd ed (Toronto: Carswell, 2013) at 6, footnote 16.

¹⁵⁵ These other lines from Shakespeare's *Othello* put in the mouth of the character Iago were also cited in Raymond E Brown, *Defamation Law*, *supra* note 152 at 6, footnote 16, and also in *Gatley on Libel and Slander*, 11th ed by Patrick Milmo & W.V.H. Rogers (London, UK: Sweet & Maxwell, 2008) at 3, footnote 1, as well as in Dario Milo, *Defamation and Freedom of Speech* (New York: Oxford University Press, 2008) at 20, footnote 39.

¹⁵⁶ Dario Milo, *supra* note 153 at 20, footnote 39.

and is recipient-oriented."¹⁵⁷ Nevertheless, even though more than four hundred years have passed since Shakespeare wrote *Othello*, the difficulty defining and explaining the meaning of "reputation," especially in legal terms, remains to this day. According to the *Oxford English Dictionary*, "reputation" means

- (a) The condition, quality, or fact of being highly regarded or esteemed; credit, fame, distinction; respectability, good report.
- (b) The honour, credit, good name, or fame of a particular person or thing.

¹⁵⁸

A specialized law dictionary such as *Black's Law Dictionary* defines "reputation" more precisely as

1. (1839) The esteem in which someone is held or the goodwill extended to or confidence reposed in that person by others, whether with respect to personal character, private or domestic life, professional and business qualifications, social dealings, conduct, status, or financial standing. Evidence of reputation may be introduced as proof of character whenever character evidence is admissible. ... Also termed *personal reputation*.
2. The esteem in which a company is held by the public.¹⁵⁹

The definition of the term "reputation" in the law dictionary expands the meaning of the term beyond the artistic and linguistic. The law dictionary embraces the "personal character" of reputation and broadens its perspective to include "the goodwill extended to or confidence reposed in that person by others." The first definition of reputation in the *Black's Law Dictionary* (citation 1 above) dates to 1839. At that time modern corporations had not been created in corporate law in Canada. The term "goodwill" could only be linked to an individual's reputation and not a corporate reputation because

¹⁵⁷ *Ibid* at 19 [footnotes omitted].

¹⁵⁸ *Oxford English Dictionary* (OED) (Oxford University Press, 2020) sub verbo "reputation," 1st definition.

¹⁵⁹ *Black's Law Dictionary*, 10th ed (St. Paul, MN: Thomson Reuters, 2014) sub verbo "reputation".

modern corporations had not yet been created in Canadian law.¹⁶⁰ In *Black's Law Dictionary*, the second definition of reputation above "[t]he esteem in which a company is held by the public"¹⁶¹ indicates that reputation [also expressed here as "esteem"] manifests itself (only) through the lenses of others, i.e. "the public."

In the most recent edition of *Canadian Law of Torts*, the authors say that "[a] judicial person, that is, a non-profit organization or a business corporation, may also sue for defamation if the defamatory statement affects the reputation of the organization concerned."¹⁶² However, the authors further note that "[n]evertheless, it is generally accepted that governments and public institutions cannot sue in defamation, because allowing them to sue would be inconsistent with the constitutional right to freedom of expression, and would have a chilling effect on citizens' ability to criticize the government."¹⁶³

(b) Theories about "reputation"

Australian author Matthew Collins comments in 2014 that "[s]urprisingly little judicial ink has been spilled on the relationship between defamatory meaning and

¹⁶⁰ Regarding the connection of "goodwill" with intellectual property devices Wilkinson wrote that first dates of corporation in Canada "[u]p until the mid-nineteenth century, when the modern legal separation of a corporation from its owners occurred, inventors, authors and creators were exclusively individuals - and a business's goodwill was only the goodwill of the individual or individuals operating it." Wilkinson, "What is the Role of New Technologies ..." *supra* note 62 at 9.

¹⁶¹ *Black's Law Dictionary*, 10th ed (St. Paul, MN: Thomson Reuters, 2014) sub verbo "reputation".

¹⁶² Erika Chamberlain & Stephen GA Pitel, eds, *Introduction to the Canadian Law of Torts*, 4th ed (Toronto: Lexis Nexis, 2020) at 189 [footnote omitted]. In her study, "The Canadian Defamation Act: An Empirical Study," (2017) 95:3 Can B Rev 591, Hilary Young reports (at p 608-9) that both between 1973 and 1983 and between 2003 and 2013 in Canada corporate plaintiffs and human plaintiffs succeeded in defamation proceedings in the same proportion (though, overall, defamation proceedings were more often successful in earlier period than the later, see p 605).

¹⁶³ Chamberlain & Pitel, *supra*.

reputation," while, as he puts it in a note, "[t]he question has, however, been the subject of academic attention."¹⁶⁴

Robert Post, in an article in 1986, wrote that "[r]eputation ... is a mysterious thing"¹⁶⁵ that still draws scholars' attention.¹⁶⁶

Among scholars drawn by Post's article was Lawrence McNamara, who said, "[w]ithout a clear sense of what reputation *is*, it would be difficult to make a judgment about the manner and extent of its protection under the law."¹⁶⁷ Nonetheless, Dario Milo, who also discussed Post's article (at approximately the same time as McNamara) said that "[i]t is difficult to provide a satisfactory definition of reputation."¹⁶⁸

Post considered reputation in defamation law in its social context and historical perspective.¹⁶⁹ He postulated "three distinct concepts of reputation that the common law

¹⁶⁴ Matthew Collins, *Collins on Defamation* (New York: Oxford University Press, 2014) 6.23). Collins in his own work points to the authors who write about reputation, "in particular, Robert Post, 'The Social Foundations of Defamation Law: Reputation and the Constitution' (1986) 74 *California Law Review* 691; Lawrence McNamara, *Reputation and Defamation* (2007); David Rolph, *Reputation, Celebrity and Defamation Law* (2008)." at 121, note 55.

¹⁶⁵ Robert C Post, "The Social Foundations of Defamation Law: Reputation and the Constitution" (1986) 74 *Cal L Rev* 691 at 692.

¹⁶⁶ For example, Post's article had such an impact on Lyrisa Lidsky when she was a law student in Texas that, a quarter-century later, in 2020, as an established American legal scholar, she published a tribute to Post's article. In her article, Lidsky said that "Post illuminated the role of the common law of defamation in reflecting and reinforcing existing social relationships, including hierarchies of status, while ostensibly protecting reputation." (Lyrisa Lidsky, "Post, Robert C., *The Social Foundations of Defamation Law: Reputation and the Constitution*", 74 *Calif. L. Rev.* 691 (1986)" (2020) 25:4 *Comm L & Pol'y* 491 at 492). The other scholars who have discussed Post's theoretical foundation for reputation are Lawrence McNamara, Dario Milo, Bob Tarantino, Chris DL Hunt, Katie Duke and Megan Richardson. Each of them will be discussed in the following pages.

¹⁶⁷ Lawrence McNamara, *Reputation and Defamation* (New York: Oxford University Press, 2007) at 15 [emphasis in original].

¹⁶⁸ Dario Milo, *Defamation and Freedom of Speech* (New York: Oxford University Press, 2008) at 17.

¹⁶⁹ Post *supra* note 165. Post's approach to conceptualizing reputation had an empirical aspect (discussed through defamation law in the context of freedoms guaranteed by the Constitution of the United States): Post, referred to the First Amendment of the Constitution of the United States - the amendment that guarantees the freedoms such as freedom of religion, freedom of speech, freedom of the press.

of defamation has at various times in its history attempted to protect."¹⁷⁰ In this context, Post discussed reputation as property, reputation as honour, and reputation as dignity. Post said at the beginning of his article, for all three of his concepts of reputation, "they are as types analytically distinct, although in actuality there may be, and indeed must be, some overlap."¹⁷¹

(i) Post's "reputation as property"

Post's starting point about reputation as property is that reputation can be understood in connection with goodwill.¹⁷² Post states that "[t]here are aspects of modern defamation law that can be understood only by reference to the concept of reputation as property, as, for example, the fact that corporations and other inanimate entities can sue for defamation."¹⁷³ As Post notes, "[i]n many cases, particularly where the plaintiff is a corporation, it is difficult to distinguish between defamation and injurious falsehood, since it is not possible to separate defamation of the plaintiff from disparagement of plaintiff's property or business."^{174 175}

¹⁷⁰ *Ibid* at 693.

¹⁷¹ *Ibid*.

¹⁷² *Ibid* at 691.

¹⁷³ *Ibid* at 696 [footnotes omitted].

¹⁷⁴ Chamberlain & Pitel, *supra* note 162, at 234 & 236 provide [footnotes omitted] further explanation about the tort of injurious falsehood:

In the modern law of torts, there are two different versions of this action: slander of title (the old action based upon an attack on the plaintiff's title to property) and slander of quality/goods (when the attack is on the quality of the plaintiff's property). However, the action for injurious falsehood can also be relevant to other analogous situations...The plaintiff must plead and prove that the relevant statement was false.(234)

This distinguishes injurious falsehood from defamation, in which defamatory statements are presumed to be untrue, and it is for the defendant to prove that they are true through the defence of justification. Like in defamation, however, the plaintiff must prove that the statement was intended to refer to the plaintiff, either directly or indirectly.(236)

¹⁷⁵ Post, *supra* note 165 at 699.

Post begins his observations about reputation as property by saying that this concept "can be understood as a form of intangible property akin to goodwill."¹⁷⁶ He continues by saying "[t]he concept of reputation as property explains why defamation law proscribes aspersions on an individual's character even in the contexts that are not narrowly oriented toward business relationships;"¹⁷⁷ – his explanation is that character can be viewed as "the fruit of *personal exertion*."¹⁷⁸

Post writes that

The concept of reputation as property presupposes that individuals are connected to each other through the institution of the market. The market provides the mechanism by which the value of property is determined. The purpose of the law of defamation is to protect individuals within the market by ensuring that their reputation is not wrongfully deprived of its proper market value.¹⁷⁹

Although in his article Post does not separate reputation (as property) from the individual who has it, he discusses both concepts (reputation as property and the individual who has it) in the context of the market. For Post, "[u]nderlying the concept of reputation as property is an implicit image of a form of society that ... [he terms] 'a market society.'¹⁸⁰ In theory,¹⁸¹ Post explains, an individual always retains the capacity

¹⁷⁶ *Ibid* at 693. (Note that in Chapter 1, this thesis considers goodwill being an asset in the process of acquiring a property (different from intellectual property) - thus, it is unlikely applicable to intellectual property devices (prohibited marks and geographical indications) regardless of the fact these devices can be associated with corporations. Intellectual property devices - prohibited marks and geographical indications are not-transferable, not-licensable, and not-tradeable. Therefore, these devices cannot generate goodwill in the sense that classic trademarks could. (See also Chapter 1 of this thesis).

¹⁷⁷ *Ibid* at 694.

¹⁷⁸ *Ibid* [emphasis in original].

¹⁷⁹ *Ibid* at 695.

¹⁸⁰ *Ibid*.

¹⁸¹ Describing the concept of reputation as property, Post relied on the ideas, for example, found in the works of the seventeenth-century English philosopher Thomas Hobbes (Post, *supra* 165 at 694 at footnote

to "produce" new reputation. Law protects only "those aspects of an individual's reputation that the market can measure."¹⁸² This means that the market value of a person's reputation will vary. It also means that "every person enjoys an equal right to enter the market to attempt to achieve what reputation he can."¹⁸³ As Post observes, "[t]he concept of reputation as property is ... deeply imbedded in our understanding of defamation law."¹⁸⁴ (Note that Post also sees "reputation as honour" and "reputation as dignity" as part of defamation law, as will be explained further).

Writing in the late 20th century, Robert Post considers reputation as a product of human labour. He says, it exists "[t]he concept of reputation as property presupposes that individuals are connected to each other through the institution of the market."¹⁸⁵

Post also says that "the concept of reputation as property is deeply inconsistent with important doctrines of common law defamation."¹⁸⁶ He explains that this is so because reputation as property "cannot explain so fundamental a doctrine as that a communication must be deemed defamatory before it can support an action."¹⁸⁷ This is because "[t]he common law of defamation will not offer redress for untrue communications that are not defamatory, even if they cause damage to an individual's credit or business opportunities."¹⁸⁸

15), the nineteenth-century English lawyer Thomas Starkie (Post, *supra* 165 at 694 at footnote 14), and the twentieth-century German sociologist Max Weber (Post, *supra* 165 at 693 at footnote 11).

¹⁸² *Ibid* at 696.

¹⁸³ *Ibid*.

¹⁸⁴ *Ibid*.

¹⁸⁵ *Ibid* at 695.

¹⁸⁶ *Ibid* at 697.

¹⁸⁷ *Ibid*.

¹⁸⁸ *Ibid*.

Concluding his section on reputation as property Post says that "[i]mportant and fundamental aspects of defamation law are thus inexplicable from the perspective of reputation as property. To understand them, we must turn to the analysis of other concepts of reputation."¹⁸⁹

(ii) Post's "reputation as honour"

Post ties the concept of reputation as honour to the traditional view of reputation,¹⁹⁰ particularly "influential in preindustrial England during the formative years of defamation law."¹⁹¹ Post defines honour as "a form of reputation in which an individual personally identifies with the normative characteristics of a particular social role and in return personally receives from others the regard and estimation that society accords to that role."¹⁹² Post explains that "reputation as honour" is different from "reputation as property" because the former is not earned or created through the effort of labour but is created from what society attributes to the individual's position (for example, the position of king). As Post says, "a king does not work to attain the honor of his kingship, but rather benefits from the honor which society attributes to his position."¹⁹³ Reputation as honour "cannot be bought and sold like goodwill, but is instead attached to specific social roles."¹⁹⁴

¹⁸⁹ *Ibid* at 699.

¹⁹⁰ *Ibid*. Traditional views on reputation as honour Post tied not only to Shakespeare's Othello, but also to the Bible, Proverbs 22:1 ("A good name is rather to be chosen than great riches").

¹⁹¹ *Ibid*.

¹⁹² *Ibid* at 699-700.

¹⁹³ *Ibid* at 700.

¹⁹⁴ *Ibid* at 700-701 [footnotes omitted].

In his work, Post borrows the term "deference society" from historian Michael Thompson's book describing society in eighteenth-century England.¹⁹⁵ Post explains that "[a]n insult to the king involves not only injury to the king's personal interest, but also damage to the social status with which society has invested the role of kingship."¹⁹⁶ Post elaborates, saying that "[t]he preservation of honor in a deference society, ... entails more than the protection of merely individual interests."¹⁹⁷ He further says that "[t]he concept of reputation as honor is consonant with aspects of defamation law that are difficult to understand from the perspective of reputation as property."¹⁹⁸

About the distinction between reputation in terms of involving the honour of an individual and reputation involving an institution that an individual represents, Post says that "[i]f in a deference society an attack upon the person of the king was equivalent to an attack on the institution of monarchy, we [in modern society] are now more likely to distinguish between an attack on the president and an attack on the institution of the presidency."¹⁹⁹ That is, the reputation of an individual will likely be differently interpreted today from reputation of an institution that an individual represents whereas, in the past, we lived in "deference" societies where the reputation of the individual and that of the institution the individual represented were more often conflated and thus differently protected at law.

¹⁹⁵ *Ibid* at 702, note 63, citing FML Thompson, *English Landed Society in the Nineteenth Century* (London, UK: Routledge & Kegan Paul, 1963) at 7, 23.

¹⁹⁶ *Ibid* at 702.

¹⁹⁷ *Ibid*.

¹⁹⁸ *Ibid* at 706.

¹⁹⁹ *Ibid*.

(iii) Post's "reputation as dignity"

Another of Post's concepts of reputation is tied to the concept of dignity. Post notes that "it is not immediately clear how reputation, which is social and public, and which resides in the 'common or general estimate of a person,' can possibly affect the 'essential dignity' or a person's 'private personality'."²⁰⁰ However, Post makes the connection by adopting Erving Goffman's sociological approach²⁰¹ (expressed in Goffman's 1967 collection of essays):²⁰²

[w]hile it may be true that the individual has a unique self all his own, evidence of this possession is thoroughly a product of joint ceremonial labor, the part expressed through the individual's demeanor being no more significant than the part conveyed by others through their deferential behaviour toward him.²⁰³

Although Post holds that Goffman's approach could possibly create a theoretical grounding for a connection between the law of defamation and the concept of reputation as dignity, Post finds this possible theoretical connection problematic.

Post believes instead that defamation law protects reputation as dignity because "[w]hen rules of deference and demeanor are embodied in speech, and hence are subject to the law of defamation, ... [and he then calls them] 'rules of civility.'"²⁰⁴ For Post, "[t]he dignity that defamation law protects is thus the respect (and self-respect) that arises from full membership in society."²⁰⁵

²⁰⁰ *Ibid* at 708.

²⁰¹ *Ibid* at 710 ("Goffman's account provides a theory for connecting the law of defamation to the concept of dignity.").

²⁰² Erving Goffman, *Interaction Ritual: Essays on Face-to Face Behaviour* (Garden City, NY: Anchor Books, 1967).

²⁰³ *Ibid* at 84-85. Cited in Post *supra* note 163 at 710, footnote 108.

²⁰⁴ Post *supra* note 163 at 710.

²⁰⁵ *Ibid* at 711.

Post says that “[d]ignity is not like property, for dignity is not the result of individual achievement and its value cannot be measured in the marketplace” and that “[i]t is inaccurate, therefore, to speak of defamation law as ‘compensating’ for the loss of dignity.”²⁰⁶ Post says, “[s]ometimes defamation law incorporates the perspective of [reputation as property] ‘a considerable and respectable class in the community’; sometimes the perspective of [reputation as honour] ‘right-thinking persons’; and sometimes the perspective of [reputation as dignity] ‘society ... taken as it is.’”²⁰⁷ Post continues saying that “honor is concerned with attributes of personal identity that stem from the characteristics of particular social roles, whereas dignity is concerned with the aspects of personal identity that stem from membership in the general community.”²⁰⁸ However, Post elaborates (considering that at one time the meaning of the terms “dignity” and “honour” were close, referring to the time of the English Renaissance and citing to the usage of the term “dignity” recorded in the Oxford English Dictionary) by saying that the question of reputation “is not the protection of individual dignity, but rather which communities the law will assist in the maintenance of their cultural identity.”²⁰⁹

Post’s study is theoretical but rooted in historical observations positioned within a broader social context. Post identified three possible approaches to the concept of reputation in defamation law. He did not prioritize any of them over the others. Instead, describing characteristics which, in his view, separate each of the three approaches from

²⁰⁶ *Ibid* at 712.

²⁰⁷ *Ibid* at 715, footnote 131.

²⁰⁸ *Ibid* at 715.

²⁰⁹ Post, *supra* note 165 at 715.

the other two he did not seek to establish a "right" nor "the" approach to the concept of reputation.

(iv) Reaction to Post

McNamara considers reputation a critical interest to be protected by defamation law²¹⁰ (although his main focus in his book is on the question of what test should be used to determine what is defamatory).²¹¹ McNamara disagreed with Post over the concept of reputation as property, saying that "[i]t does not explain why esteem, confidence, and goodwill are vested in a person... [and that] the idea that reputation is a form of property does not tell us anything about the processes of moral judgment that are [according to McNamara] central to the formation of reputation."²¹²

McNamara rejects Post's "proposition that [reputation in defamation law] is a form of property"²¹³ but considers Post's analyses of reputation as honour²¹⁴ and reputation as dignity²¹⁵ to be relevant to some extent for his theorizing about reputation as a moral judgement. With respect to Post's concept of reputation as property, McNamara argues that "[t]he connections between social and self-worth, and between honour, reputation, and dignity, suggest that the idea of a moral taxonomy will also be a useful way to think about honour and dignity, and about reputation and its relationships to

²¹⁰ McNamara, *supra* note 167 at 1.

²¹¹ *Ibid* at 107.

²¹² *Ibid* at 42.

²¹³ *Ibid* at 57.

²¹⁴ *Ibid* at 43.

²¹⁵ *Ibid* at 56.

defamation law."²¹⁶ McNamara declares that his own approach does not allow for looking at reputation as property because, in his view, this treatment does not reflect the true nature of reputation.²¹⁷ According to McNamara "[a]n individual's reputation is a social judgment of the person based upon facts which are considered relevant by a community."²¹⁸ McNamara's conclusion in the early part of his book is to defend reputation as a moral judgment that may be derived from different sources: for example, from various communities.²¹⁹ He argues that a community "should be understood as a moral construct."²²⁰ In the concluding chapter of his book, he proposes a theory of reputation different from either Post's reputation as honour or Post's reputation as dignity: a theory of reputation as a moral taxonomy.²²¹ Having proposed his theory, McNamara concludes that "there should be one test for what is defamatory and it should be stated in the following terms: A publication will be defamatory if it has a tendency to cause 'the right-thinking person' in the community to think the less of the plaintiff."²²²

A year after McNamara published his book, Dario Milo published a book containing a chapter about reputation.²²³ Milo disagreed with McNamara's rejection of Post's theory of reputation as respect to reputation as property.²²⁴ Milo agrees with Post's

²¹⁶ *Ibid* at 38.

²¹⁷ *Ibid*.

²¹⁸ *Ibid* at 21.

²¹⁹ *Ibid*, passim at 15-36 ("Reputation and Community: The Centrality of Moral Judgment").

²²⁰ *Ibid* at 30.

²²¹ *Ibid* at 229.

²²² *Ibid*.

²²³ Dario Milo, *supra* note 168. While working on his book, Milo cited directly from McNamara's manuscript (see p 17, footnote 18).

²²⁴ *Ibid*, Ch 2 "The Right to Reputation" at 27, footnote 103.

theory and said that "reputation as property certainly explains some incongruous features of the common law of defamation."²²⁵ Referring to Post theory of reputation as property, Milo said that "[t]he classic aspect of defamation law that regards reputation as a form of property is the rule that corporations can sue for defamation."²²⁶

Dario Milo, the year after McNamara published *Reputation and Defamation*, published *Defamation and Freedom of Speech*.²²⁷ Dario Milo wrote a chapter on the right to reputation, fully accepting Post's theory of reputation.²²⁸ Milo's view was that "[r]eputation is difficult to define and categorize, especially since it is not a static concept; its contours adapt to fit changing social, economic, and legal *mores* of society."²²⁹ Opposing McNamara's rejection of Post's concept of reputation as property, Milo said "[a]s to the right to reputation, the rationales that are most applicable in modern circumstances are the property and the dignity justifications for reputation."²³⁰ He added that "[i]t is not just the individual sense of self-worth that is implicated in a defamation action, but also society's interest in ensuring that its rules of civility are respected."²³¹ Milo also said that "[t]he ambiguity that defamation law exhibits, especially between

²²⁵ *Ibid* at 28.

²²⁶ *Ibid* at 28 [footnotes omitted].

²²⁷ *Ibid*.

²²⁸ *Ibid*, Ch 2 "The Right to Reputation" at 26-42 ("Section C. The Values Underlying the Right to Reputation: 1. Reputation as property, 2. Reputation as honour, 3. Reputation as dignity"). Dario Milo expressed his gratitude to McNamara for providing him (Milo) with access to the manuscript of his (McNamara's) book. However, Milo's approach to reputation departed from McNamara's and aligned with that of Robert Post.

²²⁹ *Ibid* at 41-42 [emphasis in original].

²³⁰ *Ibid* at 42.

²³¹ *Ibid*.

property and dignity reputation, is unsurprising."²³² Milo added that "[r]eputation is a complex concept; it represents the community's opinions of the image projected by an individual, and individuals naturally 'constitute themselves in various milieus - business associations, communities, families'."²³³ Ending his chapter on reputation, Dario Milo said that "[a] coherent theory of reputation must recognize that our social world contains important elements of both market and communitarian societies."²³⁴ He concludes that "[i]t is probably too optimistic to expect reputation to be fully explained by only one justification. It is better that the influences of property, and dignity, and, to a lesser extent, honour, are acknowledged."²³⁵

Subsequent authors, like Milo, have accepted Post's original three-part approach to reputation. Other than McNamara's reservation about reputation as property, no other authors discussing Post appear to diverge from his three-part interpretation of reputation in defamation. Canadian author Bob Tarantino, writing an article, "Chasing Reputation: The Argument for Different Treatment of Public Figures in Canadian Defamation Law",²³⁶ in 2010, following his thesis work, discussed the concept of reputation from a historical perspective and commented on the approaches taken by Post.²³⁷

Tarantino noted that "defamation law has failed to keep pace with a more sophisticated understanding of reputation and the impact of mass media and interactive

²³² *Ibid.*

²³³ *Ibid* [footnotes omitted].

²³⁴ *Ibid.*

²³⁵ *Ibid.*

²³⁶ Bob Tarantino, "Chasing Reputation: The Argument for Differential Treatment of Public Figures in Canadian Defamation Law" (2010) 48 Osgoode Hall LJ 595.

²³⁷ Interestingly, Tarantino, in his "Chasing Reputation" article, did not mention Milo's book.

technologies, which makes the construction and repair of reputation markedly different from what it once was.”²³⁸ Tarantino aligned himself with the Supreme Court of Canada’s comment in *Hill v Church of Scientology of Toronto*²³⁹ that “very little has been written by the courts about that central concept [the reputation of the individual] and its constitutive elements.”²⁴⁰ In addition to *Hill*, Tarantino discusses *Grant v Torstar*²⁴¹ and *R v Lucas*²⁴² (a criminal case), but he also mentions three other Canadian civil defamation cases: *Vander Zalm v Times Publishers*,²⁴³ *WIC Radio Ltd. v Simpson*²⁴⁴ and *Quan v Casson*²⁴⁵ (all these cases are detailed and further empirically analyzed in Chapter 3). Tarantino's discussion about reputation in defamation law is rather theoretical although he moves the discussion further than Post, considering the modern technologies as dictating adjustments to law.

To date, in addition to Tarantino’s work, Post’s approach to the concept of reputation has been referred to in Canadian journals by the following authors: Chris Hunt, Katie Duke, and Megan Richardson.

²³⁸ Tarantino *supra* note 236 at 612.

²³⁹ *Hill v Church of Scientology of Toronto*, [1995] 2 SCR 1130. It is considered a major Canadian libel trial at the end of the twentieth century, representing a massive victory in the legal protection of an individual's reputation. This case is further mentioned in this chapter as well as in the following chapter.

²⁴⁰ Tarantino *supra* note 236 at 612 (Tarantino asks whether an individual's reputation is defined merely by what the common law tort of defamation protects, or whether there should be a more robust definition of reputation as a protected interest.).

²⁴¹ *Grant v Torstar Corporation*, 2009 SCC 61, [2009] 3 SCR 640.

²⁴² *R v Lucas*, [1998] 1 SCR 439 (for full history of the action see footnote 537)

²⁴³ *Vander Zalm v Times Publishers*, (1980), 109 DLR (3d) 531 (SCC).

²⁴⁴ *WIC Radio Ltd. v Simpson*, [2008] 2 SCR 420, 2008 SCC 40.

²⁴⁵ *Quan v Cusson*, 2009 SCC 62, [2009] 3 SCR 712.

Chris Hunt's 2015 article relies upon theoretical work, especially that of Post's "influential exposition of defamation,"²⁴⁶ in examining analogies between privacy and defamation. He asks "if defamation is concerned with one's *public reputation*, how can it be anchored in the values of dignity at all, since dignity is characteristically concerned with one's *private personality*?"²⁴⁷ He finds his answer in Post's discussion of reputation as dignity.

Katie Duke, in her 2016 article, notes that "[t]he meaning of 'reputation' is rarely addressed in Canadian defamation cases, despite repetition that it merits legal protection."²⁴⁸ Duke follows this observation by mentioning that "Robert Post understands the protection of reputation by defamation law as being motivated by concerns for property, honour and dignity."²⁴⁹ Duke mentions *Hill v Church of Scientology of Toronto*,²⁵⁰ *Grant v Torstar Ltd.*²⁵¹, and *WIC Radio v Simpson*²⁵² - but she does not tie it (directly) to Post's concepts on reputation.

In 2018, Megan Richardson discussed Post's work in connection with her own broad social perspective on understanding reputation in an article commenting the American case of *Garcia v Google, Inc.*²⁵³ that deals with a case not involving

²⁴⁶ Chris DL Hunt, "From Right to Wrong: Grounding a Right to Privacy in the Wrongs of Tort" (2015) 52:3 *Alta L Rev* 635 at 661.

²⁴⁷ *Ibid* [emphasis in original].

²⁴⁸ Katie Duke, "Calling a Racist a Racist: A Case for Reforming the Tort of Defamation" (2016) 37 *Windsor Rev Legal Soc Issues* 70 at 76 [footnotes omitted].

²⁴⁹ *Ibid* [footnotes omitted].

²⁵⁰ *Supra* note 239 (detailed later in this chapter, and further analyzed in Chapter 3).

²⁵¹ *Supra* note 241 (detailed later in this chapter, and further analyzed in Chapter 3).

²⁵² *Supra* note 244 (detailed later in this chapter, and further analyzed in Chapter 3).

²⁵³ *Garcia v Google, Inc.*, 78 F (3d) 733 at 745 ((9th Cir 2015) (en banc) (US)).

defamation but connecting reputation to privacy (rather personal identity).²⁵⁴ Richardson pointed to Post's focus on reputation as "the social apprehension that we have of each other."²⁵⁵ Richardson's citations to Post's discussion of reputation as dignity links Richardson's view to that of Post.

B - Other, "Non-Post," Theorizing About Reputation

Other authors have written about reputation in defamation without referring to Post's work.²⁵⁶ For example, Canadian law professor Robert Martin, in 2003, explored the balance between the competing interests of freedom of expression and protection of individuals' reputations, focusing on the protection of the reputation of journalists.²⁵⁷ He noted that the concept of reputation in defamation law has to be balanced against the concept of freedom of speech.²⁵⁸ While he did not cite to Post's article, he mentioned the case of *New York Times Co v Sullivan*²⁵⁹ in connection with the debate about whether "the defence of qualified privilege should be expanded to the point where any statement made by the mass media on any matter of public interest would attract a *Charter*-based privilege."²⁶⁰ Martin further noted that "[t]his argument was expressly and unequivocally

²⁵⁴ Megan Richardson, "A Virtual Puppet: Performance and Privacy in the Digital Age" (2018) 4 Can J of Comparative & Contemporary L 231 at 232.

²⁵⁵ *Ibid* at 242.

²⁵⁶ See for example GHL Fridman et al, *The Law of Torts in Canada*, 3rd ed (Toronto: Thomson Reuters Canada, 2010); Raymond E Brown, *Brown on Defamation supra* note 138; Erika Chamberlain & Stephen GA Pitel, eds, *Introduction to the Canadian Law of Torts*, 4th ed (Toronto: Lexis Nexis, 2020).

²⁵⁷ Robert Martin, *supra* note 131, at 143-216.

²⁵⁸ *Ibid* at 143.

²⁵⁹ *New York Times Co v Sullivan*, 376 U.S. 254 (1964). A case which Post also discusses, *supra* note 163, at 691, 721, 723, 731, 732 and 733.

²⁶⁰ Martin, *supra* note 131 (Ch 4 "Free Expression and Private Rights") at 183.

rejected by the Supreme Court in 1995 in *Hill v. Church of Scientology of Toronto*" adding that "decision, while it did not directly involve mass media, set out important conclusions about the general direction the law of defamation should take in Canada."²⁶¹

Eugene Lim points out to the 2009 Supreme Court of Canada decision in *Grant v Torstar Corporation*²⁶² "held that the law of defamation should be changed to afford greater protection to communications on matters of public interest, so as to give adequate weight to the constitutional value of free speech enshrined in section 2(b) of the *Canadian Charter of Rights and Freedoms*."²⁶³ Lim states "[i]n order to encourage debate on matters of public interest, a new defence to defamation was recognized - one that protected reliable statements made in the context of such debate, even if the statements in question were *not entirely true*."²⁶⁴ Citing to 2008 *WIC Radio Ltd v Simpson*,²⁶⁵ Lim noted that "[a] separate, but related, issue that should be considered is the extent to which responsible communication can be distinguished from the defence of fair comment, since both defences involve communications concerning the public interest."²⁶⁶

²⁶¹ *Ibid.*

²⁶² *Grant v Torstar Corporation*, *supra* note 239.

²⁶³ Eugene C Lim, "Malice, Qualified Privilege, and the New Responsible Communication Defence to Defamation Which Way Forward for Investigative Journalism in Canada" (2012) 451 UBC L Rev 223 at 227.

²⁶⁴ *Ibid* [emphasis in original].

²⁶⁵ *WIC Radio Ltd. v Simpson*, *supra* note 242.

²⁶⁶ Eugene Lim *supra* note 263 at 232.

C - Conclusion

The *Canadian Charter of Rights and Freedoms*,²⁶⁷ itself, does not mention reputation, and the question of whether someone has a reputation is an entirely separate concept from questions of freedom of expression (which is a protected right under the Charter).

Defamation law is concerned with the concept of reputation only when it is being alleged that a person's reputation is being injured. Justice Cory, in *Hill v Scientology*, said that reputation "is an attribute that must, just as much as freedom of expression, be protected by society's laws."²⁶⁸ In *WIC Radio Ltd. v Simpson*, Justice Binnie said that "the worth and dignity of each individual, including reputation, is an important value underlying the *Charter* and is to be weighed in the balance with freedom of expression, including freedom of the media."²⁶⁹ He also said that "[t]he function of the tort of defamation is to vindicate reputation."²⁷⁰ The then Chief Justice McLachlin, in *Grant v Torstar* emphasized that courts recognize that the Canadian Charter guarantees freedom of expression as "essential to the functioning of our democracy"²⁷¹ but also that this right "is not absolute",²⁷² that "[o]ne limitation on free expression is the law of defamation, which protects a person's reputation from unjustified assault."²⁷³

²⁶⁷ *Canadian Charter of Rights and Freedoms*, s 7, Part I of the *Constitution Act*, 1982, being Schedule B to the *Canada Act 1982 (UK)*, 1982, c 11.

²⁶⁸ *Hill v Church of Scientology of Toronto*, *supra* note 239 at para 107.

²⁶⁹ *WIC Radio Ltd. v Simpson*, *supra* note 244 at para 2.

²⁷⁰ *Ibid* at para 15.

²⁷¹ *Grant v Torstar Corporation*, *supra* note 241 at para 1.

²⁷² *Ibid* at para 2.

²⁷³ *Ibid*.

CHAPTER 3 - EMPIRICAL EVIDENCE OF THE MEANING OF "REPUTATION" IN CANADIAN DEFAMATION LAW

A - The Role of Statute in the Common Law Tort of Defamation in Canada

As noted in Chapter 1, across Canada (except in the civil law province of Quebec²⁷⁴) civil defamation is a common law tort.²⁷⁵ Nonetheless, aspects of defamation have been affected more recently by various provincial statutory enactments. In the early 1980s, for instance, the Uniform Law Conference of Canada began a national law reform process considering defamation law across the country.²⁷⁶ From this process, in 1994, a model “Uniform Defamation Act”²⁷⁷ was created, which the promulgators intended to serve as a model for the consideration of Canada’s common law jurisdictions. In fact, this model was eventually adopted by most Canadian common law jurisdictions: Newfoundland and Labrador,²⁷⁸ Nova Scotia,²⁷⁹ Prince Edward Island,²⁸⁰ New

²⁷⁴ In Quebec, the *Civil Code of Québec*, CQLR c CCQ-1991 applies. This thesis focuses on Canada’s common law trials: proceedings under Quebec civil law were not included in this research.

²⁷⁵ Defamatory libel prosecuted under Canada’s *Criminal Code* is discussed later in this Chapter. As the Law Commission of Ontario noted in 2017, “Ontario defamation law has developed primarily through common law supplemented by the *Libel and Slander Act* (LSA) [footnote omitted]. The elements of the tort are substantially similar in most common law jurisdictions with the exception of the United States.” Law Commission of Ontario, *Defamation Law in the Internet Age: Consultation Paper* (Toronto: November 2017) at 22, online: <lco-cdo.org/en/our-current-projects/defamation-law-in-the-internet-age/consultation-paper/>.

²⁷⁶ *Ibid.*

²⁷⁷ Available in the Uniform Law Conference of Canada/Conference sur l’uniformisation des lois au Canada, Proceedings of the Seventy-Six Annual Meeting held at Charlottetown, Prince Edward Island, August 1994, Appendix D: Uniform Defamation Act at 201. This model code failed to define what constitutes defamatory expression. See online: <<https://www.ulcc-chlc.ca/ULCC/media/Proceedings-2006-1994/1994-Charlottetown-Proceedings.pdf>>

²⁷⁸ *Defamation Act*, RSNL 1990, c D-3.

²⁷⁹ *Defamation Act*, RSNS 1989, c 122, as amended by SNS 2018, c 1 Sch A, s 104.

²⁸⁰ *Defamation Act*, RSPEI 1988, c D-5.

Brunswick,²⁸¹ Manitoba,²⁸² Alberta,²⁸³ the Northwest Territories,²⁸⁴ Nunavut,²⁸⁵ and Yukon²⁸⁶ (see Table 2, below).

Table 2: Provinces and Territories Where the ‘Uniform Defamation Act’ Adopted

Provinces and Territories that adopted the Uniform Defamation Act	Statute	Section	Expression eradicating the difference between libel and slander
Newfoundland and Labrador	<i>Defamation Act</i> , RSNL 1990, c D-3	s 2(b)	‘defamation’ means libel or slander
Nova Scotia	<i>Defamation Act</i> , RSNS 1989, c 122	s 2(b)	‘defamation’ means libel or slander
Prince Edward Island	<i>Defamation Act</i> , RSPEI 1988, c D-5	s 1(b)	‘defamation’ means libel or slander
New Brunswick	<i>Defamation Act</i> , RSNB 2011, c 139	s 1	‘defamation’ means libel or slander
Manitoba	<i>Defamation Act</i> , CCSM, c D20	s 1	‘defamation’ means libel or slander
Alberta	<i>Defamation Act</i> , RSA 2000, c D-7	s 1(b)	‘defamation’ means libel or slander
Northwest Territories	<i>Defamation Act</i> , RSNWT 1988, c D-1	s 1	‘defamation’ means libel or slander
Nunavut	<i>Defamation Act</i> , RSNWT 1988, c D-1	s 1	‘defamation’ means libel or slander
Yukon	<i>Defamation Act</i> , RSY 2002, c 52	s 1	‘defamation’ means libel or slander

Only Ontario, Saskatchewan and British Columbia did not absorb any of the model “Uniform Defamation Act” into their law (see Table 3, below).

²⁸¹ *Defamation Act*, RSNB 2011, c 139.

²⁸² *Defamation Act*, CCSM, c D20.

²⁸³ *Defamation Act*, RSA 2000, c D-7.

²⁸⁴ *Defamation Act*, RSNWT 1988, c D-1.

²⁸⁵ *Defamation Act*, RSNWT 1988, c D-1 (adopted for use in Nunavut).

²⁸⁶ *Defamation Act*, RSY 2002, c 52.

Table 3: Provinces with Sui Generis Statutes not the ‘Uniform Defamation Act’

Provinces that created unique statutes to “combine” libel and slander	Statute	Section	Expressions diminishing the difference between libel and slander
Ontario	<i>Libel and Slander Act</i> , RSO 1990, c L-12	ss 16-18 ----- ss 19-23	"In an action for slander..." ----- "In an action for libel or slander..."
Saskatchewan	<i>Libel and Slander Act</i> , RSS 1978, c L-14	ss 3-4	"In an action for libel or slander"
British Columbia	<i>Libel and Slander Act</i> , RSBC 1996, c 263	s 13(1) ----- s 13(2)	"In actions of libel and slander..." ----- "...of the alleged libel or slander..."

One change instigated by adoption into legislation in nine jurisdictions in Canada of the “Uniform Defamation Act” model was eradication of previous procedural differences that had existed between libel and slander (see Table 2 above).²⁸⁷ Although, as noted, the provinces of Ontario, Saskatchewan and British Columbia did not adopt the provisions of the model “Uniform Defamation Act” – and the terms “libel” and “slander” remain in their respective statutes – all three provinces have, nonetheless, reformed their defamation legislation and each, though somewhat differently than the other, has addressed giving libel and slander similar treatment.²⁸⁸ This chapter, therefore, will generally refer to libel and slander collectively as “defamation.”

²⁸⁷ Note that the model statute was not intended only to be procedural; it proposed substantive changes including model definitions for the terms “broadcasting”, “court”, “defamation”, “newspaper” and “public meeting.”

²⁸⁸ In Ontario, *Libel and Slander Act*, RSO 1990, c L-12, “slander” appears in ss 16-18, while the expression “libel or slander” appears in ss 19-23. In Saskatchewan, *Libel and Slander Act*, RSS 1978, c L-14, “libel or slander” appears in ss 3,4. In British Columbia, *Libel and Slander Act*, RSBC 1996, c 263, “libel and slander” is mentioned in s 13(1), while “libel or slander” appears in s 13(2).

Despite statutory modifications made to the tort of defamation across all the Canadian common law jurisdictions, this civil cause of action remains, at its core, a common law tort.²⁸⁹

B - Reputation in Canadian Defamation Law, both Civil and Criminal

In a recent consultation paper published by the Law Commission of Ontario (2017),²⁹⁰ it is noted that the common elements of the tort of defamation, across all jurisdictions (except in jurisdictions in the United States), are that

In order to make out a claim of defamation, a plaintiff must establish three things:

- that the words in issue refer to the plaintiff
- that they were published to a third party; and
- that they are defamatory in the sense that they tend to lower the plaintiff's reputation among reasonable persons in the community.²⁹¹

It is also important to the research being presented in this thesis on defamation law to note that defamation is one of the last remaining civil causes of action in Canada that can be tried either by judge and jury or by judge alone.²⁹² In 1936 in the English case

²⁸⁹ In contrast, Canada's criminal offence of defamatory libel, in s 298(1) of the *Criminal Code* (quoted in part below) is entirely statutory.

²⁹⁰ *Supra* note 275.

²⁹¹ *Ibid.* A similar formulation can be found in the Ontario case of *Hodgson v Canadian Newspapers Co.*, (1998) 39 OR(3d) 235.

²⁹² Robert Ivan Martin states that “[l]ibel actions are the last bastion of the jury in civil proceedings in Canada.” (Robert Ivan Martin, *Free Expression in Canada: Surrendered to Diversity and Multiculturalism* (Mount Vernon, Wash: Stairway Press, 2012 at 239). Note that juries are also empanelled in medical malpractice suits in Canada: see Emily Wilson, “Medical Malpractice and Jury Secrecy: Is It Time to Lift the Veil on Causation?”, online: < <https://www.cba.org/Sections/Health-Law/Resources/Resources/2020/Winner-of-the-2020Health-Law-Student-Essay-Contest> >. Unlike juries in criminal cases in Canada (where juries operate on a principle of unanimity: twelve out of twelve jurors must be convinced that the accused is guilty in order for an accused to be convicted), civil juries in Canada operate on the basis of majorities (five out of six members of a civil jury holding the defendant has libelled the plaintiff is sufficient for the plaintiff to succeed in the lawsuit). See again Martin, *Free Expression in Canada*, at 272.

of *Sim v Stretch*, Lord Atkin stated that, in determining whether a communication is defamatory:

there is no dispute as to the relative functions of judge and jury on law and fact. ... It is well settled that the **judge** must decide whether the words are *capable* [italics added] of a defamatory meaning. ... That is a question of law: is there evidence of a tort? ... If they are capable, then the **jury** is to decide whether they are *in fact* defamatory. [emphasis added]²⁹³

A key question in defamation litigation is whether the communication involved in the litigation is defamatory. A communication is said to be defamatory “if it would tend to lower the plaintiff in the estimation of right-thinking people generally,”²⁹⁴ “if it would tend to cause the plaintiff to be shunned or avoided?”²⁹⁵ or “if it would tend to expose the plaintiff to be shunned or avoided.”²⁹⁶ Robert Ivan Martin notes that

The plaintiff is only required to establish that the material at the basis of the action had that tendency. This is a remarkable feature of libel actions, as compared to other tort actions, where the plaintiff is required to prove injury. Once it is established that the material is libellous, injury to the plaintiff is assumed.²⁹⁷

As noted above, a key element in establishing whether the defendant in a civil defamation action will be liable is to establish “that [the words in issue are] defamatory in the sense that they tend to lower the plaintiff’s reputation among reasonable persons in the community.”²⁹⁸ It can be seen that the plaintiff’s reputation thus forms a key aspect of Canadian civil defamation litigation.

²⁹³ *Sim v Stretch* [1936] 2 All ER 1237 (HL), 1240; (1936) 52 TLR 669; (cited from [1936] UKHL J0722-2 at 2) [emphasis added].

²⁹⁴ Martin, *Free Expression ...*, *supra* note 292 at 239.

²⁹⁵ *Ibid* at 240.

²⁹⁶ *Ibid*.

²⁹⁷ *Ibid*.

²⁹⁸ See Martin, *Free Expression ...*, *supra* note 292 at 239.

As well as in civil defamation, reputation also plays a key part in Canadian criminal libel:

s 298(1) A defamatory libel is matter published, without lawful justification or excuse, that is likely to injure the **reputation** of any person by exposing him to hatred, contempt or ridicule or that is designed to insult the person of or concerning whom it is published [emphasis added]²⁹⁹.

Whether it is part of the function of the judge to ascertain the facts in a defamation trial because he is sitting alone, without a jury, or whether it is the function of a jury to ascertain the facts (in a defamation trial involving both judge and jury), both the fact that a publication³⁰⁰ is capable of being defamatory and that it is capable of damaging the plaintiff's reputation must be established in evidence at trial.

²⁹⁹ *Criminal Code*, RSC 1985, c C-46, s 298(1) [emphasis added]. The remainder of the Criminal Code provisions on defamatory libel are as follows:

Mode of expression

298(2) A defamatory libel may be expressed directly or by insinuation or irony

- (a) in words legibly marked on any substance; or
- (b) by any object signifying a defamatory libel otherwise than by words.

Publishing Publication

299 A person publishes a libel when he

- (a) exhibits it in public;
- (b) causes it to be read or seen; or
- (c) shows or delivers it, or causes it to be shown or delivered, with intent that it should be read or seen by any person other than the person whom it defames

Punishment of libel known to be false

300 Every person who publishes a defamatory libel that they know is false is guilty of

- (a) an indictable offence and liable to imprisonment for a term of not more than five years; or
- (b) an offence punishable on summary conviction

Punishment for defamatory libel

301 Every person who publishes a defamatory libel is guilty of

- (a) an indictable offence and liable to imprisonment for a term of not more than two years; or
- (b) an offence punishable on summary conviction

³⁰⁰ Although the classic formula quoted by the Law Commission of Ontario immediately above uses the language of “words” (as does *Hodgson v Canadian Newspapers Co.*, (1998) 39 OR(3d) 235.), defamatory publication can be in other than word format, e.g., a cartoon. (See details in Chapter 1).

Since it is only triers of fact who can establish what facts have been proven at trial, it follows that factual findings made at trial, virtually without exception, will never be disturbed by appellate bodies. However, "[w]here the trial judge's finding of law on [an] issue is appealed, the appellate court may simply substitute its opinion for that of the trial judge."³⁰¹ It has, however, been noted, in the context of defamation litigation when juries have been involved, "it is not always easy to mark the boundaries between issues of fact or decision by the jury from questions of law to be ruled on by the judge."³⁰²

C - The Conduct of Civil Defamation Trials Across Common Law Canada

The conduct of defamation actions in Canadian common law jurisdictions is governed by the laws of each jurisdiction regulating civil trials (in general), and also, procedurally, by each jurisdiction's court rules and regulations.³⁰³ Nonetheless, because of the presence of juries in defamation trials in Canada, a provision of the *Criminal Code* is also relevant to Canadian civil defamation actions because it applies to both criminal and civil jury trials.

Section 649 of Canada's *Criminal Code* provides

Every member of a jury ... who ... [except for certain purposes related to obstruction of justice under s 139 of the Code] ... discloses any information relating to the proceedings of the jury when it was absent

³⁰¹ Roger D McConchie & David A Potts, *Canadian Libel and Slander Actions* (Toronto: Irwin Law, 2004) at 295.

³⁰² *Gatley on Libel and Slander*, 11th ed by Patrick Milmo & W.V.H. Rogers (London, UK: Sweet & Maxwell, 2008) (Ch 36: The Trial: Functions of Judge and Jury) 36.2 at 1242.

³⁰³ The conduct of trials for criminal libel is governed by the *Criminal Code*. About civil juries across Canadian provinces and territories see "The Civil Jury Elsewhere in Canada" in British Columbia Law Institute, *Civil Juries in British Columbia: Anachronism or Cornerstone of the Civil Justice Process?* (Vancouver: The University of British Columbia, 2021) at 14.

from the courtroom that was not subsequently disclosed in open court is guilty of an offence punishable on summary conviction.³⁰⁴

The Supreme Court has confirmed that this provision also applies to juries in civil matters.³⁰⁵ Chris Richardson and Romaine Smith Fullerton, in their book about what journalists should know when covering Canadian criminal cases, quoted long-time *Globe and Mail's* Timothy Appleby:

Canada is a very different environment than America. One of the things I think is really great in this country is our jury system. It's absolutely off limits. It's *illegal* if jurors even talk about what they've discussed in their deliberations."[italics in the original]³⁰⁶

In Newfoundland and Labrador, the *Defamation Act* explicitly addresses the conduct of defamation actions. The statute reads as follows: "An action for defamation shall be tried in the Trial Division before a **judge** or before a **judge and jury**."³⁰⁷ [emphasis added]. A civil jury in Newfoundland and Labrador consists of six jurors³⁰⁸. If the verdict is not reached after three hours of deliberation, five jurors may return a verdict.³⁰⁹

In Nova Scotia, in the *Judicature Act* (not in the *Defamation Act*) it says unless the parties in person or by their counsel or solicitors consent to a trial of the issues of fact or the assessment or inquiry of damages without a

³⁰⁴ *Criminal Code*, *supra* note 297, s 649.

³⁰⁵ *Danis v Saumure* [1956] SCR 403.

³⁰⁶ Chris Richardson & Romaine Smith Fullerton, "'I Sleep Really Well at Night': The *Globe and Mail's* Timothy Appleby on Covering Thirty Years of Grief" (Ch 6) in Chris Richardson & Romaine Smith Fullerton, *Covering Canadian Crime: What Journalists Should Know and the Public Should Question* (Toronto: U of T Press, 2016) 100 at 101

³⁰⁷ *Defamation Act*, RSNL 1990, c D-3, s 7 [emphasis added].

³⁰⁸ *Jury Act*, 1991, SNL 1991, c 16, s 31.1(1).

³⁰⁹ *Ibid*, ss 31.1(1), (2).

jury, the issues of fact shall be tried with a jury in the following cases: (i) where the proceeding is an action [among other] for libel, slander.³¹⁰

In Nova Scotia, a civil jury consists of seven jurors, of whom any five may return a verdict.³¹¹

In Prince Edward Island, the *Jury Act* states that "a party may, by filing a jury notice in accordance with the rules of court, require that the issues of fact be tried or the damages assessed, or both, by a jury, unless otherwise provided."³¹² However, the statute goes on to list actions that "shall be heard without a jury"³¹³ and this list does not mention defamation actions. However, the statute further says that "[o]n application, the court may order that the issues of fact be tried or damages assessed, or both, without a jury."³¹⁴ In Prince Edward Island, a civil jury consists of seven jurors.³¹⁵ If the jury deliberates for at least three hours without reaching unanimity, five jurors may return a verdict.³¹⁶

In New Brunswick, according to the *Rules of Court*, "[i]f the questions in issue in an action are more fit (1) for trial by a jury than by a judge, the court may, on motion by any party, order trial by jury."³¹⁷ Further, the *Rules of Court* says that "[a]n action for (a) libel, (b) slander ... shall be tried by jury if a party, not less than 14 days before the Motions Day at which the action is to be set down for trial, serves on every other party

³¹⁰ *Judicature Act*, RSNS 1989, c 240, s.34(a)(i).

³¹¹ *Juries Act*, SNS 1998, c 16, s 15(2).

³¹² *Jury Act*, RSPEI 1988, c J-5.1, s 3(1).

³¹³ *Ibid*, s 3(2).

³¹⁴ *Ibid*, s 3(3).

³¹⁵ *Ibid* s 24.

³¹⁶ *Ibid*.

³¹⁷ *Rules of Court*, NB Reg 82-73, Rule 46.01(1).

and files with the clerk a Jury Notice (Form 46A) requiring trial by jury."³¹⁸ A civil jury in New Brunswick consists of seven jurors.³¹⁹ After deliberating for at least three hours without decision, five jurors may return a verdict.³²⁰

In Ontario, the *Courts of Justice Act* provides that "[i]n an action in the Superior Court of Justice that is not in the Small Claims Court, a party may require that the issues of fact be tried or the damages assessed, or both, by a jury, unless otherwise provided."³²¹ In addition, according to Regulation 194 of the Rules of Civil Procedure,

[a] party to an action that is proceeding under this Rule may deliver a jury notice under rule 47.01 if the action involves a claim for relief arising from one of the following: 1. **Slander**, 2. **Libel**, 3. Malicious arrest, 4. Malicious prosecution, 5. False imprisonment. O. Reg 344/19, s. 4³²² [emphasis added].

In Ontario, a civil jury consists of six jurors.³²³ Five jurors may return a verdict.³²⁴

In Manitoba, the *Court of Queen's Bench Act* says "[a]n action for defamation, malicious arrest, malicious prosecution or false imprisonment shall be tried with a jury, unless the parties waive trial with a jury."³²⁵ In Manitoba, a civil jury consists of six

³¹⁸ *Ibid* Rule 46.01(2).

³¹⁹ *Jury Act*, RSNB 2016, c 103, s 15.

³²⁰ *Ibid* s 18(1).

³²¹ *Courts of Justice Act*, RSO 1990, c C43, s 108(1).

³²² RRO 1990, Reg. 194: Rules of Civil Procedure, s 76.02.1(2). (Note: Rule 76 applies to simplified procedure) [emphasis added].

³²³ *Courts of Justice Act*, *supra* note 318, s 108(4).

³²⁴ *Ibid* s 108(6).

³²⁵ *Court of Queen's Bench Act*, CCSM c C280, s 64(1).

jurors.³²⁶ Five jurors may return a verdict.³²⁷ In cases where parties agree to trial by five jurors, instead of six, the verdict must be unanimous.³²⁸

In Saskatchewan, "[a]ny party may demand a jury in accordance with The Queen's Bench Rules in an action: (a) for libel, slander, malicious arrest, malicious prosecution or false imprisonment."³²⁹ In Saskatchewan, a civil jury consists of six jurors, five of whom may return a verdict.³³⁰

In Alberta, the *Jury Act* specifies in s 17(1):

Subject to subsections (1.1) and (2), on application by a party to the proceeding, the following shall be tried by a jury: (a) an action for defamation, false imprisonment, malicious prosecution, seduction or breach of promise for marriage.³³¹

Further, the statute says

[i]f, on an application made under subsection (1) [quoted above] or on a subsequent application, a judge considers it appropriate, the judge may direct that the proceeding be tried by judge alone pursuant to the summary trial procedure set out in the Alberta Rules of Court.³³²

In Alberta, a civil jury consists of six jurors, five may return a verdict.³³³

³²⁶ *Jury Act*, CCSM c J30, s 32(1).

³²⁷ *Ibid* s 32(2).

³²⁸ *Ibid* s 32(3).

³²⁹ *Jury Act*, SS 1998, c J-4.2, s 18(1).

³³⁰ *Ibid* s 16.

³³¹ *Jury Act*, RSA 2000, c J-3, s 17(1)(a).

³³² *Ibid* s 17(1.1).

³³³ *Ibid* ss 13(1), (2).

In British Columbia, the general rule is that a civil action in the Supreme Court is to be tried without a jury unless a party files a jury notice³³⁴ but a further rule states that "[the] Court may refuse [a] jury trial except in cases of defamation, false imprisonment and malicious prosecution."³³⁵ A civil jury consists of eight jurors.³³⁶ The judge of the court may receive the verdict of six jurors (75%) in case where the jury could not reach a unanimous verdict after 3 hours of deliberation.³³⁷

In the Northwest Territories, in civil matters, in the s 2 (1) of the *Jury Act*, it says that "Where, in any action (a) of libel, slander, false imprisonment, malicious prosecution or breach of promise of marriage, (b) founded on a tort or contract in which the amount claimed exceeds \$1,000, or (c) for the recovery of real property, either party to the action applies to the Court, not less than two weeks before the time fixed for the trial of the action before a jury, the action shall, ... be tried before a jury, but in no other case shall an action be tried before a jury".³³⁸ The *Jury Act* also says that "in any action of a class specified in subsection (1) [i.e., libel, slander] ... it appears to a judge ... that the trial will involve any prolonged examination of documents or accounts ... that, in the opinion of the judge cannot conveniently be made by a jury, the judge may direct that the action be tried without a jury or that the jury be dismissed in which case the action shall be tried or

³³⁴ *Supreme Court Civil Rules*, BC Reg. 168/2009, Rr. 12-6(1), (3). Note: a subrule 0.1 was added to this regulation that there will be no jury trials starting 28 September 2020 and ending on 7 October 2022 (concerning the backlog of cases caused partly due to the Covid-19 pandemic).

³³⁵ *Ibid* Rr. 12-6(5).

³³⁶ *Jury Act*, RSBC 1996, c 242, s 20.

³³⁷ *Ibid* s 22.

³³⁸ *Jury Act*, RSNWT 1988, c J-2, s 2(1).

the trial continued, as the case may be, without a jury."³³⁹ In the Northwest Territories, a civil jury consists of six jurors, though five can return a verdict.³⁴⁰

Nunavut has adopted the procedural legislation of the Northwest Territories for civil actions.³⁴¹ In Nunavut, a civil jury consists of six jurors, and any five can return a verdict.³⁴²

The Yukon has legislated civil trials in much the same way as the Northwest Territories (and, consequently, Nunavut).³⁴³ The difference in the Yukon is that "either party to the action [can apply] to the Supreme Court, not less than 90 days before the time set for the trial of the action before a jury, the action shall, ... be tried before a jury, but in no other case shall an action be tried before a jury."³⁴⁴ In the Yukon, a civil jury consists of six jurors, and any five of them can return a verdict.³⁴⁵

In summary, in all the common law jurisdictions in Canada, a defamation action can be tried either before a judge or before a judge and jury (the procedures vary depending on the parties' consent, the applications filed with the court, and the trial judge's opinion about the most proper conduct for the specific case). In defamation jury trials, the jury's role is limited to establishing whether a publication concerning the plaintiff, in fact, is defamatory, and to assessing what damages the plaintiff should be

³³⁹ *Ibid* s 2(2).

³⁴⁰ *Ibid* s 22(1).

³⁴¹ *Ibid*. Adopted in Nunavut by the *Nunavut Act*, SC 1993, c 28, s 29 [the statute establishing Nunavut].

³⁴² *Ibid* s 26(1).

³⁴³ *Jury Act*, RSY 2002, c 129, ss 2(1), 2(2).

³⁴⁴ *Ibid* s 2(1).

³⁴⁵ *Ibid* s 25(1).

awarded to compensate for the harm the defamatory publication could have caused to the plaintiff's reputation.³⁴⁶

The question of whether a defamation trial is conducted with or without a jury is important to this study – particularly because of its focus on the concept of reputation in defamation. Whether a plaintiff has a reputation that deserves legal protection (in a civil trial) or whether a person has a reputation such that the state needs to step in and protect the public from the person alleged to have uttered the libel (in a criminal case) is a question of fact.³⁴⁷ Where a jury is involved in a defamation trial, the jury will make that determination of fact – and, as noted above, that determination cannot be further investigated because jury decisions are secret. Where there has been a jury trial, therefore, to the extent that the reported decisions concerning the trial (written by the trial judge and, in the case of appeals, appellate judges) can only speculate and theorize in their judgments about what the jury's finding was on the topic of reputation (although these judges are not required to speculate on this topic).³⁴⁸ Where there has been a trial by judge alone, the reported decision can report the judge's findings of fact concerning

³⁴⁶ See, for instance, the *Jury Act*, RSNWT 1988, c J-2, s 6:

Where an action for defamation is tried with a jury, the jury may give a general verdict on the whole matter ... but the presiding judge shall, according to his or her discretion, give his opinion and directions to the jury on the matter in issue as in other cases and the jury may on that issue give a special verdict if they think fit to do so.

See Appendix A for details about the role of juries in deliberating about a "general or special verdict" in defamation statutes in all territories and provinces.

³⁴⁷ In a criminal libel, the person libelled becomes a witness for the Crown: the Crown is the party taking the proceeding against the person alleged to have uttered the libel.

³⁴⁸ Even the judge presiding in a defamation case involving a jury is not privy to any details of the jury's deliberations. See again *Criminal Code*, *supra* note 299, s 649.

reputation³⁴⁹-- but, as will be discussed below, in no cases studied was any such comment actually made by any judge.

In a civil defamation action in Canada's common law jurisdictions,³⁵⁰ it is first required that the plaintiff establish the libel:

[i]n the interpretive step, the court must determine exactly what the statement attributes to the plaintiff. In the evaluative step, the court must determine whether the statement, as properly interpreted and understood, has the tendency to harm the plaintiff's reputation."³⁵¹

It is the role of the judge to determine whether the allegedly defamatory publication is capable of being defamatory. As Hilary Young has noted, "[d]efamation is an unusual tort: it is strict liability"³⁵² in that "[i]ntent is required for the publication element, but only intent to convey – knowledge of the contents is not required"³⁵³ and "plaintiffs need not prove actual injury to their reputations in order to be entitled to damages."³⁵⁴

Once publication of controversial material has been established, the burden of proof shifts to the defendant. If, for instance, the defendant can establish that what is alleged to be defamatory is true, the plaintiff cannot succeed in the defamation action.

Besides establishing the truth of an alleged libel or slander, there are other defences that

³⁴⁹ For this reason, analysis of relevant Canadian cases below has been split between those at trial involving a judge sitting alone and those at trial where both judge and jury were involved.

³⁵⁰ Karen Eltis notes, in "Is 'Truth-telling' Decontextualized Online Still Reasonable? Restoring Context to Defamation Analysis in the Digital Age" (2018) 63:3/4 McGill LJ 553 at 573, that "[u]nlike the common law, Quebec civil law does not, strictly speaking, recognize any defences to defamation, other than the absence of fault or causation." The differences in approach to defamation under Quebec's civil law and in the common law jurisdictions of the rest of Canada is the reason this thesis does not include analysis of Quebec except in respect of criminal law (which is applicable to the entire country).

³⁵¹ Allan Miller & Ronen Perry, "A Group's a Group, No Matter How Small: An Economic Analysis of Defamation," (2013) 70(4) Washington & Lee L R 2269-2336, at 2271, footnotes omitted.

³⁵² Hilary Young, *supra* at note 162 at 593.

³⁵³ *Ibid* at footnote 4.

³⁵⁴ *Ibid* at 593.

can be established by the defendant which will defeat the plaintiff in a defamation action, including the defences of fair comment, justification, absolute privilege, qualified privilege and responsible communication.³⁵⁵

Speaking of defamation in early nineteenth century Nova Scotia, Lyndsay Campbell found that “[i]n both civil and criminal actions, the defense had the complicated side of the case; it was in the defenses that evolving understandings of the needs of freedom of expression and of the press were expressed.”³⁵⁶

From modern Canadian data, Hilary Young found that liability was established (the defendants were unsuccessful) in 52% of the 145 final judgments identified in Canadian defamation cases between 1973 and 1983. On the other hand, between 2003 and 2013, she found that the plaintiffs were successful in only 28% of the 480 final judgments identified.³⁵⁷ Young found that 11% of Canadian defamation cases between 1973 and 1983 were unsuccessful because the statement was found not defamatory or was justified – and, between 2003 and 2013, that proportion was 14% unsuccessful because the publication was not defamatory or there were inadequate pleadings. These findings support, in the case of modern defamation litigation, Campbell’s comment from the nineteenth century about the burden that falls upon the defence in defamation actions: by far the majority of successes for the defence in modern defamation litigation still come through defences which require the defence, rather than the plaintiff, to adduce the majority of the evidence.

³⁵⁵ *Ibid* at 625-6.

³⁵⁶ Lyndsay M Campbell, *Truth and Privilege: Libel Law in Massachusetts and Nova Scotia, 1820-1840* (Cambridge: Cambridge University Press, 2022) at 9-10.

³⁵⁷ Young, *supra* note 162 at 605.

In a finding not incompatible with Campbell's observation about the role of the defence in nineteenth century Nova Scotian defamation actions, Young found that where Canadian defendants were successful in both the twentieth and twenty-first century periods she examined, the largest proportion of cases involved the defence of qualified privilege³⁵⁸ (34% of cases between 1973 and 1983 and 21% of cases between 2003 and 2013).³⁵⁹

D - The Role of Statute with Respect to Reputation in Defamation

The term "reputation" has not been defined in any defamation statute in any Canadian common law jurisdiction, despite the fact that defamation actions are known to protect reputation.³⁶⁰ Indeed, across all the defamation statutes in common law Canada, the term "reputation" appears only in the *Defamation Act* of Nova Scotia³⁶¹ and in the *Libel and Slander Act* of Ontario³⁶² (in both provinces, in provisions dealing with the defendant's defence of justification). In Nova Scotia, the *Defamation Act* provides as follows:

s 9 Justification

In an action for defamation in respect of words containing two or more distinct charges against the plaintiff, a defence of justification shall not fail by reason only that the truth of every charge is not proved if the words not proved to be true do not materially injure the plaintiff's

³⁵⁸ Cases in which the person alleged to have defamed another had a duty to make the statement at issue and did so without malice.

³⁵⁹ Young, *supra* at note 162 at 625.

³⁶⁰ See, for instance, Roger D McConchie & David A Potts, *Canadian Libel and Slander Actions* (Toronto: Irwin Law, 2004) at 1 ("The gist of the cause of action for libel or slander is injury to reputation. In the common law provinces and three northern territories, the tort is firmly rooted in centuries of English jurisprudence and is largely unaltered by statute.")

³⁶¹ *Defamation Act*, RSNS 1989, c 122, s 9.

³⁶² *Libel and Slander Act*, RSO 1990, c L-12, s 22.

reputation having regard to the truth of the remaining charges.
[emphasis added]

In Ontario, the *Libel and Slander Act* provides as follows:

s 22 Justification

In an action for libel or slander for words containing two or more distinct charges against the plaintiff, a defence of justification shall not fail by reason only that the truth of every charge is not proved if the words not proved to be true do not materially injure the plaintiff's **reputation** having regard to the truth of the remaining charges.
[emphasis added]

As can be seen, there is no statutory definition of the concept of reputation created through either of these two statutory appearances of the term "reputation."

E - Civil Defamation Cases Analyzed for their Focus on Reputation

(a) Analytic strategy

For the analysis of Canadian defamation jurisprudence that follows, the guiding principle in reporting on the cases was the mention of the term "reputation."³⁶³ Both cases tried in the first instance by judge alone and cases tried by judge and jury are included. Across the selected cases, the alleged defamatory statements appeared in various formats, including newspapers, non-textual publications, broadcasting, and the Internet.

In terms of the presentation of the jurisprudence in this chapter, it is important to recall that defamation trials in common law Canada can be conducted either by judge

³⁶³ This research focused on finding Canadian defamation cases where the term "reputation" was mentioned in the judgments. In addition, this research examined Canada's major defamation cases (those brought before the Supreme Court of Canada). Two digital databases (Westlaw and CanLII) were searched and those searches confirm the fact that the legal decisions analyzed here, together, include those containing discussion of 'reputation', including the most cited defamation decisions dealing with reputation.

alone or by a judge sitting with a jury. When defamation trials are conducted with a jury in Canada, the judge (whose role is to instruct the jury) almost invariably writes reasons for decision – but, as noted earlier, no information about how the jurors reach their findings can become of thesis reasons because jury deliberations cannot become public. On the other hand, in defamation actions conducted before a judge alone, it is the role of that trial judge to determine the facts about the plaintiff's reputation – and the judges are not barred from discussing in their judgments how they come to their findings.

The cases to be examined that were decided by a judge sitting alone will be presented first, namely *Vander Zalm*,³⁶⁴ *WIC Radio*,³⁶⁵ and *Crookes*.³⁶⁶ *Vander Zalm* was subsequently appealed to the British Columbia Court of Appeal,³⁶⁷ *WIC Radio* was ultimately appealed to the Supreme Court of Canada, as was *Crookes*.³⁶⁸

³⁶⁴ *Vander Zalm v Times Publishers*, *supra* note 243 (Reasons for judgment delivered by Chief Justice Nemetz and each Seaton, Hinkson, Craig, Aikins, JJA), reversing (1979), 96 DLR (3d) 172 Justice Munroe, who had held for the plaintiff) [*Vander Zalm* 1980].

³⁶⁵ *WIC Radio Ltd. v Simpson*, *supra* note 244 (Justice Binnie delivered the reasons for judgment for himself, Chief Justice McLachlin, and Justices Bastarache, Deschamps, Fish, Abella and Charron (paras 1-65); Justice LeBel delivered partly concurring reasons (paras 66-107); Justice Rothstein also delivered partly concurring reasons (paras 108--112)) [*WIC Radio* 2008].

³⁶⁶ *Crookes v Newton*, 2011 SCC 47, [2011] 3 SCR 269 (Abella J delivered reasons for judgment for Binnie, LeBel, Charron, Rothstein and Cromwell JJ. Concurring; Chief Justice McLachlin and Fish J. joint concurring reasons; Deschamps J. reasons concurring in the result) [*Crookes* 2011].

³⁶⁷ *Vander Zalm* 1980 *supra* note 243.

³⁶⁸ *WIC Radio* 2008 *supra* note 365 and *Crookes* 2011 *supra* note 366.

The cases that will be discussed second were tried by judge and jury: *Currie*,³⁶⁹ *Gouzenko*,³⁷⁰ *Hill*,³⁷¹ *Grant*,³⁷² and *Quan*.³⁷³ *Currie* was appealed to the Ontario Court of Appeal³⁷⁴; *Gouzenko*, *Hill*, *Grant*, and *Quan* were ultimately all appealed to the Supreme Court of Canada.³⁷⁵

(b) Civil defamation cases tried before a judge alone

*Vander Zalm v Times Publishers*³⁷⁶

In this case, the defamatory communication involved a public figure, and the defamatory communication was published in a daily newspaper,³⁷⁷ this time in a non-textual format.³⁷⁸

³⁶⁹ *Currie v Preston and Wilson*, [1928, Supreme Court of Ontario, Toronto] [*Currie* 1928].

³⁷⁰ *Lefolii et al. v Gouzenko*, [1969] SCR 3 (the judgment of Justices Martland, Ritchie and Hall was delivered by Justice Hall; Justice Spence concurred with Justice Hall; Justice Judson dissented [*Gouzenko* 1969])

³⁷¹ *Hill v Church of Scientology of Toronto*, [1995] 2 SCR 1130 (The judgment of La Forest, Gonthier, Cory, McLachlin, Iacobucci and Major JJ. was delivered by Cory J for the majority; Per L'Heureux-Dubé J: Cory J.'s reasons were generally agreed with, except with respect to the scope of the defence of qualified privilege) [*Hill* 1995].

³⁷² *Grant v Torstar Corporation*, 2009 SCC 61, [2009] 3 SCR 640 (Chief Justice McLachlin delivered the judgment for Binnie, LeBel, Deschamps, Fish, Charron, Rothstein and Cromwell JJ; concurring reasons, Abella J.) [*Grant* 2009].

³⁷³ *Quan v Cusson*, 2009 SCC 62, [2009] 3 SCR 712 (Reasons or judgment delivered by Chief Justice McLachlin, Binnie, LeBel, Deschamps, Fish, Charron, Rothstein and Cromwell JJ concurring (paras 1-51) Justice Abella concurring reasons (para 52) [*Quan* 2009].

³⁷⁴ Robert J Sharpe, *The Last Day, The Last Hour: The Currie Libel Trial* (Toronto: University of Toronto Press, Osgoode Society for Canadian Legal History, 2009), ch 14 "Appeal".

³⁷⁵ *Gouzenko* 1969, *supra* note 368; *Hill* 1995, *supra* note 239; *Grant* 2009, *supra* note 241; *Quan* 2009, *supra* note 245.

³⁷⁶ *Vander Zalm* 1980, *supra* note 243.

³⁷⁷ The *Victoria Times* is a daily newspaper of the City of Victoria, in British Columbia.

³⁷⁸ The defamatory publication was a political cartoon published in the British Columbia newspaper the *Victoria Times* on 22 June 1978.

In 1978, the *Victoria Times* (a daily newspaper of the City of Victoria) published a political cartoon drawn by Robert Bierman depicting William N Vander Zalm, Minister of Human Resources in British Columbia (as he then was, though the cartoon character only had “Human Resources” on the nametag, not the name of the Minister), "engaged in plucking the wings from a fly."³⁷⁹

Vander Zalm brought this libel action against the newspaper, the editor, the publisher and the author (Mr. Bierman), claiming that the published cartoon depicted him as "a person of cruel and sadistic nature who enjoys inflicting suffering and torture on helpless beings who cannot protect themselves."³⁸⁰

Justice Monroe heard the matter at trial.³⁸¹ The defendant pleaded that the cartoon was not defamatory, and that in any event it was a fair comment. Justice Munroe referred to the statement of defence:

The statement of defence pleads that the cartoon was intended to and did depict the plaintiff as a person who, in his role as Minister, acted on occasion in a cruel and thoughtless manner, and at times performed the duties of his office in such a way as to inflict suffering on those who in some instances were unable to protect their own interests. As such, the defendants rely upon the plea of fair comment, made without malice, on a matter of public interest. **The defence of fair comment cannot prevail if the facts on which comment is made are untrue and defamatory.** [emphasis added]³⁸²

³⁷⁹ *Vander Zalm* 1980, *supra* note 243. The cartoon is reproduced in Justice Aikins’ reasons for judgment at 3.

³⁸⁰ *Ibid* (Reasons for judgment by Chief Justice Nemetz, at 2).

³⁸¹ *Ibid*. Nemetz, CJ, noted on appeal "[t]he action was heard by Munroe, J., sitting without a jury." (Reasons for judgment by Chief Justice Nemetz, at 2).

³⁸² *Vander Zalm v Times Publishers*, (1979), 96 DLR (3d) 172 (Justice Munroe, judgment for the plaintiff, at 173-174) at 173. [*Vander Zalm* 1979].

Justice Munroe found, about the plaintiff's character³⁸³: "upon the evidence I find that the controversial statements made by the plaintiff and relied upon by the defendants were such that he [Vander Zalm, the plaintiff] was entitled to hold and to express."³⁸⁴ Further in his judgment, Justice Monroe said that the cartoon "was a false misrepresentation of the character of the plaintiff, as a person or in his role as a Minister."³⁸⁵

Justice Munroe held that

... the cartoon was defamatory because in the natural and ordinary meaning that viewers would attribute to it, it meant and would be understood to mean that the plaintiff is a person of a cruel and sadistic nature who enjoys inflicting suffering on helpless persons, said false pictorial representation adversely affecting and lowering his [Vander Zalm's] **reputation** and standing in the estimation **of right-thinking members of society** generally by exposing him to hatred, contempt or ridicule, and disparaging him in his office as Minister of Human Resources and upon the evidence I find that the cartoon was not objectively a fair comment upon facts.³⁸⁶[emphasis added]

In writing his reasons for decision, Justice Munroe portrayed the plaintiff as the holder of a public office, advancing his career in government, though also as a family man and a father:

The plaintiff, a nurseryman by occupation, was first elected to public office as an alderman in the Municipality of Surrey. Thereafter he served as mayor of that municipality for six years. He was elected to the Provincial Legislature in 1975 and served as Minister of Human Resources from December, 1975 until December, 1978. He is still a

³⁸³ Distinguishing between the character of an individual and an individual's reputation (the perception of that individual by others) is a difficult task for a judge or jury deciding questions of defamation. This is particularly the case because a person's "character" and a person's "reputation" cannot always be clearly distinguished. A characteristic such as 'honesty' can be related to a person's character or reputation or to both: meanings can overlap. (See also Brown, *Defamation Law*, *supra* note 154 at 6-7, footnote 20).

³⁸⁴ *Vander Zalm v Times Publishers* (1979), *supra* note 382 at 173-174.

³⁸⁵ *Ibid* at 173.

³⁸⁶ *Ibid* at 175 [emphasis added].

member of the Provincial Legislature and Executive Council thereof. He is a married man and the father of four children.³⁸⁷

Having found for the plaintiff, Justice Munroe assessed damages "for the loss of **reputation** suffered by the plaintiff as a result of the defamatory cartoon."³⁸⁸ He noted that

[s]ince the plaintiff's principal purpose in bringing this suit is the **vindication of his reputation** rather than a large monetary award, ... a modest award will meet the ends of justice, notwithstanding the refusal of the defendants to comply with the request for an apology.³⁸⁹

Justice Monroe's judgment was appealed. In 1980, the Court of Appeal for British Columbia (Chief Justice Nemetz and Justices Seaton, Hinkson, Craig and Aikins) allowed the appeal and dismissed the action, reversing the judgment of the trial judge, though each of the five appeal justices hearing the appeal wrote his own reasons.³⁹⁰ Chief Justice Nemetz decided that the three elements establishing the defence of fair comment (truth, public interest and an honest expression) should prevail in this case.³⁹¹ The controversy seemed to be, at least in part, about whether the "reputation" at issue was that of the man or of the man in his position as Minister. Justice Aikins agreed "that the defamation found by the trial judge is of the respondent [Vander Zalm] as a person, not of the respondent in his role as Minister of Human Resources."³⁹² (Recall that the trial

³⁸⁷ *Ibid* [emphasis added].

³⁸⁸ *Ibid* [emphasis added].

³⁸⁹ *Ibid* [emphasis added]. Justice Munroe assessed the damages for the plaintiff "at the sum of \$3,500." (at 176)

³⁹⁰ *Vander Zalm v Times Publishers* (1980), *supra* note 243, reversing *Vander Zalm v Times Publishers*, *supra* note 380. Chief Justice Nemetz wrote at paras 1-13, Justice Seaton wrote at paras 14-23, Justice Hinkson wrote at paras 24-49, Justice Craig wrote at paras 50-69, and Justice Aikins wrote at paras 70-90.

³⁹¹ *Ibid*. Reasons for judgment by Chief Justice Nemetz at para 7.

³⁹² *Ibid*. Justice Aikins' reasons for judgment at para 75.

judge, Justice Munroe, considered that the cartoon "was a false misrepresentation of the character of the plaintiff, as a person or in his role as Minister.")³⁹³ All five appeal judges agreed there was defamation but also found that the defence of fair comment nonetheless applied.

It may be noted that Justice Craig, in his own reasons for judgment in the Court of Appeal, referred to evidence provided by the appellants (the defendants at trial) that was intended to demonstrate that the respondent on appeal (plaintiff at trial, Vander Zalm) had a reputation as a controversial politician:³⁹⁴ a list of 16 "[p]articulans of the facts upon which the Defendants plead fair comment"³⁹⁵ This list focused solely on how Vander

³⁹³ *Vander Zalm v Times Publishers* (1979), *supra* note 382 at 173 [emphasis added].

³⁹⁴ *Vander Zalm v Times Publishers* (1980) *supra* note 243. Justice Craig, citing to the statement of the defendants in his reasons for judgment at para 52.

³⁹⁵ *Ibid.*:

6. a. That the Plaintiff, within hours of being appointed Human Resources Minister in December, 1975, stated that he would develop ways of dealing with welfare recipients who refused to 'pick up their shovels'.
- b. That the Plaintiff, since assuming the role of Minister of Human Resources, has cut off funding for a number of community groups that had been providing valuable services for those in need.
- c. That the Plaintiff, in March 1976, made statements to a group of women to the effect that women make better homemakers than they do plumbers or electricians.
- d. That in March, 1976, the Plaintiff threatened to scrap all provincial day-care programs if unionized staff engaged in strikes or labour disturbances.
- e. That in March, 1976, the Plaintiff tightened regulations so that fewer people in British Columbia would be classified as handicapped and so be eligible for handicapped benefits.
- f. That in April, 1976, the Plaintiff tightened regulations so that persons refused jobs because of unsuitable grooming or attire could be cut off welfare.
- g. That in April, 1976, the Plaintiff changed welfare policies to make it much more difficult for persons waiting for unemployment cheques to receive welfare on the grounds that this change would encourage persons affected to complain to Unemployment Insurance Commission to improve their efficiency.
- h. That in May, 1976, the Plaintiff introduced an assets test for those receiving Mincome supplements, making Mincome a variation of welfare instead of a separate program for seniors.
- i. That in September, 1976, the Plaintiff stated he was looking into the problems caused by newly arrived immigrants to Canada going on welfare, Mincome and other programs.
- j. That in January, 1977, the Plaintiff stated that legal aid subsidies to help people getting divorces was 'garbage' and worked against goals of keeping families together.
- k. That in February, 1977, the Plaintiff deliberated for several days before deciding whether a man injured in a criminal attack would be allowed to keep the \$300.00 awarded him by

Zelm performed his duties in his public role as the Minister of Human Resources of the Government of British Columbia.

Ultimately the five justices of the Court of Appeal, while each writing separate reasons, concurred in the result and reversed the judgment of Justice Monroe at trial, pointing out that the publication, the political cartoon, was a "fair comment" directed to the Vander Zalm's public rank and therefore not defamatory in such a sense as to cause harm to Vander Zalm's reputation as a person.

*WIC Radio Ltd. v Simpson*³⁹⁶

This case concerned Kari Simpson, a British Columbia social activist who took the Rafe Mair, a radio show host, and the radio show's broadcaster WIC Radio Ltd., to court claiming an editorial aired in 1999 was defamatory.

In this editorial, Mair portrayed Simpson, who protested schools in BC hiring gay teachers and introducing books about gay lifestyle, as someone who, as Mair said, "placed herself [Simpson] alongside skinheads and the Klu Klux Klan ... not talking about the violent aspects of those groups but the philosophical parallels to other examples

the Criminal Injuries Compensation Board or whether it would be deducted from his welfare payments.

- l. That in October, 1977, the Plaintiff stated that young people should be denied assistance because they have more mobility to find jobs.
- m. That in January, 1978, the Plaintiff ordered that even emergency welfare aid be refused to persons in areas where the picking of hallucinogenic mushrooms is common.
- n. That in March, 1978, the Plaintiff suggested that the current level of unemployment Insurance payments to single people should be reduced.
- o. That in May, 1978, the Ministry of Human Resources announced that it was considering a Plan of requiring persons helped by counselling and social work through the Ministry to pay a fee for the service.
- p. That in June, 1978, the Plaintiff commented that native Indians in Vancouver should return to their reserves because there was 'more opportunity' there for them.

³⁹⁶ *WIC Radio Ltd. v Simpson* [2008], *supra* note 244.

of intolerance."³⁹⁷ Simpson (the plaintiff) took the position that those words (just quoted), and similar language in other parts of Mair's broadcast, "were defamatory according to their ordinary and natural meaning."³⁹⁸ At trial, Madam Justice Koeningsberg found that the plaintiff Simpson

had a significant public profile before the alleged defamation ... [and that] ... she had a **public reputation** as a leader of those opposed to schools teaching acceptance of a gay lifestyle. Simpson's **reputation** was earned as a result of her very public actions and words. [emphasis added]³⁹⁹

She also said that

[t]he parties agree that the law requires that allegedly defamatory statements must be viewed objectively and from the point of view of what a **reasonable and right thinking reader or listener** would have understood from the words read or spoken.[emphasis added]⁴⁰⁰

Madam Justice Koeningsberg went on to say that "[t]he ordinary and natural meaning of the words guides the determination whether the statements are capable of bearing a defamatory meaning."⁴⁰¹ Further, she stated that

[i]t is not necessary to prove that the words would be understood in a defamatory sense by everyone who hears them or that the words had an **actual effect on the person's reputation**, as long as a **reasonable person**⁴⁰² to whom they were published would understand them in a defamatory sense." [emphasis added]⁴⁰³

However, Madam Justice Koeningsberg found most of the sentences in the editorial which the plaintiff claimed were facts were "statements of opinion." Commenting on the

³⁹⁷ *Simpson v Mair and WIC Radio Ltd.*, 2004 BCSC 754 at para 6(d) [*WIC Radio* 2004].

³⁹⁸ *Ibid* at para 6.

³⁹⁹ *Ibid* at para 10 [emphasis added].

⁴⁰⁰ *Ibid* at para 20 [emphasis added].

⁴⁰¹ *Ibid* at para 22.

⁴⁰² The concept of the "reasonable person" is not new in tort law. See Aaida Peerani, "The Reasonable Person." (2017) LawNow, online: <<https://www.lawnow.org/the-reasonable-person/>> [emphasis added].

⁴⁰³ *WIC Radio* [2004] *supra* note 397 at para 22 [emphasis added].

final statement (in Rafa Mair's editorial) Madam Justice Koeningsberg said "[t]here is nothing in this statement which could be understood by any reasonable person to be a matter of fact. It is a matter of opinion or comment."⁴⁰⁴ Therefore, the defence of fair comment prevailed and WIC Radio Ltd. was not liable.

The finding by Madam Justice Koeningsberg at trial in *Simpson v Mair* and *WIC Radio Ltd*⁴⁰⁵ is the singular and only piece of evidence of how reputation is established to the satisfaction of the trier of fact in defamation litigation in Canada that was uncovered by this entire examination of the state of defamation jurisprudence in Canada. The finding, on the evidence before her, that Simpson “had a significant public profile ... [and that] she had a public reputation as a leader of those opposed to schools teaching acceptance of a gay lifestyle” led to Madam Justice Koeningsberg’s finding that, as a matter of law, Ms Simpson had a reputation protectable under defamation law (even though Ms Simpson ultimately was not successful in her litigation before Madam Justice Koeningsberg or, ultimately, before the Supreme Court of Canada, because the defence of fair comment was established⁴⁰⁶).

The reference by Madam Justice Koeningsberg to the evidence before her in making her finding about Ms Simpson’s reputation is the only clear evidence of reputation found in the examination of defamation cases in Canada conducted as part of this research.

⁴⁰⁴ *Ibid* at para 46.

⁴⁰⁵ *Ibid* at para 10.

⁴⁰⁶ *WIC Radio* [2008] *supra* note 244.

Simpson appealed the decision. The Court of Appeal for British Columbia (Madam Justice Southin writing for herself and Justice Thackray, with Madam Justice Prowse delivering concurring reasons) allowed the appeal, finding against Mair and WIC Radio Ltd, and reversing the trial judgment.⁴⁰⁷ WIC Radio Ltd., and Rafe Mair appealed the decision of the Court of Appeal for British Columbia to the Supreme Court of Canada.⁴⁰⁸

The full Supreme Court of Canada held that the trial judgment should be restored, allowing the defence of fair comment to succeed. Justice Binnie, writing for the majority,⁴⁰⁹ said that “the worth and dignity of each individual, including reputation, is an important value underlying the *Charter* and is to be weighed in the balance in a defamation case with freedom of expression, including freedom of the media.”⁴¹⁰ He explained there had been a ‘shift’ in Canada’s defamation law after the *Charter* was made part of the Canadian Constitution in 1982, saying “[t]he function of the tort of defamation is to vindicate reputation, but many courts have concluded that the traditional elements of that tort may require modification to provide broader accommodation to the value of freedom of expression.”⁴¹¹ However, he also said that, in his opinion, “Mair's editorial about Kari Simpson clearly defamed her” and that it “tend[ed] to lower her in the **opinion of right-thinking people**.”⁴¹² He added that

[t]he trial judge found a difference between what Mair subjectively intended to say ... and objectively what he is taken to have said. The gap

⁴⁰⁷ *Simpson v Mair and WIC Radio Ltd.*, 2006 BCCA 287 at paras 43-46 [*WIC Radio* 2006].

⁴⁰⁸ *WIC Radio* [2008] *supra* note 244.

⁴⁰⁹ *Ibid* paras 108-112.

⁴¹⁰ *Ibid* at para 2.

⁴¹¹ *Ibid* at para 15.

⁴¹² *Ibid* at para 45 [emphasis added].

between the intended meaning and what the court determined to be the effect Mair's **words conveyed to reasonable members of the audience** has important implications.⁴¹³

In his partially concurring reasons, Justice LeBel said:

[a]lthough distinguishing facts from comment may sometimes be difficult, a comment is by its subjective nature generally less capable of damaging someone's reputation than an objective statement of fact, because the public is much more likely to be influenced in its belief by a statement of fact than by a comment.⁴¹⁴

*Crookes v Newton*⁴¹⁵

Wayne Crookes, a member of the Green Party of Canada and his company West Coast Title Search Ltd., (the plaintiffs), brought an action against Wikimedia Foundation Inc, and Jon Newton (who operated and owned a website in British Columbia where he posted various commentary) for posting an article that included two hyperlinks connecting to websites with articles allegedly containing defamatory information about Mr. Crookes.⁴¹⁶ This case concerned internet publication.⁴¹⁷

In his reasons for judgment (this was a summary trial⁴¹⁸), Justice Kelleher said that "[w]ithout proof that persons other than the plaintiff visited the defendant's website,

⁴¹³ *Ibid* at para 46 [emphasis added].

⁴¹⁴ *Ibid*: Justice LeBel at 71.

⁴¹⁵ *Crookes v Newton* [2011] *supra* note 366.

⁴¹⁶ *Crookes v Wikimedia Foundation Inc.*, 2008 BCSC 1424 at paras 2, 6,9. (Note: the alleged websites are no longer operational at the time of this research) [*Crookes* 2008].

⁴¹⁷ *Ibid* at para 14. Evidence of this connection with the internet can be seen in the following comment by Justice Kelleher in the first instance: "[t]he plaintiffs' case [was] that publication [accessible via the hyperlink] is presumed."

⁴¹⁸ Based on the Rule 18A - Summary Trial of the British Columbia *Court Rules Act* (In 1983, the Supreme Court of British Columbia added Rule 18A - Summary Trial authorizing a judge in chambers to give judgment based on affidavits or similar evidence).

https://www.bclaws.gov.bc.ca/civix/document/id/loo81/loo81/221_90_00

clicked on the hyperlinks, and read the articles complained of, there cannot be a finding of publication."⁴¹⁹ Justice Kelleher dismissed the action due to lack of evidence.⁴²⁰ It was agreed that the defendant did not publish any defamatory content on his (p2net) website.⁴²¹ The plaintiffs appealed Justice Kelleher's decision.

The Court of Appeal for British Columbia dismissed the appeal.⁴²²

The plaintiffs (appellants) took the appeal to the Supreme Court of Canada. In 2011, Justice Abella delivered judgment for the majority⁴²³ and concluded "that a hyperlink, by itself, should never be seen as "publication" of the content to which it refers."⁴²⁴ The plaintiff erred in suing the wrong publisher (hyperlinks were not equivalent to the publication). Regarding "reputation" in *Crookes v Newton* case, Justice Abella (of the Supreme Court of Canada) said that "[p]reventing plaintiffs from suing those who have merely referred their readers to other sources that may contain defamatory content and not expressed defamatory meaning about plaintiffs will not leave them unable to vindicate their reputation."⁴²⁵ She added that "most effective remedy lies

⁴¹⁹ *Crookes v Wikimedia Foundation Inc.*, *supra* note 416 at para 20.

⁴²⁰ *Ibid* at para 20.

⁴²¹ *Ibid* at para 32.

⁴²² *Crookes v Newton*, 2009 BCCA 392 (Reasons for judgment delivered by Justice Saunders (at paras 78-93), Justice Bauman concurring; dissenting reasons delivered by Justice Prowse (at paras 1-77) [*Crookes* 2009]). In concluding, Madam Justice Prowse, said: "I would allow the appeal, set aside the order of the trial judge, and remit the action to the trial court for resolution of all outstanding issues." (at para 77).

⁴²³ *Crookes v Newton* (2011) *supra* note 366 at 364.

⁴²⁴ *Ibid* para 14.

⁴²⁵ *Ibid* para 41.

with the person who actually created and controls the content."⁴²⁶ Justice Abella, writing for the majority, said

Pre-*Charter* approaches to defamation law in Canada largely leaned towards protecting **reputation**. That began to change when the Court modified the “honest belief” element to the fair comment defence in *WIC Radio Ltd. v. Simpson*, 2008 SCC 40, [2008] 2 S.C.R. 420, and when, in *Grant*, the Court developed a defence of responsible communication on matters of public interest. These cases recognize the importance of achieving a proper balance between protecting an individual’s **reputation** and the foundational role of freedom of expression in the development of democratic institutions and values (*Grant*, at para. 1; *Hill*, at para. 101). [emphasis added]⁴²⁷

(c) Civil defamation cases tried before judge and jury

*Currie v Preston and Wilson*⁴²⁸

This libel trial involved First World War General Sir Arthur Currie, who sued article author William Thomas Rochester Preston and Frederick W Wilson (owner and publisher of small-town Ontario newspaper the Port Hope *Evening Guide*) for an article published in the newspaper.

Because of the secrecy that surrounds jury deliberations in Canada, it is impossible to know how the jury in this case, as in other cases, decided matters involving the plaintiff’s reputation. However, Robert J Sharpe, in his book, meticulously details the Sir Arthur Currie case, supported by the transcripts and documents from the trial.⁴²⁹

⁴²⁶ *Ibid.*

⁴²⁷ *Ibid* para 32 [emphasis added].

⁴²⁸ *Currie v Preston and Wilson*, [1928, Supreme Court of Ontario, Toronto] [*Currie* 1928].

⁴²⁹ Sharpe, *The Last Day, The Last Hour* *supra* note 374, at Preface: “The Currie case ... provides an opportunity to reflect upon the law of defamation, not only as it appears to potential litigants, but from the broader perspective of reconciling the conflicting claims of the need to protect personal reputation on the one hand, and the desirability of free and open discussion of important public issues on the other.” (at p.x). His research included broad sources related to the trial, including, for example, transcripts of the trial (see,

Because this book brings a fully documented legal perspective to the Sir Arthur Currie case (Robert J Sharpe is a Canadian author, lawyer, academic and judge), this study relies on the descriptions of the evidence and processes of both trial and appeal as documented in Sharpe's book.⁴³⁰

The alleged defamation was in an editorial⁴³¹ published 13 June 1927 in the Port Hope Evening Guide newspaper.⁴³² The plaintiff Currie won at trial: “the Defendants are guilty of libel, and that the award of five hundred dollars be given to the Plaintiff.”⁴³³ The defendants appealed.⁴³⁴ The Ontario Court of Appeal denied the appeal.⁴³⁵

The article that appeared in the *Evening Guide* followed the unveiling of a plaque at Mons (a town in Belgium near the French border) commemorating twenty years since the city had been re-captured by the Canadians on the last day (11 November 1918) of the Great War. A segment of the newspaper's article said that "it is doubtful whether in any

eg, chapter 12, which begins with direct quotation from the defendants' lawyer's cross-examination of Sir Arthur Currie (at 186-205)).

⁴³⁰ *Ibid.* Sharpe was a professor, and later Dean, at the University of Toronto Faculty of Law, later serving on the Ontario Court of Appeal from 1999-2020. The extensive sources used by Sharpe in his study include transcripts of the proceedings, correspondence of key players, and contemporary newspaper accounts. Sir Arthur Currie's case has also been described by historian Tim Cook in *The Madman and the Butcher: The Sensational Wars of Sam Hughes and General Arthur Currie* (Toronto: Penguin Group, 2010).

⁴³¹ *Ibid* at 10-11.

⁴³² *Ibid* at 8-9. The article names Sir Arthur Currie and is highly critical of actions taken just as the First World War was concluded.

⁴³³ *Ibid* at 231.

⁴³⁴ *Ibid.*

⁴³⁵ *Ibid.* See Chapter 14 “Appeal” at 235-236: “At the conclusion of [Appellant’s counsel’s] argument, without even calling on [the Respondent’s counsel], Chief Justice Latchford delivered a brief oral judgment disposing of the case.[:]

We are all of one opinion with regard to these appeals. No argument has been presented to the court that would lead us to think there has been any mistrial of the action, or that anything was improperly withheld from the jury in the judge’s charge, or that anything which should not have been said was said. There was no improper rejection of evidence and no improper admission. The greatest latitude, it seems to me, was extended to counsel for the defendants by the trial judge, and the only error – and it is an error – is that the latitude was too wide.

case there was a more deliberate and useless waste of human life than in the so-called capture of Mons."⁴³⁶ In addition, the article said that

[i]t was ... almost the last minute, when ... the Commander-in-Chief [with no mention of his name, though the reference had to be to Sir General Arthur Currie who was the Commander of Canadian Corps at that time] conceived the mad idea that it would be a fine thing to say that the Canadians had fired the last shot in the Great War, and had captured the last German entrenchment before ... eleven o'clock, when the armistice, which had been signed by both sides would begin officially.⁴³⁷

In its final paragraph, the article included the following sentences, clearly identifying Sir Arthur Currie:

It does not seem to be remembered that even Ottawa, neither by government nor Parliament, gave Sir Arthur Currie any official vote of thanks, nor any special grant as an evidence of the esteem of appreciation of his services. ... He was allowed to return to Canada unnoticed by officials of the government or of Parliament and permitted to sink into comparative obscurity in a civilian position as President of McGill University.⁴³⁸

Currie instructed his solicitor George H Montgomery "to retain a Toronto lawyer, William Norman Tilley, KC, one of the leading advocates of the day, and to take whatever steps were necessary to proceed with the lawsuit."⁴³⁹ The case, *Currie v Preston and Wilson*, was tried with a jury,⁴⁴⁰ before Justice Hugh Rose, beginning 16 April 1928 in the Superior Court of Ontario during the Spring Assizes for Northumberland and Durham, in Cobourg, Ontario,⁴⁴¹ and ending 1 May 1928.⁴⁴² In addition to the article in

⁴³⁶ *Ibid* at 10.

⁴³⁷ *Ibid*.

⁴³⁸ *Ibid* at 11.

⁴³⁹ *Ibid* at 15.

⁴⁴⁰ *Ibid* at 100. The "special jury" as it was in the 1928 Currie libel trial was comprised of twelve jurors selected from the grand jury roll.

⁴⁴¹ *Ibid* at 99.

⁴⁴² *Ibid* at 221-222.

question being directed to Currie, Tilley explained to the jury "that the offending article had been published" and that "the plaintiff [Currie] had only to establish that it was defamatory."⁴⁴³ The newspaper article was presented as an exhibit, and Tilly called a witness (Ralph Hodgson) who testified on Currie's behalf.⁴⁴⁴ Sharpe said that "Hodgson was called to prove that the ordinary reader would infer that its [the newspaper article's] sting was directed at Currie. Hodgson swore that when he read the article, he took 'commander-in chief' ... to mean General Currie and none other."⁴⁴⁵

Currie wanted to prove that his reputation as a highly ranked military public figure was hurt, and during the trial, his witness, Sir Richard Turner, provided evidence that Currie had that kind of reputation. The questioning of witness Turner by Currie's counsel Tilley, based on the transcripts of the trial recorded in Sharpe's book, reads as follows:

Q Do you know General Currie?

A I do, sir.

Q Do you know his **reputation**?

A I do.

Q As a military man?

A I do.

Q What is it?

A Well, I should say that any man that could have a **military reputation** such as General Currie would be envied. [emphasis added]⁴⁴⁶

⁴⁴³ *Ibid*. The requirements for a publication to be defamatory were (1) that the words were defamatory; (2) that the words referred to the plaintiff; and (3) that the words were published (See Chapter 2 for details). Sharpe notes at 101:

The defendants had pleaded justification and it was for them to prove the truth of what they had written. Tilley then read the entire article aloud without interruption. There could be no doubt, Tilley contended, that the defendants had stated that Currie himself gave the order to attack, intending to glorify himself at the cost of needless human slaughter. It was a serious charge, one made worse by the refusal of the defendants to retract.

⁴⁴⁴ *Ibid* at 101-102.

⁴⁴⁵ *Ibid* at 102.

⁴⁴⁶ *Ibid* at 212-213 [emphasis added].

Although the jury of twelve (with one dissent) found Preston and Wilson guilty of libel and awarded Currie five hundred dollars, "the trial had been a much more stressful experience than Currie had expected."⁴⁴⁷

The defendants filed a notice of appeal. The Court of Appeal denied the appeal and no further action was taken by Currie: as author Tim Cook has said "he [Currie] feared that, ... his reputation might be damaged beyond repair as Canada's Great War was refought in a Cobourg courtroom, the outcome being decided not by armies, but by lawyers, judge, and jurors."⁴⁴⁸

The trial transcripts published in Sharpe's book provide unique evidence (such as that just quoted above) establishing that Currie had a reputation. However, this was a jury trial, and there is no evidence available about how the jury weighed this evidence of Currie's reputation when coming to its verdict and then deciding to award only \$500 in general damages⁴⁴⁹ (a significantly smaller amount than what Currie had initially claimed).

⁴⁴⁷ *Ibid* at 230.

⁴⁴⁸ Tim Cook, *The Madman and the Butcher: The Sensational Wars of Sam Hughes and General Arthur Currie* (Toronto: Penguin Group, 2010) at 337.

⁴⁴⁹ Sharpe, *supra* note 374, at 225.

*Lefolii et al. v Gouzenko*⁴⁵⁰

This litigation was initiated by plaintiff Igor Gouzenko⁴⁵¹ based on an article published in *Maclean's Magazine* in 1964.⁴⁵²

The fact that this was a jury trial is apparent from the judgments of the two appellate courts that were later involved.⁴⁵³ From judgment of Justice Hall in the Supreme Court of Canada, it can be discerned that "[t]he trial was a short one"⁴⁵⁴ and that "[at] the trial, the plaintiff did not appear and the only evidence adduced was on behalf of [Gouzenko] and consisted of the reading of the actual article complained of and certain limited portions of the examination for discovery of the three defendants Lefolii, Spears and Fraser [the authors of the publication]."⁴⁵⁵ Lefolii, Spears and Fraser "called no witnesses."⁴⁵⁶

Gouzenko, the plaintiff, though successful at trial, appealed the trial judgment to the Ontario Court of Appeal⁴⁵⁷ on the grounds that "the learned trial judge erroneously

⁴⁵⁰ There appears to be no report of this litigation at trial: the unanimous decision of the Court of Appeal (Justice Kelly writing also for Justices McLellan and Laskin) is reported at [1967] 2 OR 262 (29th May 1967) and the decision of the Supreme Court of Canada is reported at *Lefolii et al. v Gouzenko*, [1969] SCR 3 (the judgment of Justices Martland, Ritchie and Hall was delivered by Justice Hall; Justice Spence concurred with Justice Hall; Justice Judson dissented).

⁴⁵¹ At the time of the trial, Igor Gouzenko was known for his book *The Fall of a Titan* for which he won Governor General's award in 1954 (the award had no monetary prize at that time). Earlier, in 1948, the Twentieth Century Fox released a film *The Iron Curtain* based on the story of Gouzenko's defection from his position of a cipher clerk in the USSR's embassy in Ottawa in 1945 - when he took a bag of secret documents on the USSR espionage activities in Canada, the USA and the UK and passed it on to Canadian authorities.

⁴⁵² Blair Fraser, "These Were the Years That Made Our World", *Maclean's* (5 September 1964) 10, online: <<https://archive.macleans.ca/article/1964/9/5/these-were-the-years-that-made-our-world>>.

⁴⁵³ *Lefolii et al. v Gouzenko*, [1967] 2 OR 262 (OCA) and *Gouzenko* (SCC) *supra* note 370. As noted above (*supra* note 450), there appears to be no published report of the trial judgment.

⁴⁵⁴ *Gouzenko* (SCC) *supra* note 370 at 5.

⁴⁵⁵ *Ibid* at 9.

⁴⁵⁶ *Ibid*, per Justice Hall.

⁴⁵⁷ *Lefolii et al. v Gouzenko*, [1967] *supra* note 453.

excluded evidence of express malice and, that the jury was prejudiced in their assessment of the damages of the plaintiff”⁴⁵⁸

On the first ground (of exclusion of evidence), the Court of Appeal (Justice Kelly, for himself and Justices McLennan and Laskin) found that “[i]t is impossible in this Court, in the absence of the articles themselves and of any testimony as to their contents and the circumstances of their publication, to say whether the learned trial judge was right or wrong in his ruling.”⁴⁵⁹

In considering the second ground (that the jury was prejudiced), the Court of Appeal noted “[the trial judge] should not permit his uncertainty as to the capability of the words to be defamatory, to influence the jury’s assessment of the gravity of the injury to the appellant caused by those words.”⁴⁶⁰ The Court of Appeal went on to say “the words complained of taken in their entirety are capable of supporting some of the other innuendos set out in the statement of claim in addition to those which the learned trial judge left with the jury.”⁴⁶¹

In deciding in favour of Gouzenko (the plaintiff at trial), the Court of Appeal stated unequivocally that

the separate functions of a judge and a jury in an action for libel: [are] that it was his [the trial judge's] function to decide whether the words were capable of a defamatory meaning and that it was the jury's duty to decide whether they were in fact defamatory.⁴⁶²

The Court of Appeal noted further that

⁴⁵⁸ *Ibid*, Justice Kelly at para 3.

⁴⁵⁹ *Ibid* at para 4.

⁴⁶⁰ *Ibid* at para 11.

⁴⁶¹ *Ibid* at para 12.

⁴⁶² *Ibid* at para 10.

[h]e [the trial judge] should not have told them [the jury] of the motion made in their absence or have said anything about his [the trial judge's] difficulty in arriving at a conclusion as to whether the words were capable of a defamatory meaning.⁴⁶³

Finally, the Court of Appeal stated

[i]n this action the duty of the jury was to determine liability and, having done so, to assess damages. These were separate functions and should not have been intermixed. The jury's finding as to liability should have been made with respect to words which the Judge had already ruled capable of being defamatory or instructed the jury to assume to be so. The assessment of damages should have been made uninfluenced by the charge with respect to liability.⁴⁶⁴

Ultimately, the Court of Appeal ordered a new trial “on all issues rather than limit the new trial to the assessment of damages only, which is the usual order where there is an appeal against assessment only.”⁴⁶⁵

Lefolii, Spears and Fraser, who had lost at trial and then lost again in the Court of Appeal, appealed to the Supreme Court of Canada. The Supreme Court of Canada dismissed the appeal, though it varied the costs portion of the judgment below,⁴⁶⁶ thus leaving the Court of Appeal's order for a new trial in place. There is no evidence that such a trial ever took place.

Although the question of the reputation of the plaintiff Gouzenko was not specifically discussed either the judgment of the Court of Appeal or in the opinions rendered at the Supreme Court of Canada, the roles of judge and jury in considering matters related to reputation featured in an important discussion in the Court of Appeal.

⁴⁶³ *Ibid* at para 11.

⁴⁶⁴ *Ibid* at para 13.

⁴⁶⁵ *Ibid* at para 15.

⁴⁶⁶ *Gouzenko* [1969] *supra* note 370.

Justice Spence (in his own judgment at the Supreme Court of Canada) agreed with the following statements of Justice Kelly, who wrote the judgment of the Court of Appeal:

This statement of [the trial judge's] difficulties in deciding whether the words were capable of a defamatory meaning was repeated three times in different but equally compelling language.⁴⁶⁷

... I doubt if this is a case where the trial Judge should have reserved his ruling on the issue of whether the words were capable of a defamatory meaning, but, assuming it was an appropriate case to reserve his ruling, he should simply have told the jury to assume that the words were capable of a defamatory meaning and that it was their duty to decide whether they were so in fact. He should not have told them of the motion made in their absence or have said anything about his difficulty in arriving at a conclusion as to whether the words were capable of a defamatory meaning. What happened in the jury's absence was wholly irrelevant to the function of the jury.⁴⁶⁸

... The [judge's] emphasis placed upon his difficulties in making up his mind could have one effect and one effect only on the jury to cause them to believe that, if the words were defamatory at all, the effect on the reputation of the appellant [plaintiff at trial] was trivial and that the damages suffered by the appellant were likewise trivial. It may be that what was said of the appellant [plaintiff at trial] was not serious: in a proper context a trial Judge may properly express to the jury his own views in regard to the words used. But he should not permit his uncertainty as to the capability of the words to be defamatory, to influence the jury's assessment of the gravity of the injury to the appellant [plaintiff at trial] caused by those words.⁴⁶⁹

Justice Kelly makes it clear that it is the jury's "duty to decide whether ... [the words] were ... [defamatory] in fact"⁴⁷⁰ – and, as discussed earlier, juries in Canada must keep their decisions secret.

⁴⁶⁷ *Ibid* at 8.

⁴⁶⁸ *Ibid* at 8-9.

⁴⁶⁹ *Ibid* at 10.

⁴⁷⁰ From the text quoted immediately above (in text at footnote 469).

*Hill v Church of Scientology of Toronto*⁴⁷¹

The facts about this high profile jury trial are found in the judgment at trial delivered by Justice Carruthers in 1992 *Hill v Church of Scientology of Toronto*.⁴⁷² Justice Carruthers established that "[t]he plaintiff Hill claimed that he was the object of defamatory statements which the defendant [Morris] Manning made while he was acting as counsel to the defendant Church Of Scientology."⁴⁷³ Justice Carruthers established that the defendant Manning, "outside the front entrance to Osgoode Hall on September 17, 1984 ... wearing his barrister's gown spoke to a number of representatives of the print media and appeared before the television cameras of both CBC and CTV. Portion of what the defendant Manning had to say at that time were published in newspapers and aired on television networks' news broadcasts."⁴⁷⁴ Casey Hill, a high profile official at the Office of the Ministry of Attorney General for Ontario, launched a defamation lawsuit, alleging that Manning had portrayed Hill as misleading a judge and breaching orders sealing a certain number of the Church of Scientology documents earlier seized by the police.⁴⁷⁵

In his judgment at trial, holding for the plaintiff Hill, Justice Carruthers affirmed: "The trial began on September 3, 1991 and the jury verdict was received on the night of

⁴⁷¹ *Hill* 1995, *supra* at 239.

⁴⁷² *Hill v Church of Scientology of Toronto* 7 OR (3d) 489 [1992] OJ No 451 (Judgment delivered by Justice Carruthers: there was enough evidence for the jury to decide the case.) [*Hill* 1992].

⁴⁷³ *Ibid* at para 1.

⁴⁷⁴ *Ibid* at para 2. The defamatory publication appeared both as libel and slander.

⁴⁷⁵ *Ibid* at paras 3 and 7.

October 3, 1991. ... The jury ... found that the words of statements about which the plaintiff complained were defamatory of him."⁴⁷⁶

The Church of Scientology of Toronto and its counsel Manning (the defendants at trial) appealed.

In 1994, a unanimous Court of Appeal (Justices Griffiths, Catzman and Galligan) made the general observation that "the common law has long held that in defamation cases the jury represents society and, in that capacity, the jury expresses society's opinion about the actions of the person who makes false statements about another."⁴⁷⁷ The Court of Appeal also observed that

each libel case is unique and it is virtually impossible to categorize or compare them. The personality and character of the defamed person, the nature of the libel and the circumstances surrounding its publication, the motivation and persistence of the person who defames, and the effect of the defamation upon the injured person depend upon many variables which are rarely duplicated. No two cases are the same, indeed, they rarely resemble one another. An award in one case is rarely, if ever, a useful guide in another.⁴⁷⁸

The Court of Appeal noted, in general, "our final observation is that the most valuable asset of any lawyer is one that, if lacking, cannot be compensated by any amount of talent or industry: it is the justified **reputation for integrity** ... A false statement which disparages a lawyer's professional integrity is a very grave matter."⁴⁷⁹ But the Court of Appeal went on to observe specifically, in the case before it,

⁴⁷⁶ *Ibid* at para 5. "The jury awarded general damages against both defendants in the total amount of \$300,000. As well, the jury assessed aggravated damages in the amount of \$500,000, and punitive damages in the amount of \$800,000 against the defendant Church of Scientology."

⁴⁷⁷ *Hill v Church of Scientology of Toronto*, (ON CA) 18 OR (3d) 385 [1994] OJ No. 961 at 3 [*Hill* 1994].

⁴⁷⁸ *Ibid* at 29.

⁴⁷⁹ *Ibid* [emphasis added].

[w]hat the circumstances of this case demonstrated beyond peradventure to the jury was that Scientology was engaged in an unceasing and apparently unstoppable campaign to destroy Casey Hill and his reputation. It must have been apparent to the jury that a very substantial penalty was required because Scientology had not been deterred from its course of conduct by a previous judicial determination that its allegations were unfounded nor by its own knowledge that its principal allegation was false. The jury chose an amount of \$800,000. It appears to have decided that a fine equivalent to the total amount of compensatory damages was the appropriate penalty. That rationale is one which six reasonable people could adopt and it is one which does not offend our conscience or our sense of justice.⁴⁸⁰

The Court of Appeal dismissed the appeal of the Church of Scientology. The decision of the Court of Appeal of Ontario was then appealed by the Church of Scientology to the Supreme Court of Canada.

Justice Cory, writing the judgment for the majority⁴⁸¹ in Supreme Court of Canada's 1995 decision in *Hill v Church of Scientology of Toronto*, dismissing the appeal and affirming the judgment of the Ontario Court of Appeal, said that reputation "is an attribute that must, just as much as freedom of expression, be protected by society's laws".⁴⁸² He recognized that the "**reputation of a lawyer** is of paramount importance to clients, to other members of the profession and to the judiciary."⁴⁸³ Justice Cory wrote

[a]nything that leads to the tarnishing of a **professional reputation** can be disastrous for a lawyer. ... As a lawyer, Hill would have no way of knowing what members of the public, colleagues, other lawyers and judges may have been affected by the dramatic presentation of the

⁴⁸⁰ *Ibid* at 46.

⁴⁸¹ *Hill v Church of Scientology of Toronto*, [1995] *supra* 239 (The judgment of La Forest, Gonthier, Cory, McLachlin, Iacobucci and Major JJ. was delivered by Cory J for the majority; Per L'Heureux-Dubé J concurring: Cory J.'s reasons were generally agreed with, except with respect to the scope of the defence of qualified privilege)

⁴⁸² *Ibid*, Justice Cory at para 107.

⁴⁸³ *Ibid* para 118 [emphasis added].

allegation that he had been instrumental in breaching an order of the court and that he was guilty of criminal contempt. [emphasis added]⁴⁸⁴

Most details of the attack on Cassey Hill's reputation are found in the judgment of the Supreme Court of Canada. The Supreme Court took note of Justice Carruther's account, in his trial judgment, of the years of repeated attacks on Casey Hill's "**professional integrity**, which added to the sting of the libel uttered to that point." [emphasis added]⁴⁸⁵

About the conduct of the Church of Scientology during the trial, the Supreme Court stated that "Scientology continued its attack against Casey Hill throughout the trial of this action, both in the presence of the jury and in its absence. More than once, it reiterated the libel even though it knew that these allegations were false. Clearly, it sought to repeatedly attack Casey Hill's **moral character**." [emphasis added]⁴⁸⁶ In comparison with other libel cases, Justice Cory said:

At the outset, I should state that I agree completely with the Court of Appeal that each libel case is unique and that this particular case is in a "class by itself". The assessment of damages in a libel case flows from a particular confluence of the following elements: the nature and circumstances of the publication of the libel, the nature and position of the victim of the libel, the possible effects of the libel statement upon the life of the plaintiff, and the actions and motivations of the defendants. It follows that there is little to be gained from a detailed comparison of libel awards.⁴⁸⁷

⁴⁸⁴ *Ibid* para 177 [emphasis added].

⁴⁸⁵ *Ibid* para 39 [emphasis added]

⁴⁸⁶ *Ibid* para 45 [emphasis added].

⁴⁸⁷ *Ibid* para 187.

This litigation began with a trial that involved a jury. The deliberations of the jury would have included findings on the reputation of Cassey Hill -- but these jury findings, like those of all other juries in defamation actions, were secret, as required by law.

It is remarkable how much discourse in these appeal judgments focuses on reputation. The quotations above demonstrate this. While it would be tempting to draw conclusions based on the language about reputation found in the judgments of the Court of Appeal and, especially, the Supreme Court of Canada, that language is all expressing generalities: "reputation of the lawyer" not the reputation of *this* lawyer specifically. The courts are concerned about the plaintiff's future reputation – but it is the test of the plaintiff's reputation in the present that is germane to a defamation action. A defamation action cannot look to possible future changes to reputation.

*Quan v Cusson*⁴⁸⁸

In this case, the plaintiff Danno Cusson was an Ontario Provincial Police Constable who took the initiative to join the rescue operations in New York immediately after the September 11 attack on the World Trade Centre (taking with him his dog). “The O.P.P. was publicly assailed for ordering the plaintiff to return to his duties in Ottawa. [He] gave a number of media interviews and was portrayed as a hero for his rescue efforts.”⁴⁸⁹

⁴⁸⁸ *Quan* 2009 *supra* note 245 (Reasons for judgment delivered by Chief Justice McLachlin, Binnie, LeBel, Deschamps, Fish, Charron, Rothstein and Cromwell JJ concurring (paras 1-51) Justice Abella concurring reasons (para 52) [*Quan* 2009]).

⁴⁸⁹ *Cusson v Quan* 87 OR(3d) 241 Ontario Court of Appeal (Justice Sharpe, for himself and Justices Weiler and Blair). This judgment discusses “reputation” throughout but does not comment on reputation in the circumstances of the case before it.

Cusson later brought a defamation action against those involved in three articles published in the Ottawa Citizen newspaper: Douglas Quan, Kelly Egan and Don Campbell (the authors), the Ottawa Citizen, the Ottawa Citizen Group Inc, and Southam Publications (a CanWest Company) and OPP Staff Sargeant Penny Barager.⁴⁹⁰ According to the article written by Douglas Quan, as an example, Cusson “had identified himself to the New York State Police Department as an R.C.M.P. officer trained in K-9 rescues and that although the plaintiff had been hailed as a hero, he ‘may have compromised the search and rescue mission after he is alleged to have misled the New York State Police into thinking he was a fully trained K-9 handler with the R.C.M.P.’”⁴⁹¹

Justice Maranger of the Ontario Superior Court of Justice at trial "ruled that all three articles were of public interest, but that as there was no "compelling, moral or social duty" to publish the Quan and Egan articles, those articles, Justice Maranger ruled, could not possibly attract the defence of qualified privilege. Justice Maranger, however, did leave the question of application of the defence of truth to the jury and:⁴⁹²

[a]nswering a long list of factual questions [posed by the trial judge] which parsed the allegedly defamatory statements in considerable detail, the jury found that many, but not all, of the factual imputations in the articles had been proven true. It awarded Cst. Cusson \$100,000 in general damages against the Citizen defendants and \$25,000 against Staff Sgt. Barager. However, the jury also found no malice on the part of any of the defendants and declined to award any special, aggravated or punitive damages.⁴⁹³

⁴⁹⁰ *Quan* 2009 *supra* note 245 at para 3. There does not seem to be a report of the proceedings at trial before Justice Maranger. The information provided here about the proceedings at the trial level is culled from the reports of the proceedings recounted by Justice Sharpe of the Ontario Court of Appeal (*Cusson v Quan* 87 OR(3d) 241) and, at the Supreme Court of Canada, by then Chief Justice McLachlin (2009 SCC 62).

⁴⁹¹ *Cusson v Quan*, 2007 87 O.R. (3d) 241 at para 9 [*Quan* 2007].

⁴⁹² *Quan* 2009 *supra* note 245 at para 17.

⁴⁹³ *Ibid* at para 4.

This list is reproduced in the Supreme Court judgment:

- [21] ... the jury found the defendants had proven the following facts:
- the plaintiff had failed in his duties as an OPP officer and abandoned his responsibilities without justification;
 - neither the plaintiff nor his dog had received formal training in search and rescue operations;
 - Sgt. Fischer or someone else intended to arrest the plaintiff;
 - the plaintiff misled Sgt. Fischer into thinking he was an RCMP officer;
 - the plaintiff was trying to give the impression that he was an RCMP officer.⁴⁹⁴

The list of allegations that the jury found had not been proven was also reproduced in the Supreme Court judgment:

- [22] ... the jury ... found that the following imputations had *not* been proven [emphasis in the original]:
- the plaintiff may have compromised the World Trade Centre rescue effort;
 - the plaintiff deliberately misled the New York police by representing himself as a trained RCMP K-9 officer;
 - the plaintiff had no search and rescue training;
 - the plaintiff told Sgt. Fischer that he was an RCMP officer and his dog had received training;
 - the plaintiff had concealed his true identity;
 - the plaintiff had asked to be told about the most elementary dog handling techniques and could not carry out even the simplest manoeuvres with his dog;
 - the plaintiff was responsible for a supposed 'fiasco';
 - the plaintiff's actions embarrassed the OPP and may have harmed the force's reputation.⁴⁹⁵

Having found truth in statements such as "the plaintiff had failed in his duties as an OPP officer and abandoned his responsibilities without justification"⁴⁹⁶ meant the defendants could not be found to have defamed Cusson in making those statements – and,

⁴⁹⁴ *Ibid* at para 21.

⁴⁹⁵ *Ibid* at para 22.

⁴⁹⁶ *Ibid* at para 21.

in turn, that such statements could not be considered to impugn Cusson's reputation as OPP officer.

On the other hand, the jury also finding that other facts, among them the statement that "the plaintiff deliberately misled the New York police by representing himself as a trained RCMP K-9 officer", were not proven,⁴⁹⁷ was evidence that, absent an applicable defence other than the defence of truth, the publications containing those statements were defamatory and therefore could harm the plaintiff's reputation.

The defendants Quan, Egan and Campbell (the authors), the Ottawa Citizen (and its affiliated companies) and OPP Staff Sergeant Penny Barager appealed the decision to the Court of Appeal for Ontario, arguing that the defence of qualified privilege was not considered properly with respect to two of the three articles at issue. The Court of Appeal dismissed the appeal.⁴⁹⁸ On appeal to the Supreme Court of Canada, the Supreme Court of Canada (then Chief Justice McLachlin sitting for herself and the other seven justices on the panel), did not consider reputation at any point in the judgment. The Court found that "the time has come to recognize a new defence - the defence of responsible communication on matters of public interest"⁴⁹⁹ and, in consequence, allowed the appeal and ordered a new trial.⁵⁰⁰

⁴⁹⁷ *Ibid* at para 22.

⁴⁹⁸ The Court of Appeal recognized a new 'responsible journalism' defence in Ontario in the judgment but, finding that the defendants had failed to advance this defence at trial, did not grant the appeal. See *Quan* 2007 *supra* 489 at para 5.

⁴⁹⁹ *Ibid* at para 2.

⁵⁰⁰ No evidence found of a new trial.

*Grant v Torstar Corporation*⁵⁰¹

Peter Grant (the plaintiff) was a major employer and a local philanthropist in the cottage area of Twin Lakes (Ontario), where he built his mansion and a headquarters for his company Grant Forest Products Inc., (the corporate plaintiff) and a small golf course adjacent to his property for which he partly purchased a Crown land.⁵⁰² The plaintiffs sued the Toronto Star newspaper for libel because the newspaper's treatment of Grant's proposal for an expansion of the golf course, which would have required purchasing an additional larger piece of Crown land. The impugned article said, "[e]veryone thinks it's a done deal because of Grant's influence -- but most of all his Mike Harris ties."⁵⁰³

The newspaper built its defence to the action based on the argument that the article expressed the local cottagers' concern over the expansion of the golf course as it would affect the environment and that Mr. Grant's political influence should not give him special treatment in the government approval process (to purchase more Crown land).⁵⁰⁴

As then Chief Justice McLachlin expressed the facts in the case (and the outcome of the trial), in paragraphs 4 and 5 of her majority judgment:

[4] Peter Grant and his company Grant Forest Products Inc. ("GFP") sued the *Toronto Star* in defamation for an article the newspaper published on June 23, 2001, concerning a proposed private golf course development on Grant's lakefront estate. The story aired the views of local residents who were critical of the development's environmental impact and suspicious that Grant was exercising political influence behind the scenes to secure government approval for the new golf

⁵⁰¹ *Grant v Torstar Corporation*, *supra* note 241 (Chief Justice McLachlin delivered the judgment for Binnie, LeBel, Deschamps, Fish, Charron, Rothstein and Cromwell JJ; concurring reasons, Abella J.) [*Grant* 2009].

⁵⁰² *Grant v Torstar Corporation*, 2008 92 OR (3d) 561 at paras 7-11.

⁵⁰³ *Ibid.* The 'Mike Harris referred to was Premier of Ontario, 1995-2002, and a leader of Progressive Conservative Party, 1990-2002.

⁵⁰⁴ *Grant v Torstar Corporation*, *supra* note 500 at para 4.

course. The reporter, an experienced journalist named Bill Schiller, attempted to verify the allegations in the article, including asking Grant for comment, which Grant chose not to provide. The article was published, and Grant brought this libel action.⁵⁰⁵

[5] The trial proceeded with judge and jury. The jury found the respondents (the “Star defendants”) liable and awarded general, aggravated and punitive damages totalling \$1.475 million.⁵⁰⁶

At trial Justice Rivard rejected the newspaper's defence of qualified privilege and, as well, a claimed defence of responsible journalism (the latter a defence recognized in England⁵⁰⁷ but not then recognized in Canadian courts) before putting the case to the jury (with neither of those defences).⁵⁰⁸ The jury found the newspaper liable to Grant and awarded Grant general, aggravated and punitive damages.

The newspaper appealed the verdict. The Court of Appeal for Ontario allowed the appeal and ordered a new trial.⁵⁰⁹ Grant then appealed the decision of the Court of Appeal for Ontario in favour of the newspaper to the Supreme Court of Canada, seeking to have the jury verdict reinstated. The Toronto Star defendants cross-appealed, seeking to have the Supreme Court of Canada dismiss the action either on the basis of the “new” defence of responsible journalism⁵¹⁰ or, in the alternative, on the basis of fair comment.⁵¹¹

⁵⁰⁵ *Grant* [2009], *supra* note 241 at para 4.

⁵⁰⁶ *Ibid* at para 5.

⁵⁰⁷ See *Reynolds v Times Newspaper Ltd.*, [1999] 4 ALL ER 609.

⁵⁰⁸ *Grant* [2008], *supra* note 502 at para 5.

⁵⁰⁹ *Grant v Torstar Corporation*, 2008 ONCA 796 (Justice Feldman for herself and Justices Rosenberg and Simmons). The Ontario Court of Appeal ordered a new trial on the grounds that a novel defence of “responsible journalism” should have been put to the jury.

⁵¹⁰ The Supreme Court of Canada ultimately did dismiss the action on the basis of the defence of responsible journalism: see para 87 of the judgment of the Chief Justice (and paras 88-126) in *Grant v Torstar Corporation*, *supra* note 241.

⁵¹¹ *Ibid* at para 25.

Chief Justice McLachlin (as she then was), in her reasons for judgment,⁵¹² emphasized that “[w]hile freedom of expression is a fundamental freedom protected by s 2(b) of the *Charter*, courts have long recognized that **protection of reputation is also worthy of legal recognition**” [emphasis added].⁵¹³ She went on to explain, in dismissing the appeal and cross-appeal, and ordering a new trial,⁵¹⁴ that

A plaintiff in a defamation action is required to prove three things to obtain judgment and an award of damages:

- (1) that the impugned words were defamatory, **in the sense that they would tend to lower the plaintiff’s reputation in the eyes of a reasonable person;**
- (2) that the words in fact referred to the plaintiff; and
- (3) that the words were published, meaning that they were communicated to at least one person other than the plaintiff.

If these elements are established on a balance of probabilities, falsity and damage are presumed. [emphasis added]⁵¹⁵

At paragraphs 127-133, then Chief Justice McLachlin specifically turned to the procedural issues arising from the new defence of responsible communication in matters of the public interest in a case involving a judge and jury:

[127] As a general rule, the judge decides questions of law, while the jury decides questions of fact and applies the law to the facts... issues of fact and law cannot be entirely disentangled...

[128] The judge decides whether the statement [at issue] relates to a matter of public interest. If public interest is shown, the jury decides whether on the evidence the defence is established...

...

[130] ... The jury should be instructed to assess the responsibility of the communication in light of the range of meanings the words are

⁵¹² *Ibid* at para 4.

⁵¹³ *Ibid* at para 3 [emphasis added].

⁵¹⁴ *Ibid* at para 141.

⁵¹⁵ *Ibid* at para 28 [emphasis added].

reasonably capable of bearing, including evidence as to the defendant's intended meaning.

[131] ... Courts have interpreted s14 [of the Ontario *Libel and Slander Act*] to mean that the jury cannot be *required* [emphasis in original] to answer specific questions, and if they are asked to do so they must be informed of their right to render a general verdict.⁵¹⁶

[132] The plaintiffs argue against a central role for the jury. ...⁵¹⁷

[133] This argument cannot be sustained. ...

Although the Supreme Court of Canada ordered a new trial, there are no available reports to confirm whether or not it ever took place. One might conjecture that Grant dropped the matter because, as the media reported, the projected expansion of the golf course at the heart of the matter was abandoned.⁵¹⁸

F - Criminal Libel Cases

Following in the footsteps of English law,⁵¹⁹ defamatory libel has been a criminal offence in Canada since the introduction of the *Act Respecting the Crime of Libel* in 1874.⁵²⁰ The offence was absorbed into the *Criminal Code* in 1892.⁵²¹ A century later,

⁵¹⁶ This, of course, renders it more difficult for researchers to ascertain what these civil juries are thinking about when coming to findings of fact on questions like reputation.

⁵¹⁷ Note that the Supreme Court justices overwhelmingly supported the Chief Justice in her reasoning on this point – but it is on exactly this point that Justice Abella, in her concurring judgment, was the sole dissenter: at para 144 she writes “I am unpersuaded that it is inconsistent with the statutory scheme to leave the legal issues at stake here [in the case of the new “responsible communication “ defence] with the judge and any disputed facts with the jury.”

⁵¹⁸ Peter Grant abandoned his unfinished mansion on Twin Lakes after his company experienced bankruptcy following the 2008 financial and economic crisis. See Erik White, "Multimillion-dollar waterfront mansion was never finished now 'just decaying'" CBC news, posted 21 June 2018.

⁵¹⁹ *An Act to Amend the Law Respecting Defamatory Words and Libel* 1843 (6 and 7 Vict), c 96 (also known as "*Lord Campbell's Act*).

⁵²⁰ For the history of criminal defamatory libel see again Justice Linda Giesbrecht in *R v Stevens*, *supra* note 111 at paras 104-105.

⁵²¹ *Criminal Code*, 1892 [55-56 Vic c 29] Section: V Offences against the person and reputation.

writing about the history of the Criminal Code in Canada [in a section of her defamatory libel judgment in *R v Stevens*⁵²²], Provincial Court Judge Linda Giesbrecht pointed out that "defamatory provisions of the *Code* have remained substantially unchanged since the enactment of the first *Criminal Code* in 1892."⁵²³

Robert Martin wrote that, while "[c]ivil libel is the mechanism whereby individuals may seek to protect their reputations,"⁵²⁴ "[t]he broad purpose of criminal libel is to preserve public order."⁵²⁵

The definition of defamatory libel in Canada's *Criminal Code* speaks directly to reputation:

Definition

298 (1) A defamatory libel is matter published, without lawful justification or excuse, that is likely to injure the **reputation** of any person by exposing him to hatred, contempt or ridicule, or that is designed to insult the person of or concerning whom it is published. [emphasis added]⁵²⁶

Although criminal defamation case numbers are low in Canada, these cases can be complex and controversial at times.⁵²⁷

⁵²² *R v Stevens*, [1993] *supra* note 110, at paras 104-105.

⁵²³ *Ibid* at para 117.

⁵²⁴ See Robert Martin, *Media Law*, 2nd ed., *supra* note 131 at 69-70.

⁵²⁵ *Ibid* at 70.

⁵²⁶ *Criminal Code*, RSC 1985, c C-46, s 298(1) [emphasis added].

⁵²⁷ See Dylan J Williams, *supra* note 136 at 182.

R v Stevens ⁵²⁸

As a result of the police investigation, B G Stevens was charged under s 300 of the *Criminal Code* for publishing a defamatory libel (on posters) about the complainant J.P. knowing that the publication's content was false.⁵²⁹ Mr. Stevens elected to be tried by a Manitoba Provincial Court judge.⁵³⁰ Justice Linda Giesbrecht, sitting alone, found that Mr. Stevens "intended to injure the complainant's reputation by exposing her to hatred, contempt or ridicule, and that he intended to insult her."⁵³¹ Justice Giesbrecht also concluded that "the statements in the posters ... were malicious and calculated to do the most possible damage to J.P.'s reputation, and that the places where the posters were published were selected to maximize their harmful effect on the complainant."⁵³² She found the accused guilty of the offence under s 300 of the *Criminal Code*.⁵³³

⁵²⁸ *R v Stevens*, [1995] 100 Man R(2d) 81 (Judgment delivered by Scott CJM, Helper JA concurring):

There are two appeals before the court. At the first trial held before L. Giesbrecht Prov. Ct. J., the accused was convicted of defamatory libel and sentenced to a period of imprisonment of 15 months. He appeals both conviction and sentence.... Appeal dismissed.

⁵²⁹ *R v Stevens* [1993] *supra* note 110. The facts read:

In October, 1991, a number of posters were displayed at various locations at the University of Manitoba campus where the complainant J.P. was a student in the Faculty of Education. These posters identified J.P. by name, provided her address and telephone number, and contained a photocopy of a photograph of her. The posters purported to be a request from J.P., for people to call or write to her and made the following statements: HELP! I'M DESPERATE AND SUICIDAL. I'M TIRED OF FINGERING MYSELF! I CAN'T KEEP A GUY CAUSE I'M 4 FOOT 11, BALDING, OVERWEIGHT, HAVE A BLADDER DISEASE AND I'V HAD AN ABORTION ...

⁵³⁰ *Ibid* at 102.

⁵³¹ *Ibid* at 103-104.

⁵³² *Ibid* at 104.

⁵³³ *R v Stevens* [1995] *supra* note 528.

Justice Giesbrecht found "that the overriding objective of the defamatory libel provisions in the *Code* is the protection of reputation."⁵³⁴ Referring to *R v Morgenthaler*,⁵³⁵ she said "[a] defamatory attack on a person's reputation involves a violation of that person's integrity and human dignity in much the same way that a physical assault does, and may in some circumstances have more serious consequences."⁵³⁶ She added that harm to reputation may result in "emotional distress, shame, horror, worry, fear and possible economic deprivation."⁵³⁷ Justice Giesbrecht, however, did not provide specifics in her judgment against the accused about how the reputation of the victim had been impugned by the accused.

The accused appealed from the judgment of Justice Giesbrecht but only as to the length of the sentence. The Manitoba Court of Appeal dismissed the appeal.⁵³⁸

⁵³⁴ *R v Stevens*, [1993] *supra* at 110, at 119. Justice Giesbrecht noted

The Law Reform Commission of Canada in its 1984 Working Paper 35, "Defamatory Libel", at p. 45, concluded that the present crime of defamatory libel protects two fundamental values, reputation and privacy. Protection of reputation, it said, is evident from the definition of defamatory libel in s. 298; protection of privacy is apparent from the defence of justification in s. 311, which requires that as well as being true a libel must be published for the public benefit.

She also said

Protection of privacy may well be a secondary objective where the offence is defamatory libel *simpliciter* under s. 301. That offence, however, is not the subject of these proceedings and should be left to be considered in a case where that provision is directly in issue.

The distinction between the concepts of reputation and privacy are addressed above in Ch 1.

⁵³⁵ *R v Morgenthaler* (1988), 37 CCC (3d) 449, 44 DLR (4th) 385, [1988] 1 SCR 30 (SCC).

⁵³⁶ *R v Stevens*, *supra* note 110, at 121.

⁵³⁷ *Ibid.* For the connection between the "economic deprivation" and the "material injury to the plaintiff's reputation" see an earlier discussion about reputation in the defamation statutes in Canada.

⁵³⁸ *R v Stevens*, [1995] *supra* note 528.

*R v Lucas*⁵³⁹

In this case, the two accused (Mr John Lucas and Mrs Johanna Lucas) were both found guilty of the offence of defamatory libel under s 300 of the *Criminal Code* for "publish[ing] matter without lawful justification or excuse that was likely to injure the reputation of [a police officer] by exposing him to hatred, contempt or ridicule or that was designed to insult [the officer], knowing that the matter published was false."⁵⁴⁰ In his judgment, Justice Paul Hrabinsky, sitting alone, said that "[t]he essential feature of a criminal libel remains, as in the past, the publication of a grave, not trivial, libel".⁵⁴¹ He discussed section 300 of the *Criminal Code* and said "[t]he objective of s. 300 of the Criminal Code is the protection of individuals from false defamatory attacks on their

⁵³⁹ *R v Lucas* [1998] 1 SCR 439: sentence appeal dismissed. Justice Cory for himself, Lamer CJ, Gonthier, Cory, Iacobucci and Bastarache JJ; Justice L'Heureaux-Dubé concurring; Justices McLachlin and Major JJ. dissenting on Mrs. Johanna Lucas's sentencing appeal; Justice Sopinka took no part in the judgment. *R v Lucas*, [1996] 137 Sask R 312: appeal from trial on the merits dismissed; sentence appeal allowed and sentences for Mr and Mrs Lucas varied (Justice Vancise for himself and Justices Tallis and Lane). *R v Lucas* [1995] 129 Sask R 53 (Hrabinsky J), trial judgment.

⁵⁴⁰ *R v Lucas*, [1995] 129 Sask R 53:

FACTS

Pursuant to s 655 of the Criminal Code the accused admitted the following facts:

...

2. On September 20, 1993 at 9:00 A.M. the accused were observed to be walking on a public sidewalk in front of the Police Station in Q, Sask. carrying a sign which had printed on one side the words "Did [rank] [police officer] just allow or help with the rape/sodomy of an 8 year old" and on the other side the words "If you admit it [the police officer] then you might get help with your touching problem".

...

This case was complex and controversial: Williams, *supra* note 134 at 189, notes that, although in this case the Lucases were found guilty, "[y]ears later, the foster parents successfully brought a malicious prosecution lawsuit against the officer ... Ironically, the grievance underlying the Lucases inflammatory protest was ultimately a valid criticism of police conduct".⁵⁴⁰

⁵⁴¹ *Ibid*, under the heading: "The Law."

privacy and reputations."⁵⁴² He further said "[i]t cannot be disputed that reputation is a significant facet of the inherent dignity and worth of the human person."⁵⁴³

The convictions and sentences imposed by the trial judge on the Lucases were appealed. While the convictions were upheld, the Saskatchewan Court of Appeal modified the sentences.⁵⁴⁴ The Supreme Court of Canada dismissed the further sentencing appeals made by Mr. and Mrs. Lucas.⁵⁴⁵

It was not possible to glean anything pertinent to this research from either *R v Stevens*⁵⁴⁶ or *R v Lucas*⁵⁴⁷ because neither trial judge wrote directly about how they interpreted reputation in the cases before them. Nor did either of them identify what evidence before them supported their findings of reputation.

G - Conclusion

Civil defamation cases in Canada are among the few remaining civil causes of action that can be tried by either a judge and jury or a judge alone.

⁵⁴² *Ibid*, under the heading: "Objective." There is no mention of privacy in s 300 of the *Criminal Code* (See the full citation of this provision in Appendix C). In addition, see Justice Giesbrecht about privacy and reputation in *R v Stevens*, discussed above (in text at note 111).

⁵⁴³ *Ibid*, under the heading: "Objective."

⁵⁴⁴ *R v Lucas*, 1996 107 WAC 312, 137 Sask R 312, Sentence Appeal ("In the result, the appeal as to conviction is dismissed. The sentence appeal is allowed and the sentences modified as above indicated.")

⁵⁴⁵ *R v Lucas*, [1998] *supra* note 539: Justice Cory delivered the judgment of himself, Lamer CJ, Gonthier, Cory, Iacobucci and Bastarache JJ; Justice L'Heureaux-Dubé concurred; Justices McLachlin and Major JJ. dissented on Mrs. Johanna Lucas's appeal (though not on any aspect relevant to this discussion); and Justice Sopinka took no part in the judgment.

⁵⁴⁶ *R v Stevens* [1995], *supra* note 528.

⁵⁴⁷ *R v Lucas* [1998], *supra* note 539.

In cases tried before judge and jury, the jury decides issues involving reputation -- and in Canada, by law, all jury deliberations are confidential.

As set out above,⁵⁴⁸ evidence of First World War General Currie's reputation was introduced at the trial of the defamation action he instigated – but, in the end, it appears to have had less effect on the outcome than it might have done: while Currie won his libel action, he was awarded only \$500⁵⁴⁹ (of \$50,000 claimed⁵⁵⁰).

Cases tried before judges alone were expected to provide direct evidence of findings concerning the plaintiffs' reputations. *Vander Zalm v Times Publishers*,⁵⁵¹ *WIC Radio v Simpson*⁵⁵² and *Crookes v Newton*⁵⁵³ are only civil cases before a judge alone analyzed. *R v Stevens*⁵⁵⁴ and *R v Lucas*,⁵⁵⁵ the two criminal cases analyzed, were also tried before a judge alone. In none of these five cases (civil or criminal) do the judgments reveal what evidence the trial judges used in making findings about the plaintiffs' or victims' reputations.

⁵⁴⁸ See text at footnote 446 (above), quoting from Sharpe at 212-213.

⁵⁴⁹ Sharpe, *supra* note 429, at 225.

⁵⁵⁰ *Ibid*, at 224.

⁵⁵¹ *Vander Zalm v Times Publishers* (1980), *supra* note 243.

⁵⁵² *WIC Radio Ltd v Simpson* (2008), *supra* note 244.

⁵⁵³ *Crookes v Newton* (2011), *supra* note 366. As described above, this case never reached a stage that involved considering evidence.

⁵⁵⁴ *R v Stevens* [1993] *supra* note 110; appeal to the Court of Appeal dismissed, see *R v Stevens* [1995] *supra* note 528.

⁵⁵⁵ *R v Lucas* [1995] *supra* note 540, reversed in part by *R v Lucas* [1996] *supra* note 544, further appeal dismissed, *R v Lucas* [1998] *supra* note 539.

CHAPTER 4 - REPUTATION AS EXPRESSED IN THE CANADIAN LAW OF MORAL RIGHTS

A – Background and International Presence

Reputation in Canada's defamation law has been analyzed in the two previous chapters. In addition to finding that the meaning of 'reputation' theorized by Post as integral to defamation (described in Chapter 2) is neither discussed in Canadian defamation jurisprudence nor supported by Canadian defamation jurisprudence, Chapter 3 has demonstrated that none of the reported Canadian cases involving defamation, either civil or criminal, focuses on evidence related to proving the reputation at the core of the defamation litigation. While this finding was to be expected in the cases involving jury trials (because jury findings are confidential), it is an unexpected finding in the context of defamation trials by judges sitting alone.

Because there is no evidence of reputation as applied in defamation cases available, no analogy is possible between the concept of reputation as understood in Canadian defamation law and the concept of reputation as it may be discovered in connection with moral rights, prohibited marks or geographical indications.

In the chapters that follow, this research turns, then, to the central focus of this thesis: analyzing the concept of reputation in the context, respectively, of moral rights (Chapter 4), prohibited marks (Chapter 5) and geographical indications (Chapter 6).

This chapter asks whether reputation is involved in moral rights.⁵⁵⁶

⁵⁵⁶ Chapters 5 (on Prohibited Marks) and 6 (on Geographical Indications) each consider a second specific question in connection with the analysis presented in them. However, it will be seen in this chapter that asking a question such as "Is reputation in the moral rights context the same as reputation found in

It has been pointed out by Margaret Ann Wilkinson and Natasha Gerolami that

moral rights and economic rights in copyright are best understood as the implementation of information policy designed to further the interests of society in an expanding supply of reliable, available information. The economic rights are designed to address the supply of available information, while moral rights are designed to address making reliability of that supply ascertainable.⁵⁵⁷

They predict that “[w]ith the growing complexity of the information environment, moral rights will become increasingly important as a guarantee for the authority and integrity of the work.”⁵⁵⁸

Tanya Aplin and Ahmed Shaffan Mohamed (publishing in 2019 on the United Kingdom’s legislation concerning the concept of reputation in the moral right of integrity)⁵⁵⁹ wrote “[c]rucial to the scope of the integrity right is the concept of prejudice to the author’s ‘honour’ or ‘reputation.’”⁵⁶⁰ They noted that “there has been limited exploration by courts or commentators of what ‘honour’ or ‘reputation’ means”⁵⁶¹ and argued that the test of prejudice to reputation should “legitimately borrow from the law of defamation.”⁵⁶²

After expanding the background to moral rights provided in Chapter 1 and then discussing the presence of moral rights in international law, this chapter explores two

copyright?” is not a question that makes sense in context: this chapter makes clear that copyright is not in any way dealing with reputation.

⁵⁵⁷ Wilkinson & Gerolami, “The Author as Agent of Information Policy”, *supra* note 20 at 331.

⁵⁵⁸ *Ibid.*

⁵⁵⁹ *Copyright, Designs and Patents Act 1988* (UK), c 48.

⁵⁶⁰ Tanya F Aplin & Ahmed Shaffan Mohamed, “The Concept of ‘Reputation’ in the Moral Right of Integrity” (2019) 14:4 *J Intell Prop L & Prac* 268 at 268.

⁵⁶¹ *Ibid.*

⁵⁶² *Ibid.*

further topics: what commentators say about moral rights in Canada and what concept of reputation is reflected in Canadian moral rights law.

Michelangelo Buonarroti was a leading artist in his day and likely his prominence would have allowed him to insist upon his name being associated with his works, and his works being left as he had created them, without ever exercising moral rights in connection with his work⁵⁶³ -- but, in any case, in Michelangelo's time (1475-1564), as Susan Liemer points out,⁵⁶⁴ there was no law protecting authors' or artists' moral rights: it was the pure force of Michelangelo's reputation that allowed him to succeed in controlling uses of his name and his work (perhaps contracts were also involved because, as Liemer points out, most of his artwork was commissioned⁵⁶⁵).

Moral rights⁵⁶⁶ came into existence after the concepts of copyright and *droit d'auteur* had entered public international law.⁵⁶⁷ Moral rights cannot be assigned and are inseparable from the individuals in whom they have arisen and inseparable from the heirs of those individuals. This is in direct contrast to the economic rights involved in copyright, which, as noted in Chapter 1, are transferable. To this day, it has been noted

⁵⁶³ Susan P Liemer, "On the Origins of *Le Droit Moral*: How Non-Economic Rights Came to Be Protected in French IP Law" (2011) 19:65 *J Intell Prop L* 65 at 78-79

⁵⁶⁴ *Ibid.*

⁵⁶⁵ *Ibid.*

⁵⁶⁶ Moral rights originated from French civil law tradition (*droits moraux*), which refers to individual, personal, thus inalienable rights of an author of literary or artistic works. (For the origin of "moral rights" in intellectual property and its relationship to economic rights (copyright) see Wilkinson, "The Public Interest in Moral Rights Protection" *supra* note 18; Wilkinson & Gerolami, "The Author as Agent of Information Policy" *supra* note 20; see also Mistrale Goudreau, "Le droit moral de l'auteur au Canada" (1994) 25:3 *RGD* 403.

⁵⁶⁷ The initiative for adding "moral rights" to the Berne Convention came from civil law countries of continental Europe (France, Germany, Italy) while the common law countries (especially the US) initially opposed adding them. See Margaret Ann Wilkinson & Natasha Gerolami "The Information Context of Moral Rights under the Copyright Regime" (2004) *Law Publications* 78, online <<https://ir.lib.uwo.ca/lawpub/78>>.

that "in civil law countries [where moral rights originated], moral rights are of great importance, ... whereas in common law jurisdictions the rationale behind copyright is generally more utilitarian and economic, whereas moral rights are weaker."⁵⁶⁸

As previously noted in Chapter 1, public international law efforts to expand the rights of authors not only to protect their economic rights in literary and artistic works but also to give them more control over their works first culminated in the 1928 Rome Revision of the Berne Convention, which added Article *6bis*:⁵⁶⁹

1928

Rome Revision

Original Article *6bis*

(1) Independently of the author's economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work, as well as the right to object to any distortion, mutilation or other modification of the said work, which would be prejudicial to his **honor or reputation** [emphasis added].

(2) The determination of the conditions under which these rights shall be exercised is reserved for the national legislation of the countries of the Union. The means of redress for safeguarding these rights shall be regulated by the legislation of the country where protection is claimed.

The 1948 Brussels Revision of the Berne Convention specified that "moral rights" were to be bequeathed to the author's heirs for a minimum duration equivalent to the term of economic rights. Ownership of and succession to the moral rights in works were to be

⁵⁶⁸ Iona Harding & Emily Sweetland, "Moral rights in the modern world: is it time for a change?" (2012) 7:8 J Intell Prop L & Prac 565 at 569.

⁵⁶⁹ *Berne Convention for the Protection of Literary and Artistic Works*, 9 September 1886, completed at Paris on 4 May 1896, revised at Berlin on 13 November 1908, completed at Berne on 20 March 1914, revised at Rome on 2 June 1928.

independent of ownership and succession in respect of the economic rights. The sections of Article *6bis* after the Brussels Revision read as follows⁵⁷⁰:

1948

Article 6bis (revisions are in bold)

Brussels Revision

(1) Independently of the author's economic rights, and even after the transfer of the said rights, the author shall have the right, **during his lifetime**, to claim authorship of the work, **and** to object to any distortion, mutilation or other modification of, or any other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation. [emphasis added]

(2) In so far as the legislation of the countries of the Union permits, the rights granted to the author in accordance with the preceding paragraph shall, **after his death, be maintained, at least until the expiry of the economic rights**, and shall be exercisable by the persons or institutions authorized by the said legislation. [emphasis added]

(3) The means of redress for safeguarding the rights granted by this Article shall be governed by the legislation of the country where protection is claimed.

The text of Article *6bis* was revised again in Stockholm in 1967. This revision of the "moral rights" provision provided additional flexibility for members of the Union by allowing member states whose law upon joining the Berne Union did not provide for protection after death for all of the moral rights to continue to provide, in their legislation, for provision of only some of the moral rights after death.⁵⁷¹

⁵⁷⁰ *Berne Convention for the Protection of Literary and Artistic Works*, 9 September 1886, completed at Paris on 4 May 1896, revised at Berlin on 13 November 1908, completed at Berne on 20 March 1914, revised at Rome on 2 June 1928, revised at Brussels 1948.

⁵⁷¹ Berne Convention, *supra* note 55.

1967

Article 6bis (revisions made in 1967 are in bold)

Stockholm Revision (1) Independently of the author's economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation.

(2) The rights granted to the author in accordance with the preceding paragraph shall, after his death, be maintained, at least until the expiry of the economic rights, and shall be exercisable by the persons or institutions authorized by the legislation of the country where protection is claimed.

However, those countries whose legislation, at the moment of their ratification of or accession to this Act, does not provide for the protection after the death of the author of all the rights set out in the preceding paragraph may provide that some of these rights may, after his death, cease to be maintained.

(3) The means of redress for safeguarding the rights granted by this Article shall be governed by the legislation of the country where protection is claimed.

Although the Berne Convention was also revised in Paris in 1971, and again amended in 1979⁵⁷², Article 6*bis* has not been changed since the Stockholm revision.⁵⁷³

⁵⁷² Following the Paris Revision to the Berne Convention in 1971, the United States joined the Berne Convention (at the 1971 level) in 1989, which means that the United States purports to have recognized "moral rights." The American effort in this regard can, at best, be termed minimalist since their only legislative expression in this area is the 1990 *Visual Artists Rights Act* (VARA) 17 USC §106A. See "Intellectual Property – Copyright – Second Circuit Finds Temporary Art Protected under the Visual Arts Rights Act – *Castillo v G&M Realty L.P.*, 950 F.3d 155 (2d Cir. 2020)" (2021) 134:5 Harv L Rev 1881, which begins

[t]he Visual Rights Act of 1990 grants the authors of visual artworks the "non-economic 'moral rights'" of attribution and integrity, a 'statutory first in [U.S.] federal copyright law ... Recently, in *Castillo v G&M Realty L.P.*, the Second Circuit extended VARA's moral rights protections to temporary works of art, holding that aerosol art in a warehouse exhibition space had achieved 'recognized stature' under VARA.[footnotes omitted]

According to the US Copyright Act 17 USC §101 Definitions:

A 'work of visual art' is –

a painting, drawing, print, or sculpture, existing in a single copy, in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author, or, in the case of a sculpture, in multiple cast, carved or fabricated sculptures of 200 or fewer that are consecutively numbered by the author and bear the signature or other identifying mark of the author, or a still photographic image produced for exhibition purposes only, existing in a single copy that is signed by the author, or in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author.

A work of visual art does not include –

- (A)(i) any poster, map, globe, chart, technical drawing, diagram, model, applied art, motion picture or other audiovisual work, book, magazine, newspaper, periodical, data base, electronic information service, electronic publication, or similar publication;
- (ii) any merchandising item of advertising, promotional, descriptive, covering, or packaging material or container;
- (iii) any portion or part of any item described in clause (i) or (ii);
- (B) any work made for hire; or
- (C) any work not subject to copyright protection under this title.

While there is no requirement in the Berne Convention that the moral rights be legislated in a jurisdiction – or that the protection of moral rights be legislated as part of the legislation of copyright (and therefore the moral rights can, in a common law jurisdictions, simply exist as a matter of common law), Laura Gassaway, in "Copyright and Moral Rights" ((2002) 6:12 *Information Outlook* 40), noted the

[U.S.] Congress concluded [when the United States acceded to the Convention November 26, 1988] that various state and federal laws afforded U.S. authors the minimum protection necessary for Berne accession. These laws include trademark law as well as laws governing misappropriation, defamation, and the rights of publicity and privacy. Additionally, 11 states already had some moral rights laws on their books.

However, most authors do not believe that the United States has even now fully fulfilled its Berne obligation to provide law embracing moral rights: as Roberta Rosenthal Kwall noted, in chapter 3 "The Current Legal Framework" in *The Soul of Creativity: Forging a Moral Rights Law for the United States* (Stanford University Press, 2009), "Copyright law in the United States fails to afford authors, in an explicit fashion, comprehensive moral rights..." (at 25) and she goes on to explicitly critique VARA, at 28:

VARA provides very circumscribed federal statutory protection for the moral rights of certain visual artists... One significant problem with VARA is that the statute only applies to a very narrow category of visual art... VARA specifically excludes protection for reproductions of

While the term “moral rights” does not appear explicitly in the Berne Convention in Article 6*bis*, it *is* used in the Berne Convention in Article 11*bis* (added in the 1928 Revision) under which authors shall have exclusive authorizing rights for broadcasting or rebroadcasting or otherwise communicating their works (paraphrasing Article 11*bis*(1)). Article 11*bis*(2) declares that the rights in Article 11*bis*(1) “shall not in any circumstances be prejudicial to the moral rights of the author”.⁵⁷⁴ Though the Berne Convention has consistently referred to "honour or reputation" together, it does not provide specifics regarding either of these concepts.

The Berne Convention makes no mention of performers or performances. The protection of "moral rights" for performers and their performances entered public international law through the 1996 *WIPO Performances and Phonograms Treaty* (WPPT),⁵⁷⁵ which Canada ratified in 2014.⁵⁷⁶

Article 5

Moral Rights of Performers

(1) Independently of a performer’s economic rights, and even after the transfer of those rights, the performer shall, as regards his live aural performances or performances fixed in phonograms, have the right to claim to be identified as the performer of his performances, except where omission is dictated by the manner of the use of the performance, and to

works, and fails to provide any remedy when works are used in a context found objectionable or distasteful by the author.

By contrast to the situation in the United States, the United Kingdom added moral rights to its *Copyright Designs and Patents Act* (CDPA) in 1988 (*Copyright, Designs and Patents Act 1988* (UK), c 48, - Chapter IV Moral Rights, sections 77-89).

⁵⁷³ The expression "moral rights" does not appear in Article 6*bis* of the Berne Convention. However, "the right to claim authorship of the work and [the right] to object to any distortion, mutilation or other modification of the said work" (language which does appear in Article 6*bis*) have been recognized as two categories of "moral rights": the right of paternity (or authorship), and the right of integrity, respectively.

⁵⁷⁴ Berne Convention, *supra* note 55.

⁵⁷⁵ *WIPO Performances and Phonograms Treaty* (WPPT), 20 December 1996, 186 UNTS 203 (entered into force 20 May 2002), art 5.

⁵⁷⁶ WIPO, *WPPT Notification 86, WIPO Performances and Phonograms Treaty: Ratification by Canada* ("The said Treaty will enter in into force, with respect to Canada, on August 13, 2014.").

object to any distortion, mutilation or other modification of his performances that would be prejudicial to his reputation.

(2) The rights granted to a performer in accordance with paragraph (1) shall, after his death, be maintained, at least until the expiry of the economic rights, and shall be exercisable by the persons or institutions authorized by the legislation of the Contracting Party where protection is claimed. However, those Contracting Parties whose legislation, at the moment of their ratification of or accession to this Treaty, does not provide for protection after the death of the performer of all rights set out in the preceding paragraph may provide that some of these rights will, after his death, cease to be maintained.

(3) The means of redress for safeguarding the rights granted under this Article shall be governed by the legislation of the Contracting Party where protection is claimed.

It is noteworthy in the WPPT that Article 5 refers only to “reputation” and not to the Berne Convention terminology of “honour or reputation”.

Australian author Dennis Lim has commented that, at the Brussels Conference in 1948, "a number of member countries indicated that they saw 'reputation' and 'honour' as distinctly separate."⁵⁷⁷ Iona Harding and Emily Sweetland have commented that “[i]n any case, ‘reputation and honour’ is difficult to define clearly” though “reputation is easier to judge than honour”.⁵⁷⁸ Harding and Sweetland observe that “[h]onour is a more difficult concept for British lawyers; however, in Japan, for example, honour is a well-established cultural and legal concept.”⁵⁷⁹ This chapter will explore whether consideration of the moral rights by Canadian courts identifies any distinction being made in Canadian jurisprudence between these two concepts.

⁵⁷⁷ Dennis Lim, "Prejudice to Honour or Reputation in Copyright Law" (2007) 33:2 Monash U L Rev 290 at 293 [footnote omitted].

⁵⁷⁸ Both statements appear in Iona Harding & Emily Sweetland, "Moral rights in the modern world..." *supra* note 568.

⁵⁷⁹ *Ibid.*

Berne Article *6bis* describes two distinct types of moral rights: the right of paternity and the right of integrity.⁵⁸⁰ The right of paternity is expressed, in Article *6bis*, as “the right to claim authorship of the work.” The right of integrity is expressed as “the right to object to any distortion, mutilation or other modification of the said work.”

The relative weakness of moral rights protection on the global stage (as compared to protection of copyrights, trademarks, patents, prohibited marks and geographical indications⁵⁸¹) stems from the fact that protection of moral rights is only set out in public international law, in the Berne Convention. The reason that moral rights have been locked out of international trade agreements is that the United States opposed their introduction into TRIPS Agreement and therefore subsequent TRIPS-plus trade agreements). This is because the United States has domestically come to oppose the concept of moral rights, believing them to be incompatible with the rights created by copyright.⁵⁸² In terms of its Berne Convention obligation under Article *6bis*, Patrick Goold notes

When assessing the American potential compliance with article *6bis*, an Ad Hoc Working Group came to the controversial conclusion that, while U.S. law contained no explicit moral rights provision, a “patchwork” of federal and state causes of action, from state common law libel and privacy actions to the federal Lanham Act [trademark] provisions on unfair competition, provided sufficient protection to attribution and integrity interests to enable the United States to join the Berne Convention without further legislation on moral rights.⁵⁸³

⁵⁸⁰ Note below that there is a further right enacted in the moral rights provisions in Canada’s *Copyright Act*, which may, in fact, be either an extension beyond the text of the Berne Convention in terms of the right to integrity or a third right, separate and apart from either the right to integrity or the paternity right.

⁵⁸¹ The connection of the prohibited marks and geographical indications to the trade environment of the TRIPS Agreement (*supra* note 9) will be established in subsequent chapters.

⁵⁸² See Patrick R. Goold, “The Lost Tort of Moral Rights Invasion,” (2017) 51 *Akron L Rev* 1093 at 1094.

⁵⁸³ *Ibid* at 1122. [footnote omitted].

Goold, however, demonstrates that, during the twentieth century American courts did create law that recognized rights now understood internationally to be moral rights but that these initiatives lost ground after 1980 and eventually an American rhetoric of moral rights as un-American replaced them.⁵⁸⁴

Canada having obligations respecting the moral rights under its trade agreements is specifically ruled out by its membership in the TRIPS Agreement where, in Article 9(1), it specifies:

Members shall comply with Articles 1 through 21 of the Berne Convention (1971) and the Appendix thereto. However, Members shall not have rights or obligations under this Agreement in respect of the rights conferred under Article 6*bis* of that Convention or of the rights derived therefrom.

In light of Article 9(1) in TRIPS, an agreement from which all of Canada's subsequent trade treaties flow, no subsequent trade agreement into which Canada has entered has dealt substantively with moral rights.⁵⁸⁵

⁵⁸⁴ *Ibid* at 1124.

⁵⁸⁵ Canada implemented CUSMA, the Canada-United States-Mexico Agreement, in 2020 through the *Canada-United States-Mexico Agreement Implementation Act*, SC 2020, c 1. In CUSMA, Article 20.65 dealing with Contractual Transfers, provides:

Each Party shall provide that for copyright and related rights, any person acquiring or holding an economic right ^{Footnote 63} in a work, performance, or phonogram:

- (a) may freely and separately transfer that right by contract; and
- (b) by virtue of contract, including contracts of employment underlying the creation of works, performances, or phonograms, must be able to exercise that right in that person's own name and enjoy fully the benefits derived from that right [2nd footnote, footnote 64, about Contractual transfers, omitted]

Footnote 63 to Article 20.65 reads "For greater certainty, this Article does not affect the exercise of moral rights."

The predecessor to CUSMA, the *North American Free Trade Agreement* [NAFTA] between Canada, Mexico and the United States, which as signed before TRIPS, did not contain any explicit mention of "moral rights", though it did state, in Article 1701(2) of NAFTA that "To provide adequate and effective protection and enforcement of intellectual property rights, each Party shall, at a minimum, give effect to this Chapter and to the substantive provisions of... (b) the *Berne Convention for the Protection of Literary and*

B - Commentators on Moral Rights in Canada

(a) General Comments

In *Théberge v Galerie d' Art du Petit Champlain*,⁵⁸⁶ a decision of Canada's Supreme Court that will be discussed extensively below,⁵⁸⁷ Justice Binnie, in his majority judgment, comments that

Moral rights, by contrast [with copyright], descend from the civil law tradition. They adopt a more elevated and less dollars and cents view of the relationship between an artist and his or her work. They treat the artist's oeuvre as an extension of his or her personality, possessing a dignity which is deserving of protection. The focus on the artist's right ... to protect throughout the duration of the economic rights ... both the integrity of the work and his or her authorship of it (or anonymity, as the author wishes).

Margaret Ann Wilkinson has pointed more directly to the differing roles copyright and the moral rights play (roles both increasingly important as the modern information society advances):

The two regimes [copyright and moral rights] are undeniably related. The nature of that relationship, from the public's perspective, centers on the contribution each system makes to the fundamental requirements of individuals in society related to satisfying information needs: the need for access to information and the need for indications of the authority of the information available in order to make informed choices among available sources. Copyright systematically addresses the first need and moral rights systematically address the second.⁵⁸⁸

Dennis Lim has argued that the right of paternity has no direct connection to reputation as the right of paternity is simply the right of an author to have that author's

Artistic Work, 1971". See <https://www.international.gc.ca/trade-commerce/trade-agreements-accords-commerciaux/agr-acc/nafta-alena/fta-ale/17.aspx?lang=eng>

⁵⁸⁶ *Théberge v Galerie d' Art du Petit Champlain*, 2002 SCC 34, [2002] 2 SCR 336 at para 15.

⁵⁸⁷ In part C of this chapter, on "'Reputation' in the Context of Moral Rights in Canadian Law".

⁵⁸⁸ Wilkinson, "The Public Interest ..." *supra* note 18 at 217.

name remain connected with a work.⁵⁸⁹ It is the position of this author, however, that having the author's name permanently associated with the author's work will inevitably mean that the work will either enhance or degrade its author's reputation – and that, *vice versa*, the reputation of the author will either enhance or degrade the reputation of the work.

Quite apart from the role reputation plays in connection with the moral right of paternity, it appears indisputable that reputation *is* directly connected to the moral right of integrity. This thesis, focussing on the context of reputation as it is involved in specific facets of intellectual property, is focused on exploring the concept of reputation specifically in connection with moral rights, prohibited marks and geographical indications and, in the latter two contexts (prohibited marks and geographical indications), the marks involved are used in connection with certain specific products, services, institutions or individuals. It is the moral right of integrity (linking a work with its individual author or authors), rather than the moral right of paternity (which gives the author or authors control over having their name or names linked to a work), that links a work and its reputation in the same sense as reputation is linked in the contexts of prohibited marks and geographical indications. Therefore, it must be the moral right of integrity that is the focus of this chapter.⁵⁹⁰ while having the work's author's name

⁵⁸⁹ Dennis Lim, *supra* note 577 at 293 [footnote omitted].

⁵⁹⁰ The author's moral right to attribution and right to integrity in a work were separated into two clear provisions in 1988, when Canada amended its copyright statute (*An Act to Amend the Copyright Act and to Amend Other Acts in Consequence Thereof* (Statutes of Canada 35-36-37 Elizabeth II (assented to 8 June 1988) c 15, s 18.2(1)(b)). In 2012 Canada added a performer's right to attribution with and integrity in their performance (*Copyright Modernization Act*, SC 2012, c 20 (in force 7 November 2012)).⁵⁹⁰ Also added to the *Copyright Act*, in 2012, was an entirely new provision stating that “[t] author’s or performer’s right to the integrity of a work or performer’s performance is, to the prejudice of its author’s or performer’s honour or reputation... (b) used in association with a product, service, cause or institution” (*Copyright Act*, s 28.2(1)(b)). Lesley Ellen Harris provides, as an illustration of a situation in which a moral rights holder could sue under this new provision, the example of an artist objecting when the artist’s work is presented at

associated with a work (the right of paternity) is clearly related to the reputation of that author, the reputation of the work itself is directly connected with the moral right of integrity.

Several commentators have, in the past, associated the concept of reputation in moral rights with the concept of reputation in trademark: Iona Harding and Emily Sweetland have noted that, in considering moral rights, "reputation is easier to judge than [is] honour, [because of] reputation being a familiar idea relevant, for example, to the tort of defamation and trade mark law"⁵⁹¹; Rowland Lorimer has not only said "[moral rights] are related to the reputation of an author and how the treatment by other rights holders of an author's or creator's work affects that reputation"⁵⁹² but also that "[moral rights] are akin to the historical sense of a trademark, a sign of the reputation of the trader."⁵⁹³

(b) Commentator Dennis Lim on the moral rights and defamation law

Dennis Lim considered the moral rights in the context of defamation law and argued a number of points:

“an art exhibit sponsored by a tobacco company where the artist’s reputation rides on the fact that she is a no-smoking advocate” (Lesley Ellen Harris, “Moral Rights in Canadian Copyright Law” (2010) 34:5 *LawNow* 14 at 16). The provision has been identified as a new moral right (a right to association) separate from Canada’s statutory moral rights of paternity and attribution (see Wilkinson and Gerolami, “The Author as Agent of Information Policy” *supra* note 20 at 326-327. Other authors, as noted below, however, interpret this statutory addition as merely expanding the right of integrity. It is interesting to note that the federal government provides a description of moral rights that lists "right of paternity... right of integrity ... right of association..." The entry under "right of association" begins "part of the **right of integrity** is an author's /creator's **right of association** ..." [emphasis in original]. See online: < Moral Rights - Canada.ca.

⁵⁹¹ Harding & Sweetland, *supra* note 568 at 569.

⁵⁹² Lorimer, *supra* note 63 at 5 [emphasis added].

⁵⁹³ *Ibid.*

- (1) that since the moral right of integrity is subject to the concept of *prejudice* to the authors' "honour or reputation", it goes beyond the law of defamation which is solely dealing with "reputation ";⁵⁹⁴
- (2) using Canadian cases as examples, that the test for reputation in defamation is an objective test: the law of the moral right of integrity goes beyond the test for reputation in defamation because, for moral rights, the test for reputation involved in the right contains a subjective element;⁵⁹⁵
- (3) that the concept of honour associated with the moral rights in the *Berne Convention* is different from the concept of reputation and, therefore, nations, in their laws, should be treating the two concepts separately;⁵⁹⁶
- (4) finally, that, because of a lack of distinction being made between the terms "honour" and "reputation" (which appear together in the Canadian statute), Canadian courts always use the two terms together.⁵⁹⁷

With respect to Dennis Lim's second argument, he stated that "Canadian courts have interpreted the prejudice requirement in the right of integrity as involving a test that contains subjective elements as well as the objective element of reasonableness."⁵⁹⁸ He pointed to the early decision in *Snow v Eaton Shopping Centre*, saying the approach of the trial judge "was first to consider the plaintiff's subjective evidence of prejudice, then determine whether it was an objectively reasonable view of the prejudice."⁵⁹⁹ Lim then

⁵⁹⁴ Dennis Lim, *supra* note 577 at 301.

⁵⁹⁵ *Ibid* at 300.

⁵⁹⁶ *Ibid* at 293.

⁵⁹⁷ *Ibid* at 297.

⁵⁹⁸ *Ibid* at 300.

⁵⁹⁹ *Ibid* at 302, citing to *Snow v Eaton Shopping Centre supra* note 637 (Justice O'Brien, Ontario High Court of Justice). Note that this litigation was based on the original instantiation of moral rights in Canada's *Copyright Act*, s 12(7):

Independently of the author's copyright, and even after the assignment, either wholly or partially, of the said copyright, the author has the right to claim authorship of the work, as well as the right to restrain any distortion, mutilation or other modification of the work that would be prejudicial to his honour or reputation.

concluded that “[i]n *Snow*, the objective evidence of well respected authors and people knowledgeable in the author’s field helped satisfy the objective/subjective test.”⁶⁰⁰

However, what Justice O’Brien actually wrote in his decision in *Snow v Eaton Shopping Centre* was that the artist

is adamant in his belief that his naturalistic composition has been made to look ridiculous..., [and] the artist’s opinion is shared by a number of other well respected people knowledgeable in his field.

This finding speaks to the artist’s subjective opinion being bolstered by the subjective opinions of ‘other well respected people knowledgeable in his field’ – and what that finding of fact provided was objective evidence that the artist involved had a reputation (the subjective opinions of ‘other well respected people knowledgeable in his field’) – which were, themselves, objective evidence that *Snow*’s original “naturalist composition” of flying geese, now festooned with ribbons, no longer appeared “naturalist” and was therefore, in the opinion of the artists who gave evidence, ridiculous.

With respect to Dennis Lim’s third argument, that the concept of honour associated with the moral rights in the Berne Convention is different from the concept of reputation and, therefore, nations, in their laws, should be treating the two concepts separately, Lim pointed to the 1997 Canadian case of *Boudreau v Lin*.⁶⁰¹ Lim claimed that *Boudreau v Lin* “was clearly not a prejudice to honour case, as the charges [sic] could not have affected the plaintiff’s [Boudreau’s] reputation.”⁶⁰² The plaintiff Boudreau “was a part-time student in the M.B.A. program at the University of Ottawa” (para 2)

⁶⁰⁰ *Ibid.*

⁶⁰¹ *Boudreau v Lin* (1997) 75 CPR(3d), Ont Sup Ct (Justice Ducharme).

⁶⁰² Dennis Lim *supra* note 577 at 304. Note that this was a civil action, not a criminal one, so Lim’s use of the term “charges” must be a slip.

who “took a Directed Reading course from the defendant [Professor Lin]” (para 3). The litigation was over “a paper which [Boudreau] prepared for a University class [, a paper] ... published by ... Professor Lin... without [Boudreau’s] knowledge or consent and without attribution to [Boudreau] as author.” (para 1). At paragraph 39 of his judgment, Justice Métivier set out Boudreau’s claims in the case:

Mr. Boudreau’s claims are founded on the appropriation of his work by a non-author, the photocopying of it without permission and the interference with the integrity of his work by the additions, deletions and changes to it effected by Professor Lin.

Dennis Lim, in his article, stated

[t]he plaintiff [Boudreau] did not adduce any objective evidence of prejudice to honour, ... Métivier J nevertheless held that the additions, deletions and changes to the plaintiff’s work had interfered with the integrity of the work and infringed the right of integrity.⁶⁰³

It appears, however, that evidence *was* adduced at trial, evidence which Justice Métivier considered. About the moral right to paternity, Justice Métivier found, at para 34, “I find as a fact that the plaintiff Mr. Boudreau was the only author of the work in question. I have no difficulty in finding Professor Lin is *not* a co-author [italics in original].” It also appears that Justice Métivier’s recitation of the facts at para 8 clearly presents “objective evidence adduced” which addresses the question of prejudice to honour:

In September of 1992, [former student of Professor Lin] Mr Boudreau was amazed to learn that his paper from the previous August, amended in the most minimal manner, with the omission of certain graphs and tables and with a different title; but with no mention of his name, had been copied and sold to M.B.A. students as a Case Note. He later learned that the paper, in its altered state, had also been presented by Professor Lin at a symposium in another city in September of 1992.

⁶⁰³ *Ibid* [footnote omitted].

On the merits, Justice Métivier found, concerning copyright infringement, at paragraph 52, that “[o]n all of the evidence, as examined in the framework of these rights granted by the Copyright Act, I find that both defendants [Professor Lin and the University of Ottawa] infringed the copyright belonging to the plaintiff.” Justice Métivier then continued, under the heading “Moral Rights”, to find, at paragraph 53, that “[b]oth the rights described (integrity of the work and association by name [paternity]) have been breached by the actions of Professor Lin.” Justice Métivier then continued, at paragraphs 54-61 (the last paragraph in the reasons), to consider “Damages”.

In asserting that “[t]he plaintiff [Boudreau] did not adduce any objective evidence of prejudice to honour, ...”, it appears that Lim may have been referring to Justice Métivier’s finding, at paragraph 57, that

[t]here is no evidence before me that the infringement of the plaintiff’s moral rights has caused any loss to the plaintiff’s reputation. At best there may have been a possibility of a loss of opportunity to acquire a reputation in academic circles. I consider this possibility to be so remote that I accord no weight to it.⁶⁰⁴

In the judgment in *Boudreau v Lin*, however, this finding of Justice Métivier’s is made when he considers what *remedies* should flow from his earlier findings *on the merits* and does not form part of his reasons concerning the liability of the professor to his student. In terms of remedies, Justice Métivier, at paragraph 57, specifically considers whether special or punitive damages should be awarded. Paragraph 56 reads:

Nevertheless, I do not find the conduct of either of the defendants meets the standard of ‘flagrant behaviour and callous disregard’ for Mr.

⁶⁰⁴ *Boudreau v Lin supra* note 601 at para 57.

Boudreau’s rights such as would permit me to award punitive or exemplary damages.

Justice Métivier buttresses his reasoning, in coming to the conclusion that he did on damages (in paragraph 56) and that there has been no loss to the plaintiff’s reputation (paragraph 57), in the following paragraph (paragraph 58):

It is an established principle that merely because there is no commercial market for an academic treatise or paper does not mean that the protection of the Copyright Act is unavailable. However, it does mean that, on breach of those rights, the quantification of damages become problematic.

Justice Métivier concludes his consideration of damages with the following paragraphs (in which he set out his judgment):

[59] I am of the view that an award of general damages in these circumstances and on these facts would be fair and equitable in the amount of \$7,500. This sum is commensurate with the court’s appreciation of the plaintiff’s indignation at the wrong committed, rather than a quantification of the value of the plaintiff’s loss.

[60] Further the [University of Ottawa] and Professor Lin are enjoined from further infringing the plaintiff’s copyright in the paper ‘Strategic Information Technologies for Customized Manufacturing...’.

[61] The plaintiff shall be entitled to his costs on a solicitor/client basis.⁶⁰⁵

Dennis Lim’s fourth argument is that Canadian decisions demonstrate that judges make no distinction between the two terms “honour” and “reputation” since they always use the two terms together. Lim points to two Canadian decisions in making this point:

⁶⁰⁵ Note that costs on a “solicitor/client basis” is also an indication that Justice Métivier found the behaviour of the defendants to be unacceptable. This type of order for costs now translates in Ontario to either “substantial indemnity” or “full indemnity” costs and either can be used to punish reprehensible conduct (see Rule 1.03 of the Ontario Rules of Civil Procedure). See *Manufacturers and Traders Trust Company v Amlinger*, [2006] OJ No 5547 at para 8, per Perell, J., and *Burke v Hudson’s Bay Company*, [2008]OJ No 3936 at paras 17-18 (OCA).

*Boudreau v Lin*⁶⁰⁶ and *Pollock v CFCN Productions Ltd* (1983).⁶⁰⁷ It appears, however, that the jurisprudence he uses to support this argument cannot bear the weight Lim puts upon it.⁶⁰⁸

In *Boudreau*, Justice Métivier's use of the phrase "court's appreciation of the plaintiff's indignation" (para 59) sounds very much like the Court addressing the plaintiff's "honour" rather than the plaintiff's "reputation". The case, discussed at length by Lim, would therefore seem to refute his own hypothesis on this point.

In *Pollock v CFCN Productions Ltd* (1983)⁶⁰⁹, Lim refers to a decision of Associate Chief Justice Moore, granting an interim injunction until trial of the action because "[i]n my view, the plaintiff [playwright Pollock] demonstrated that there are serious questions to be tried including ... the interpretation and application of s. 12(7) [the then moral rights provision] of the Copyright Act".⁶¹⁰ However, there is no indication that a trial ever took place and therefore the *Pollock v CFCN Productions* litigation does not appear to bear the weight of interpretation that Lim places upon it. In coming to his decision on the motion, Associate Chief Justice Moore noted (at para 8) that there were affidavits filed in evidence for the motion "that Pollock's play and screenplay have been seriously distorted, violated and mutilated to the extent that her reputation will be damaged if the film is shown", but the judgment itself is completely

⁶⁰⁶ *Supra* note 601.

⁶⁰⁷ *Pollock v CFCN Productions Ltd* (1983) 73 CPR(2d) 204, Associate Chief Justice Moore of the Alberta Court of Queen's Bench.

⁶⁰⁸ See Dennis Lim, *supra* note 577 at 303.

⁶⁰⁹ *Pollock*, *supra* note 607

⁶¹⁰ *Ibid* at para 13.

silent on the application of the concept of reputation in the context of Canada's moral rights.

(c) Other commentators on “reputation” in the context of moral rights

A number of other authors have focused directly on the concept of “reputation” in the context of the moral rights.

Mark L Rudoff, in “The Dancer and the Dance” takes the position that

[i]t is ... clear that the [Copyright] Act does not protect the public interest as such. It does not leave room for a public interest group, for example, to complain about damage to a work. No one can restrain an artist from making changes to her own work. Further, since the moral rights are coterminous with copyright, there is no protection afforded the integrity of works in the public domain.⁶¹¹

He sees the integrity right in the *Copyright Act* as

resembl[ing] nothing so much as a statutory restive covenant attaching to creative property. It may be enforced not only against the transferee who receives a work from the author, but against all later owners and users during the term of the copyright. The right is tied to the life of the property (i.e., the copyright), not that of the author. The author may bequeath the right or bargain it away. He may enforce his right with the full range of remedies, including injunctive relief and damages. In effect, the purchaser or user of an artwork or copyright takes subject to any claim that its author may have in the work's integrity.⁶¹²

Lesley Ellen Harris has said that "the purpose of moral rights is to protect the personality or reputation of an author (and not necessarily the owner) of a copyright-

⁶¹¹ Mark L Rudoff, “The Dancer and the Dance: An Essay on Composers, Performers, and Integrity Rights,” (1991) 29:4 *Alta L Rev* 884 at 888. Note that this is a different position from arguing that the moral rights are not in the public interest: as is noted elsewhere in this Chapter, it has been argued by others (among them, Wilkinson, “The Public Interest in Moral Rights Protection,” note 18 above) that the moral rights *do* serve the public interest.

⁶¹² *Ibid* at 889 [footnotes omitted].

protected work."⁶¹³ Iona Harding and Emily Sweetland have said that "[m]oral rights are personal rights in a work...[and] when that work is deformed or mutilated -- this constitutes an attack on the person or the personality of the author"⁶¹⁴ but have noted that "[i]n any case, 'reputation and honour' is [sic] difficult to define clearly."⁶¹⁵

In light of the preponderance of opinion concerning the reputation of the author and the relationship between honour and reputation, it would seem that Dennis Lim's opinion and analysis are outliers and that his case has not been made out: the majority of commentators use the terms "honour and reputation" together.

C - "Reputation" in the Context of Moral Rights in Canadian Law

(a) In the *Copyright Act*

Currently, in Canada's *Copyright Act*,⁶¹⁶ moral rights appear across several widely separated sections.⁶¹⁷ The statute "defines" moral rights, in section 2, by reference to other sections of the Act: "'moral rights' means the rights described in subsections 14.1(1) and 17.1(1)."⁶¹⁸ The s 14.1 provisions apply to moral rights of authors of works

⁶¹³ Lesley Ellen Harris, "Moral Rights in Canadian Copyright Law" (2010) 34:5 LawNow 14 at 14-15 [emphasis added].

⁶¹⁴ Harding & Sweetland, *supra* note 568 at 565 [emphasis added].

⁶¹⁵ *Ibid* at 569 [emphasis added].

⁶¹⁶ Canada added moral rights to its *Copyright Act* in 1931 (*An Act to Amend the Copyright Act*, SC (21-22 Geo V) c 8 (assented to 11 June 1931), s 5), essentially enacting the text of the Berne Convention Article 6bis as it stood at that time (see Wilkinson, "The Public Interest in Moral Rights Protection" *supra* note 18 at 221-222). Subsequently, the provisions embodying moral rights underwent significant revision in 1988 (*An Act to Amend Copyright Act and to Amend Other Acts in Consequence Thereof*, SC (35-36-37 Eliz II; assented to 8 June 1988) c 15). Further revision occurred in 2012 (*An Act to Amend Copyright Act and to Amend Other Acts in Consequence Thereof*, SC (35-36-37 Eliz II) (assented to 8 June 1988) c 15).

⁶¹⁷ *Copyright Act*, RSC 1985, c C-42. (See Appendix B: Moral rights in Canadian *Copyright Act* which, for convenience, sets out all the relevant provisions in an order intended to assist the reader).

⁶¹⁸ *Ibid*, s 2.

while the s 17.1 provisions protect the rights of "a performer of a live aural performance or a performance fixed in a sound recording".⁶¹⁹

Subsection 14.1(1) states

[t]he author of the work has ... the right to the integrity of the work and, ... the right ... to be associated with the work as its author by name or under a pseudonym and the right to remain anonymous.⁶²⁰

Subsection 17.1(1) states a performer has

the right to the integrity of the performance ... [and] the right ... to be associated with the performance as its performer by name or under a pseudonym and the right to remain anonymous.⁶²¹

Both sections 14.1(1) and 17.1(1) intermingle two separate categories of moral rights (rights to paternity and rights of integrity). The right to paternity appears, across the two sections, in the words "the [author/performer] has ... the right ... to be associated with the [work/performance] ... as its [author/performer] by name or under a pseudonym". For authors, this right appears in subsection 14.1(1) of the *Copyright Act* and for performers, in subsection 17.1(1). The right of integrity appears across the two sections (14.1(1) and 17.1(1)) as "the right to the integrity of the [work/performance]": for authors in subsection 14.1(1) and, for performers, in subsection 17.1(1).

⁶¹⁹ Canada added moral rights for authors to its *Copyright Act* in 1931 (*An Act to Amend the Copyright Act*, SC (21-22 Geo V) c 8 (assented to 11 June 1931), s 5). Subsequently, the provisions embodying moral rights underwent significant revision in 1988 (*An Act to Amend Copyright Act and to Amend Other Acts in Consequence Thereof*, SC (35-36-37 Eliz II; assented to 8 June 1988) c 15). Further revision occurred in 2012, when moral rights were created for performers and performers' performances (*An Act to Amend Copyright Act and to Amend Other Acts in Consequence Thereof*, SC (35-36-37 Eliz II) (assented to 8 June 1988) c 15.) and in the *Copyright Modernization Act*, SC 2012, c 20, s 10.

⁶²⁰ *Copyright Act*, RSC 1985, c C-42, s 14.1(1).

⁶²¹ *Ibid* s 17.1(1).

There are scholarly disagreements about interpretation of both subsections 14.1(1) and 17.1(1), one of which is over whether the language of “the right to remain anonymous” actually embodies a moral right (as understood in the international context) or not.⁶²²

A second scholarly disagreement about interpretation of both subsections 14.1(1) and 17.1(1), as they have appeared since 1988, concerns the uniquely Canadian part of a provision that appears to modify both s 14.1(1) and s 17.1(1). That provision is the following (in s 28.2(1)):

28.2(1) The author’s or performer’s right to the integrity of a work or performer’s performance is infringed only if the work or the performance is, to the prejudice of its author’s or performer’s honour or reputation,

...

(b) used in association with a product, service, cause or institution
[emphasis added].

Although Canada’s Parliament created a statutory section that frames the novel authors’ and performers’ right to sue for moral rights infringement “if the work or the performance is ... used in association with a product, service, cause or institution” in a subsection that begins with the language of “right to integrity”,⁶²³ scholars have pointed out that such an interest as use “in association with a product, service, cause or institution” has never been interpreted in international circles as a feature of the moral right of integrity and is, in fact, creating a new moral right in Canada, apart from

⁶²² Wilkinson argues that a right to anonymity cannot be part of the right to paternity because, by definition, appearing anonymously as author of a work means that the public cannot identify the author of the work and therefore cannot associate that work with its particular author (anonymity is inconsistent with the concept of paternity, since the right of paternity is meant to ensure that authors are associated with their works). See Wilkinson, "The Public Interest in Moral Rights Protection" *supra* note 18 at 224-231.

⁶²³ Note, also the statutory subheading above s 28.2(1): “Nature of right of integrity”.

Canada's previously legislated two statutory moral rights of paternity and integrity.⁶²⁴

Others have maintained that, since Parliament itself, in s 28.2(1) appears to have framed “[use] in association with a product, service, cause or institution” as part of the “author’s or performer’s right to the integrity of a work or performer’s performance”, “[use] in association with a product, service, cause or institution” must be considered, at least in Canada, to be part of the right to integrity.⁶²⁵

In the context of this thesis, however, focussed, as it is, on the concept of “reputation”, one of the key observations about the sections enshrining the moral rights (14.1 and 17.1) in Canada is, first, that neither mentions "reputation".

A second key observation about the Canadian sections enshrining the moral rights is that the concept of reputation is found in s 28.2(1):

The author’s right to the integrity of a work is infringed only if the work is, to the prejudice of the honour or **reputation** of the author

- (a) distorted mutilated or otherwise modified; or
- (b) used in association with a product, service, cause or institution [emphasis added].

⁶²⁴ This argument points to the fact that the right to *integrity* in the Berne Convention and, consequently, in the WPPT, has never included a concept of use in association with a product, service or institution and therefore, when Canada introduced this provision, distinguishable from the international concept of the right to integrity, in Canadian law, Parliament must have intended to create a new moral right for Canada’s authors and performers (just as many European nations have domestically enshrined moral rights not required of them by the Berne Convention). Canada’s new moral right, it is argued, goes beyond the requirements of Berne, creating a right which one might call a right of association. See Wilkinson, "The Public Interest in Moral Rights Protection" *supra* note 18 at 224 and Wilkinson & Gerolami, "The Author as Agent of Information Policy," *supra* note 20 at 326-327.

⁶²⁵ David Vaver considers the right of the author or *performer* to be associated with the work under s 28.2(1)(b) to be a way to "control the use of the work " and adds that "[t]his right is part of the integrity right. (Vaver, *supra* note 35 at 211 (footnote omitted)). Arguably staking out a middle position between the position taken by Vaver and the position taken by Margaret Ann Wilkinson in "The Public Interest in Moral Rights Protection" *supra* note 18 and by Wilkinson & Gerolami, "The Author as Agent of Information Policy" *supra* note 20, is the position taken by Fraser Turnbull, in "The Morality of Mash-ups: Moral Rights ad Canada's Non-Commercial User-Generated Content Exception"(2014) 26 IPJ 217. At 224, Turnbull seems to treat the “association” language in s 28.2(1)(b) as a separate from the traditional ‘branch’ (or branches?) of integrity but, because of its position in the statute, describes it as not a separate right: "Authors may also control how their works are used in association with products, services, causes and institutions, although this is a discrete branch of the right to integrity, and not a separate right in itself."

Mark L Rudoff proposes, in connection with this observation, that

[t]he parenthetical phrase, ‘to the prejudice of the honour or reputation of the author’ should be read not as a separate proof requirement, but as modifying what follows: ‘distorted, mutilated or otherwise modified.’ The legislation wants the court to ignore trivial alterations. A significant modification, one which changes the work’s character or impact, has the effect of making the work say something that its author did not intend it to say. It is in this sense that modifications that go to the essence of the work prejudice the author’s honour or reputation while superficial alterations do not. In short, ‘to the prejudice of the honour or reputation of the author’ sets a threshold for actionable alterations.⁶²⁶

He goes on to argue that “[t]his interpretation is supported by the second branch of section 28.2(1), a new provision which speaks to use of a work “in association with a product, cause or institution.”⁶²⁷ With or without considering the new provision about use of a work “in association with a product, cause or institution”, however, Rudoff argues proving actual damage would not be necessary since “the prejudice arises out of the way in which the work is dealt with... The single test of whether the character of the work has been changed is that which best fits both branches [of section 28.2(1)].”⁶²⁸ He goes on to explain

That prejudice to reputation stands for a threshold and not actual damage to the author is further supported by the later stipulation of deemed prejudice: “In the case of a painting, sculpture or engraving, the prejudice referred to in subsection (1) shall be deemed to have occurred as a result of any distortion, mutilation or other modification of the work.”[s 28.2(2)] There is no reason to single out visual artists as a class exempt from having to prove actual damage. [V]isual works can be set apart in that they are seen by the world exactly as they were created. Section 28.2(2) takes notice of the fact that even minor changes will detract from a visual work and can never be justified. By contrast, literary and musical works are subject to adaptations and performance. Because both processes require some flexibility, the strict protection accorded visual works would be inappropriate. All that deeming prejudice does in the case of visual

⁶²⁶ Mark L Rudoff, *supra* note 611 at 889.

⁶²⁷ *Ibid* at 889.

⁶²⁸ *Ibid* at 889-890.

works is to relieve the visual artist from having to show that the damage is significant, but the composer or writer must show that the detraction from the work has been significant enough to warrant a remedy. This comparison evinces a concern for the extent of damage to artistic works, not types of harm to artists.⁶²⁹

Rudoff observes that “[c]onsidering prejudice to the author’s reputation as a threshold question is ...consistent with interpretations of the parallel provision in the Berne Convention (Article *6bis*).”⁶³⁰

Moral rights in Canada can, however, be waived.

The waiver concept entered Canadian law in the 1988 revision of the *Copyright Act*⁶³¹ and, as can be seen in the following sections, applies to both authors and performers (and their heirs):

- s 14 (2) Moral rights may not be assigned but may be waived in whole or in part.
 - (3) An assignment of copyright in a work does not by that act alone constitute a waiver of any moral rights.
 - (4) Where a waiver of any moral right is made in favour of an owner or a licensee of copyright, it may be invoked by any person authorized by the owner or licensee to use the work, unless there is an indication to the contrary in the waiver.

- s. 17.1 (3) An assignment of copyright in a performer’s performance does not by itself constitute a waiver of any moral rights.
 - (4) If a waiver of any moral right is made in favour of an owner or a licensee of a copyright, it may be invoked by any person authorized by the owner or licensee to use the performer’s performance, unless there is an indication to the contrary in the waiver.

Margaret Ann Wilkinson and Natasha Gerolami have written that waiver of moral

⁶²⁹ *Ibid* at 900.

⁶³⁰ *Ibid* at 900-901.

⁶³¹ *An Act to Amend Copyright Act and to Amend Other Acts in Consequence Thereof*, SC (35-36-37 Eliz II) (assented to 8 June 1988) c 15, s 12.1(2-4).

rights “can be argued to weaken [moral] rights because authors, given the disparity in bargaining power that exists between authors and publishers, can easily be required to waive their rights as a condition of publication.”⁶³² Regarding the waiver of “moral rights”, David Vaver has also commented that “[o]ne reason moral rights are more talked about than exercised in Canada is because the *Copyright Act* explicitly allows their waiver.”⁶³³

In terms of civil enforcement of the moral rights, infringement of moral rights is defined in *Copyright Act* s 28.1 as follows:

Any act or omission that is contrary to any of the moral rights of the author of a work or of the performer of a performer’s performance is, in the absence of the author’s or performer’s consent, an infringement of those rights.

The *Copyright Act* also contains a criminal sanction, s 43(2), for certain situations that mirrors aspects of moral rights protection:

Any person who makes or causes to be made any change in or suppression of the title, or the name of the author, of any dramatic or operatic work or musical composition in which copyright subsists in Canada, or who makes or causes to be made any change in the work or composition itself without the written consent of the author or of his legal representative, in order that the work or composition may be performed in whole or in part in public for private profit, is guilty of an offence and liable on summary conviction to a fine not exceeding five hundred dollars and, in the case of a second or subsequent offence, either to that fine or to imprisonment for a term not exceeding four months or to both.

⁶³² Margaret Ann Wilkinson & Natasha Gerolami, *The Information Context of Moral Rights under the Copyright Regime: Proceedings of the 32nd Annual Conference of the Canadian Association for Information Science, Access to Information: Technologies, Skills, and Socio-Political Context*, Winnipeg, 2004 (Winnipeg: University of Manitoba, 2004). Scholarship@Western, online: <<https://ir.lib.uwo.ca/lawpub/78/>> at 1 [footnote omitted].

⁶³³ Vaver, *supra* note 35 at 212 [footnote omitted].

This is the only criminal provision concerning moral rights in Canadian law. Since the year that the new moral rights provisions in ss 14.1, 17.1 and 28.2 have been added to the *Copyright Act* in 1988, there appear to have been no criminal prosecutions under s 43(2).⁶³⁴

(b) In Canadian jurisprudence

Having established that the concept of ‘reputation’ forms part of Canada’s moral rights legislation, through its appearance in s 28.2(1), it remains to canvas interpretation of the concept of reputation in Canadian jurisprudence.⁶³⁵

The numbers of judgments that have considered the moral rights in Canada is not large. At least two cases were decided early on, when the moral rights appeared as s 12(7) of the *Copyright Act*.⁶³⁶ One was *Gnass et al v La Cité d’Alma*, in which the Quebec Court of Appeal affirmed a judgment below that had held that s12(7) did not impose an affirmative duty regarding a work of art. The case focused on a number of sculptures that had not been maintained properly (one was thrown into a river) but nonetheless the court held that s 12(7) had not been breached.⁶³⁷

⁶³⁴ Section 43(2), itself dates from the period before 1988 when the enactment of moral rights in the Canadian Copyright Act was found in the former s 12(7):

Independently of the author's copyright, and even after the assignment, either wholly or partially, of the said copyright, the author has the right to claim authorship of the work, as well as the right to restrain any distortion, mutilation or other modification of the work that would be prejudicial to his honour or reputation.

Patrick B. O’Neill in “A History of Dramatic Copyright and Performance Right in Canada to 1924”, found at <https://journals.lib.unb.ca/index.php/tric/article/view/7033/8092>, traces the history, including litigation, of the dramatic copyright and performance rights in Canada. This account includes discussion of prosecutions brought under this early law.

⁶³⁵ Recalling that the cases of *Pollock* and *Boudreau* have both already been discussed above in Part B.

⁶³⁶ Recall again *Copyright Act*, RSC 1970, c C-30, s 12(7), quoted above in footnote 634.

⁶³⁷ Quoted from Rebekah Powell, “Breaching Moral Rights: Is There a Legal Remedy” (2002) 11 Dal J Leg Stud 236 at 250.

The other, more widely known judgment under s 12(7), is *Snow v Eaton Centre Ltd.* (1982).⁶³⁸ Justice O'Brien referred to the plaintiff, in his nine-paragraph judgment, as "an artist of international reputation." He noted the artist "is adamant in his belief that his naturalistic composition has been made to look ridiculous ... While the matter is not undisputed, the [artist's] opinion is shared by a number of other well respected artists and people knowledgeable in his field" and he granted the application to have the ribbons which had been added to the sculpture removed, holding "I am satisfied the ribbons do distort or modify the [artist's] work and the [artist's] concern this will be prejudicial to his honour or reputation is reasonable under the circumstances."

Twenty years later, in referring to the *Snow* case, Justice Binnie, for the majority of the Supreme Court in *Théberge v Galerie d' Art du Petit Champlain*,⁶³⁹ wrote

Could the *economic* rights of the sculptor of the descending geese at the Eaton Centre be said to be infringed (quite apart from his *moral* rights) because the seasonal 'combination' of geese plus Christmas ribbons could be considered a 'reproduction'? The be-ribboned flock incorporated the original artistic work in more than 'substantial part', no doubt, but there was no 'reproduction' in any legal sense, any more than there was 'reproduction' when the appellants in this case [the *Théberge* case] contributed blank canvas to the 'combination' of ink layer and canvas. The sculptor [Snow] rightly invoked his moral rights against the Eaton Centre, not economic rights. [emphasis in original]

In *Prise de Parole Inc. v Guérin, Éditeur Ltée* (1995), which was ultimately decided for the plaintiff on copyright grounds,⁶⁴⁰ Justice Denault noted that [moral rights] "section 28.2(1) does not require the plaintiff to prove prejudice to his honour or

⁶³⁸ *Snow v Eaton Centre Ltd.*, [1982] OJ No.364, 70 CPR (2d) 105 [Snow]. The decision was not appealed.

⁶³⁹ *Théberge v Galerie d' Art du Petit Champlain*, *supra* note 586, at para 61.

⁶⁴⁰ *Prise de Parole Inc. v Guérin, Éditeur Ltée*, [1995] FCJ No. 1583, 104 FTR 104, 66 CPR (3d) 257 [Prise de Parole]. The decision was not appealed.

reputation; rather, it must be proved that the work was distorted, mutilated or otherwise modified 'to prejudice of the honour or reputation of the author'.⁶⁴¹ Justice Denault, in his decision, cited the *Snow* case. He confirmed that in *Snow*, both subjective and objective criteria were satisfied to prove that distortion, mutilation or modification to the author's work was to the prejudice of the author's honour or reputation.⁶⁴² In the case before him, Justice Denault acknowledged that plaintiff Doric Germain had demonstrated that his work had been distorted, mutilated or otherwise modified, but, based on Germain's acknowledgment that "he had not been ridiculed or mocked by his colleagues or the newspapers and that he had not personally heard any complaints after the *Libre expression* collection was published,"⁶⁴³ Justice Denault found that "the evidence has not shown that, objectively, as required by section 28.2(1) of the Act, his work was modified to the prejudice of his honour or reputation. Since this has not been proven, the plaintiff is not entitled to moral damages."⁶⁴⁴

Author James Plotkin comments, about the decision in *Prise de Parole*, that the Federal Court

set a relatively high standard for proving infringement of a work's integrity ...elaborate[ing] a two-prong test: first, the plaintiff author must meet a subjective standard showing that, in [the plaintiff's] opinion, the integrity of the work has been tarnished. Once this is established, the plaintiff must then meet an objective standard by offering testimony from peers in the field to the effect that they too feel that the work's integrity has been diminished by the defendant's activity.⁶⁴⁵

⁶⁴¹ *Ibid* at para 24.

⁶⁴² *Ibid* at paras 25, 26.

⁶⁴³ *Ibid* at para 27.

⁶⁴⁴ *Ibid* at para 28.

⁶⁴⁵ James Plotkin, "The Copyright Implications of Book Editing Apps: Case Study – Story Surgeon" (2014) 30:2 CIPR 232 at 235.

In the more recent case of *Ritchie v Sawmill Creek Golf & Country Club Ltd.*, (2003),⁶⁴⁶ where "[t]he Plaintiff [Ritchie] alleged that when the defendants enlarged five of the photographs to make them into posters they infringed his moral rights quite apart from any copyright violation,"⁶⁴⁷ Justice Ducharme appears to have applied that same standard, involving a two-prong test for both the question involving the moral right of integrity and the question involving the paternity right.

Justice Ducharme found, in considering the question of infringement of Ritchie's moral rights, that "[i]n blowing up some of Mr. Ritchie's photographs from prints rather than from the original negatives, the defendants certainly modified his original photographs."⁶⁴⁸ However, in the opinion of Justice Ducharme, the blow ups were

not so markedly different in quality from the prints as to damage the author's [Ritchie's] honour or reputation. Indeed, no objective evidence of prejudice was adduced to support Mr. Ritchie's own personal reaction. For example, Mr. Windjack, a professional photographer of over 30 years experience, was not asked his view of whether the enlargements were of such poor quality as to offend the integrity of the author.⁶⁴⁹

Justice Ducharme was thus not satisfied with purely subjective evidence from the plaintiff Ritchie on the question of infringement of moral rights. He referred, in para 50,

⁶⁴⁶ *Ritchie v Sawmill Creek Golf & Country Club Ltd.*, (2003), 27 CPR (4th) 220, [2003] OTC 736 [*Ritchie v Sawmill*]. This case was appealed to the Divisional Court on "whether the trial judge had misapprehended the evidence and, specifically, the evidence relating to the gift of the photo album at the initial meeting between the Appellant and Mr. Gerrits" (para 11). Ultimately, Justice McKinnon (for himself and Associate Chief Justice Kent and Regional Senior Judge Kent, dismissed the appeal, subject to vacating the order below "that the Defendants/Respondents own copyright in the "July to October photographs" and that those photographs be delivered up by the Appellant" (see para 30). See [2004] 189 OAC 282.

⁶⁴⁷ *Ibid* at para 48.

⁶⁴⁸ *Ibid* at para 49.

⁶⁴⁹ *Ibid*.

to the difference between the evidence before him and the evidence that had been before the court in *Snow v The Eaton Centre Limited*⁶⁵⁰, commenting that in *Snow*, “O’Brien J. granted the application and ordered the ribbons removed, noting that the plaintiff’s own opinion about the ‘distortion, mutilation or modification’ of his art was shared by a number of well-respected artists and people knowledgeable in his field.” Justice Ducharme said, in the case before him, that Mr. Ritchie had not provided corroborative opinions from the people knowledgeable in the field and Justice Ducharme therefore concluded that “[i]nfringement of the moral right of integrity has not been established.”⁶⁵¹

Justice Ducharme also considered whether Mr. Ritchie’s “moral right of association was infringed after the defendants [the golf and country club] removed his name from the Sawmill Creek website he had been paid to revamp.”⁶⁵² Justice Ducharme found that “[h]aving been visited by the RCMP as part of an investigation, [the golf and country club] acted quickly and, in my view, reasonably to remove Mr. Ritchie’s name from their website and to lock him out of the site to prevent any possible sabotage of it” and therefore the plaintiff, Mr. Ritchie, did not succeed in respect of this cause of action either.

Though Justice Ducharme did not discuss “reputation”, *per se*, in his reasons, in considering the question of damages (after making his findings about liability for moral rights infringement in the case), he did say that if his decision was wrong “in finding that Mr. Ritchie’s moral rights have not been infringed, ... he would “fix the damages he [Mr.

⁶⁵⁰ *Snow v Eaton Centre Ltd*, *supra* note 638.

⁶⁵¹ *Ritchie v Sawmill*, *supra* note 646 at para 50.

⁶⁵² *Ibid* at para 51.

Ritchie] has suffered to his honour and reputation as a non-professional photographer at \$200."⁶⁵³

None of the Canadian cases discussed to this point in this chapter have been considered at beyond the trial level.

There is a case, cited earlier in this chapter, however, in which moral rights have been considered at the Supreme Court of Canada, but the case,⁶⁵⁴ does not turn on issues involving moral rights: it turns, instead, on questions of copyright. Théberge, an artist, chose to sue on copyright grounds because the remedies available for copyright infringement are not available in litigation involving moral rights. As Justice Binnie explained in paragraph 3 of his majority judgment:

On August 19, 1999, [*Théberge*] arranged to have the bailiff seize canvas-backed reproductions from the [Galerie d'Art du Petit Champlain] without ever satisfying a judge that the appellants [the Galerie] had violated the [Copyright Act](#). Although seizure before judgment [available in a copyright case] is designed purely as a conservation measure divorced from the merits of the case, the appellants [the Galerie] claim that the seizure of their inventory caused them a significant loss, both in sales and reputation. [*Théberge*] has not proceeded with his [copyright] action on the merits since the date of the seizure two and a half years ago.⁶⁵⁵

Justice Binnie, in finding against the artist Théberge (the plaintiff at trial), stated clearly

“... in this case, ... [*Théberge*] is asserting a moral right in the guise of an economic

⁶⁵³ *Ibid* at para 53. The trial judge would have made this finding about the damages which he would have awarded for moral rights infringement in this case where he did not find any moral rights infringement so that, if his decision concerning the moral rights was appealed, and an appeal court overturned his decision about the moral rights on the merits, that appeal court would have the ability to substitute an order for damages for infringement of the moral rights without the matter having to be returned to the trial court in order to assess those damages.

⁶⁵⁴ *Théberge v Galerie d'Art du Petit Champlain*, *supra* note 586. The judgment for the majority was written by Justice Binnie, writing for himself and then Chief Justice McLachlin and Justices Iacobucci and Major (paras 1-80). The dissenting judgment was written by Justice Gonthier for himself and Justices L'Heureux-Dubé and LeBel (paras 81-181).

⁶⁵⁵ *Ibid* at para 3.

right, and the attempt should be rejected.”⁶⁵⁶

Despite the case being brought on copyright grounds, rather than moral rights grounds, the decision of the Supreme Court in *Théberge v Galerie d'Art du Petit Champlain* contains reasoning about moral rights that is hugely important in the Canadian context.

Justice Gonthier, writing for the minority, identified the roles of copyright and the author’s moral rights as being completely different:

The [Copyright Act] provides protection for both copyright, defined by s.3(1), and the author's moral rights, in particular in ss. 14.1 and 14.2. While the intended purposes of those rights overlap in some respects, they are nonetheless completely different legal instruments in terms of both their definition and their scope.⁶⁵⁷

Justice Binnie, in his majority judgment also recognized the role of the moral rights as separate from the role of copyright -- for instance at para 19:

The evidence here suggests that, at least in some instances, the respondent’s name was deleted and was no longer on the posters when they were offered for resale. The respondents could have asserted a moral right to be publicly identified with his artistic work in this respect [but chose not to do so].

Justice Binnie continued at paragraph 21,

Apart from the complaint of non-attribution (which is a moral rights issue), it seems the respondent as an artist simply wishes to stop the appellants from catering to the market for canvas-backed reproductions that apparently exists.

And at paragraph 22

Moral rights act as a continuing restraint on what purchasers such as the appellants [art gallery operators] can do with a work once it passes from the author, but respect must be given to the limitations that are an essential

⁶⁵⁶ *Ibid* at para 74.

⁶⁵⁷ *Ibid* at para 117, per Justice Gonthier for the minority.

part of the moral rights created by Parliament. Economic rights should not be read so broadly that they cover the same ground as moral rights, making inoperative the limits Parliament has imposed on moral rights.

At paragraph 60, Justice Binnie held

My view is that Parliament intended modifications without reproduction to be dealt with under the provisions dealing with moral rights rather than economic rights. To adopt a contrary view ... would allow copyright holders other than the artist to complain about modifications (despite the non-assignability of moral rights). It would allow an artist who objected to a “modification” of an authorized reproduction... to sidestep at a trial anywhere in Canada the important requirement of showing prejudice to honour or reputation in order to establish an infringement of moral rights.

As Jeremy de Beer and Robert Tomkowicz have pointed out, “speaking for the majority, Justice Binnie rejected the suggestion of Justice Gontier, writing for the dissenting judges, that the plaintiff could use moral rights to control the use of tangible property after its disposition.”⁶⁵⁸

D – Conclusions on Reputation in Canadian Moral Rights Law

This canvas of moral rights law in Canada demonstrates that, while the concept of reputation is part of the statutory environment of moral rights protection in Canada, the jurisprudence reveals very little concrete evidence of interpretation or application of reputation.⁶⁵⁹

In the case involving moral rights that reached the Supreme Court of Canada, *Théberge v Galerie d’Art du Petit Champlain*,⁶⁶⁰ the plaintiff had deliberately avoided

⁶⁵⁸ Jeremy de Beer and Robert Tomkowicz, “Exhaustion of Intellectual Property Rights in Canada,” (2009) 25:1 RCPI 3 at 13, citing to *Théberge v Galerie d’Art du Petit Champlain*, *supra* note 582 at paras 9-10 (per Justice Binnie, for the majority).

⁶⁵⁹ Recall that the *Pollock v CFCN Productions* matter was at such a preliminary stage that no question involving reputation had yet arisen.

⁶⁶⁰ *Supra* note 586.

pleading infringement of moral rights and therefore, despite lengthy discussions of the law of moral rights (discussions that arose as part of the defence mounted to the copyright action brought), there is no discussion in the reasons delivered by the Supreme Court justices about actual application of moral rights law on the facts before the Court.

The key case relating to the question of reputation in the moral rights context in Canada is the very early *Snow* case, in which the trial judge pointed to specific evidence before him in holding that the artist Snow's reputation was affected and in issuing judgment, on moral rights grounds, against the defendant Eaton Centre.⁶⁶¹ In the subsequent cases of *Boudreau v Lin*,⁶⁶² *Prise des Paroles*,⁶⁶³ and *Ritchie v Sawmill Creek*,⁶⁶⁴ the courts found that there was no evidence of the plaintiff's reputation that could sustain a finding of infringement of moral rights and therefore, there is nothing in the judgments that can sustain an analysis of reputation.

When considering the first specific question posed at the outset of this chapter ("Is reputation involved in moral rights?"), it is easy to point to an affirmative answer because, in the Copyright Act s 28.2(1), the language of "reputation" has been used by Parliament "[t]he author's or performer's right to the integrity of a work or performer's performance is infringed only if the work or the performance is, to the prejudice of its author's or performer's honour or reputation...". However, upon more in-depth reflection, the involvement of reputation in moral rights may be seen most clearly in terms of the function of moral rights presented earlier in this chapter, namely that

⁶⁶¹ *Snow v Eaton Centre Ltd supra* note 638.

⁶⁶² *Supra* note 601.

⁶⁶³ *Supra* note 640.

⁶⁶⁴ *Supra* note 646.

“economic rights are designed to address the supply of available information, while moral rights are designed to address making reliability of that supply ascertainable.”⁶⁶⁵

Ascertaining whether information is reliable involves forming impressions of the reputation of the source of that information. It is important, therefore, to recall the observation made earlier in this chapter that moral rights are not so much a function of the identity of the author but a function of the role of the author in maintaining the author’s identity as associated with the work - an identification which can aid users in valuing the information in the work - and maintaining the integrity of the work which, again, can be key for users in assessing the reliability of the information contained in the work.⁶⁶⁶

⁶⁶⁵ Wilkinson & Gerolami, "The Author as Agent of Information Policy" *supra* note 20 at 331.

⁶⁶⁶ See again Wilkinson, "The Public Interest in Moral Rights Protection" *supra* note 18 at 217.

CHAPTER 5 - REPUTATION AS RELATED TO CANADA'S PROHIBITED MARKS

In Chapter 4 the question asked was whether reputation was involved in Canada's moral rights. This thesis findings confirm a positive answer because the language of "reputation" has been used by Parliament in section 28.2(1) of the *Copyright Act*. Very few cases discussed in Chapter 4 made a clear determination of moral rights infringement. The key case regarding the question of reputation in the moral rights context in Canada remains the *Snow* case in which the trial judge pointed to evidence that the artist Snow's reputation was affected. However, the analysis of moral rights proved that moral rights though residing in Canada's *Copyright Act*, have no economic function (like copyright). The role of moral rights is not so much a function of the identity of the author or performer, but a function of the role author or performer has in association with the work or the performance.

This chapter considers whether the concept of reputation is involved in Canada's prohibited marks and, if so, whether reputation distinguishes prohibited marks from trademarks.

A - Note on Terminology

The term "prohibited marks" entered Canada's legislation in the 1953 *Trade Marks Act*,⁶⁶⁷ as the heading above subsection 9(1), and has remained there ever since. Canada's current legislation⁶⁶⁸ on prohibited marks appears in Section 9 of the

⁶⁶⁷ *Trade-Marks Act*, 1952-53, c 49.

⁶⁶⁸ There is no common law related to the concept of prohibited marks.

*Trademarks Act*⁶⁶⁹ under the heading “Unfair Competition and Prohibited Signs”. For convenience, current Section 9 is set out in full at Appendix C.

The term "official marks", on the other hand, first appeared in Canadian legislation in subsection 14(1)(j) of the 1932 *Unfair Competition Act*.⁶⁷⁰ In the current trademark⁶⁷¹ legislation, this term appears in subsection 9(1)(n)(iii): “any badge, crest, emblem or mark...**(iii)** adopted and used by any public authority, in Canada as an **official mark** for goods or services. [emphasis added]⁶⁷²

There is no definition of "prohibited marks" in the *Trademarks Act*, nor is there a definition of "official mark", though “official mark” appears in section 9.⁶⁷³

Although the *Trademarks Act* legislates a definition of the term "trademark" ("a sign or combination of signs that is used ... by a person to distinguish... their goods or services ... from those of others,"⁶⁷⁴), the *Trademarks Act* does not provide a definition

⁶⁶⁹ *Trademarks Act*, *supra* note 22, last amended on June 18, 2019. (The full name: *An Act Relating to Trademarks and Unfair Competition*). In the 1932 *Unfair Competition Act* neither the term ‘prohibited mark’ nor the term ‘official mark’ appears, though a marginal note near section 14 reads as follows: “Use as trade marks of certain emblems, etc., forbidden.” (*Unfair Competition Act*, RSC 1932, c 38 (Marginal note near section 14(1)).)

⁶⁷⁰ *Unfair Competition Act*, 1932, 22-23 George V, c 38, s 14(1)(j) (“any symbol adopted and used by any public authority in Canada as an **official mark** on similar wares”) [emphasis added]. This statute, while it was in force, was the Canadian legislation that dealt with trademarks.

⁶⁷¹ Note that, throughout this chapter, various spellings of trademark will appear (trademarks, trade marks, trade-marks). This is because the spelling of trademarks in Canada from time to time – only becoming “trademarks” in our statute very recently. Typically, in this chapter, the spelling will reflect the spelling used in the applicable source for which a quotation, for example, has been taken.

⁶⁷² *Trademarks Act*, *supra* note 22, s 9(1)(n)(iii) [emphasis added].

⁶⁷³ The term ‘official mark’ appears in s 9(1)(n)(iii). The term ‘official sign’ appears in s 9(1)(i.1). (See Appendix C: Prohibited marks - Section 9 of the *Trademarks Act*, *supra* note 22.

⁶⁷⁴ *Trademarks Act*, *supra* note 22, s 2 Definitions: trademark means (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.

for the term “prohibited marks”. The term “prohibited marks” actually appears only as a subheading above the current subsection 9(1) of the *Trademarks Act*.⁶⁷⁵

While the Canadian *Interpretation Act*⁶⁷⁶ explains the legal status and intended use of marginal notes and historical references printed in a statute,⁶⁷⁷ it does not say anything about the role of headings in a statute. However, in 2016, Canada's House of Commons Standing Joint Committee for the Scrutiny of Regulations, reported to Parliament that statutory headings are to be "considered part of the enactment":

Section 14 of the *Interpretation Act* provides that marginal notes form no part of the enactment, but are inserted for convenience of reference only. This means that they should not be relied upon to interpret the meaning of the enactment. **This is not the case with respect to headings, which are considered part of the enactment.** This being the case, the transformation of marginal notes into headings effectively amends legislation by adding new elements to it. At the very least, the different weight given to marginal notes and headings as tools of interpretation leads to the conclusion that the meaning of the legislation has been altered. [emphasis added]⁶⁷⁸

Scholars use different expressions to identify prohibited marks. Teresa Scassa, for instance, refers to official marks as a “type” of prohibited marks,⁶⁷⁹ while David Vaver, on the other hand, uses the expression “official marks” for all prohibited marks.⁶⁸⁰ In *Canadian Intellectual Property Law: Cases and Materials* (2nd ed) prohibited marks are

⁶⁷⁵ *Trademarks Act*, *supra* note 22.

⁶⁷⁶ *Interpretation Act*, RSC 1985, c I-21.

⁶⁷⁷ *Ibid*, s 14 ("Marginal notes and references to former enactments that appear after the end of a section or other division in an enactment form no part of the enactment, but are inserted for convenience of reference only.")

⁶⁷⁸ House of Commons, Standing Joint Committee for the Scrutiny of Regulations, Report No 91 (22 March 2016 and 24 March 2016) at 2 (Joint Chairs Pana Merchant and Harold Albrecht) [emphasis added].

⁶⁷⁹ Scassa, *supra* note 21, (Ch 4 "Prohibited Marks") at 220.

⁶⁸⁰ David Vaver refers to prohibited marks solely as official marks. See Vaver, *supra* note 35 at 501.

discussed in the section on "Special Marks."⁶⁸¹ The authors said that "[t]he language pertaining to prohibited marks is somewhat different from that used in other parts of the Act."⁶⁸²

The terms "official marks" and "prohibited marks" appear to be roughly equally used in scholarly literature and amongst legal practitioners.⁶⁸³

B - Canada's 'Prohibited Marks'

(a) Background

The provisions of Section 9 of Canada's current *Trademarks Act* that deal purely with Canada's own domestic affairs⁶⁸⁴ are the following:

- (a) the Royal Arms, Crest or Standard;
- (c) the standard, arms or crest of His Excellency the Governor General;
- (d) any word or symbol likely to lead to the belief that the goods or services in association with which it is used have received, or are produced, sold or performed under, royal, vice-regal or governmental patronage, approval or authority;
- (e) the arms, crest or **flag** adopted and used at any time by Canada or by any province or municipal corporation in Canada in respect of which the Registrar has, at the request of the Government of Canada or of the province or municipal corporation concerned, given public notice of its adoption and use;
- (j) any scandalous, obscene or immoral word or device;
- (k) any matter that may falsely suggest a connection with any living individual;

⁶⁸¹ Greg Hagen et al, *Canadian Intellectual Property Law Cases and Materials*, 2nd ed (Toronto: Emond, 2018) (Chapter Four: "Registered Trademarks," section C. "Special Marks").

⁶⁸² *Ibid* at 456-57.

⁶⁸³ For example, Renata Watkin, "Placing Canadian Geographical Indications on the Map"(2018) 30:2 IPJ 271 "Official Marks" at 294-296; Lisa James, "Make it Official: Trade-Marks, Official Marks, and the Benefits of Registration" (2010) 120:9 *Municipal World* 25.

⁶⁸⁴ Recall that, under Canada's Constitution, the Queen is Canada's head of state.

- (l) the portrait or signature of any individual who is living or has died within the preceding thirty years;
- (n) any badge, crest, emblem or mark
 - (i) adopted or used by any of Her Majesty's Forces as defined in the National Defence Act,
 - (ii) of any university, or
 - (iii) adopted and used by any public authority, in Canada as an official mark for goods or services, in respect of which the Registrar has, at the request of Her Majesty or of the university or public authority, as the case may be, given public notice of its adoption and use;
- (n.1) any armorial bearings granted, recorded or approved for use by a recipient pursuant to the prerogative powers of Her Majesty as exercised by the Governor General in respect of the granting of armorial bearings, if the Registrar has, at the request of the Governor General, given public notice of the grant, recording or approval;
- (o) the name "Royal Canadian Mounted Police" or "R.C.M.P." or any other combination of letters relating to the Royal Canadian Mounted Police, or any pictorial representation of a uniformed member thereof.

[emphasis added]

Canada's right to legislate these provisions, as a sovereign nation, is absolute, in the sense that none of these provisions arises from obligations imposed upon Canada by any foreign state.

The symbology dealt with under Section 9 that originates in connection with Canada's commitments to international organizations can be seen in the following subsections of Canada's current *Trademarks Act*:

- (g) the emblem of the Red Crescent on a white ground adopted for the same purpose as specified in paragraph (f) [paragraph (f) addresses the Red Cross];
- (g.1) the third Protocol emblem — commonly known as the "Red Crystal" — referred to in Article 2, paragraph 2 of Schedule VII to the Geneva Conventions Act and composed of a red frame in the shape of a square on edge on a white ground, adopted for the same purpose as specified in paragraph (f) [paragraph (f) addresses the Red Cross];

- (h) the equivalent sign of the Red Lion and Sun used by Iran for the same purpose as specified in paragraph (f) [[paragraph (f) addresses the Red Cross];
- (h.1) the international distinctive sign of civil defence (equilateral blue triangle on an orange ground) referred to in Article 66, paragraph 4 of Schedule V to the Geneva Conventions Act;
- (i) any territorial or civic flag or any national, territorial or civic arms, crest or emblem, of a country of the Union, if the flag, arms, crest or emblem is on a list communicated under **article 6ter of the Convention** [emphasis added] or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;
- (i.1) any official sign or hallmark indicating control or warranty adopted by a country of the Union, if the sign or hallmark is on a list communicated under **article 6ter of the Convention** [emphasis added] or pursuant to the obligations under Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives **public notice** [emphasis added] of the communication;
- (i.2) any national flag of a country of the Union;
- (i.3) any armorial bearing, flag or other emblem, or the name or any abbreviation of the name, of an international intergovernmental organization, if the armorial bearing, flag, emblem, name or abbreviation is on a list communicated under **article 6ter of the Convention** [emphasis added] or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;
- (m) the words “United Nations” or the official seal or emblem of the United Nations.
[emphasis added]

There is one legislated symbol that would appear to be able to be interpreted as being both domestic in origin and having an international connection:

- (f) the emblem of the Red Cross on a white ground formed by reversing the federal colours of Switzerland and retained by the Geneva Convention for the Protection of War Victims in 1949 as the emblem and distinctive sign of the Medical Service of armed forces and used

by the Canadian Red Cross Society, or the expression “Red Cross” or “Geneva Cross”.

[emphasis added]

From the international point of view in connection with the Red Cross symbology, it has been noted that “[t]hose drafting the Geneva Convention of 1864 foresaw the need for a universal symbol of protection easily recognizable on the battlefield. In honor of the origin of this initiative, the symbol of a red cross on a white background (the reverse of the Swiss flag) was identified as a protective emblem in conflict areas.”⁶⁸⁵ On the other hand, from the domestic Canadian point of view, the Canadian Red Cross was founded in 1896,⁶⁸⁶ well before the concept of specifically identifying the prohibited mark symbol of the “Red Cross” in Canada’s trademark legislation appeared in 1932.⁶⁸⁷ Nonetheless, as may be seen in the text of s 9(1)(f) itself (above), the provision currently enacted notes “the emblem ... retained by the Geneva Convention for the Protection of War Victims in 1949”.

Section 9 of the *Trademarks Act* continues, in subsection (2), with several provisions that apply to a number of the subsections set out above. Its text reads as follows:

Excepted uses

(2) Nothing in this section prevents the adoption, use or registration as a trade-mark or otherwise, in connection with a business, of any mark

⁶⁸⁵ American Red Cross, “Summary of the Geneva Conventions of 1949 and Their Additional Protocols,” *International Humanitarian Law*, April 2011 at 7, online: <https://www.redcross.org/content/dam/redcross/atg/PDF_s/International_Services/International_Humanitarian_Law/IHL_SummaryGenevaConv.pdf>

⁶⁸⁶ Canadian Red Cross, online: <<https://www.redcross.ca/about-us/about-the-canadian-red-cross>>.

⁶⁸⁷ As provided in 1932 in the 1932 *Unfair Competition Act*, s 14(1)(g) “the emblem of the Red Cross Society, consisting of a red cross on a white ground or the expression “Red Cross” or “Geneva Cross”.

- (a) described in subsection (1) with the consent of Her Majesty or such other person, society, authority or organization as may be considered to have been intended to be protected by this section; or
- (b) consisting of, or so nearly resembling as to be likely to be mistaken for
 - (i) an official sign or hallmark mentioned in paragraph (1)(i.1), except in respect of goods that are the same or similar to the goods in respect of which the official sign or hallmark has been adopted, or
 - (ii) an armorial bearing, flag, emblem or abbreviation mentioned in paragraph (1)(i.3), unless the use of the mark is likely to mislead the public as to a connection between the user and the organization.

There is a second type of mark now protected by Canada's *Trademarks Act*

Section 9: symbols indicative of international bodies. These symbols are protected in the following subsections of Section 9:

- (g) the emblem of the Red Crescent on a white ground adopted for the same purpose as specified in paragraph (f) [paragraph (f) addressing the Red Cross];⁶⁸⁸
- (g.1) the third Protocol emblem — commonly known as the “Red Crystal” — referred to in Article 2, paragraph 2 of Schedule VII to the *Geneva Conventions Act* and composed of a red frame in the shape of a square on edge on a white ground, adopted for the same purpose as specified in paragraph (f) [paragraph (f) addressing the Red Cross];⁶⁸⁹

⁶⁸⁸ The red crescent was recognized by “a diplomatic conference in 1929”. American Red Cross, “Summary of the Geneva Conventions of 1949 and Their Additional Protocols,” International Humanitarian Law, April 2011 at 7, online: https://www.redcross.org/content/dam/redcross/atg/PDF_s/International_Services/International_Humanitarian_Law/IHL_SummaryGenevaConv.pdf

⁶⁸⁹ According to the American Red Cross “Summary of the Geneva Conventions of 1949 and Their Additional Protocols” at 7: In December 2005, governments adopted the Third Protocol adding the Red Crystal. See online: https://www.redcross.org/content/dam/redcross/atg/PDF_s/International_Services/International_Humanitarian_Law/IHL_SummaryGenevaConv.pdf

- (h) the equivalent sign of the Red Lion and Sun used by Iran for the same purpose as specified in paragraph (f) [[paragraph (f) addressing the Red Cross];⁶⁹⁰
- (h.1) the international distinctive sign of civil defence (equilateral blue triangle on an orange ground) referred to in Article 66, paragraph 4 of Schedule V to the Geneva Conventions Act;
- (i) any territorial or civic flag or any national, territorial or civic arms, crest or emblem, of a country of the Union, if the flag, arms, crest or emblem is on a list communicated under **article 6ter of the Convention** or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;
- (i.1) any official sign or hallmark indicating control or warranty adopted by a country of the Union, if the sign or hallmark is on a list communicated under **article 6ter of the Convention** or pursuant to the obligations under Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives **public notice** of the communication;
- (i.2) any national flag of a country of the Union;
- (i.3) any armorial bearing, flag or other emblem, or the name or any abbreviation of the name, of an international intergovernmental organization, if the armorial bearing, flag, emblem, name or abbreviation is on a list communicated under **article 6ter of the Convention** or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;
- (m) the words “United Nations” or the official seal or emblem of the United Nations.

[emphasis added]

⁶⁹⁰ According to the American Red Cross “Summary of the Geneva Conventions of 1949 and Their Additional Protocols,” the red lion and sun, although adopted at the 1929 diplomatic conference, is no longer in use. See American Red Cross, “Summary of the Geneva Conventions of 1949 and Their Additional Protocols,” *International Humanitarian Law*, April 2011 at 7, online: https://www.redcross.org/content/dam/redcross/atg/PDF_s/International_Services/International_Humanitarian_Law/IHL_SummaryGenevaConv.pdf

The language of section 9(1) begins “No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for [the symbols listed]”. This introductory language is virtually identical in all previous versions of this statute.⁶⁹¹

Section 9 is drafted as a stoplist.⁶⁹² it sets out symbols that cannot be used as trademarks. As the Committee set up in 1947 to review the 1932 *Unfair Competition Act* wrote in the *Report of Trade Mark Law Revision Committee to the Secretary of State of Canada*:

Under Section 14 of *The Unfair Competition Act, 1932*, certain symbols are wholly excluded from registration and even use. In the main, these are specific words and designs which are withdrawn from general employment because of legislative policy, as in the case of the Royal Arms and the national flag, because of treaty obligations, as in the case of territorial flags and the emblem of the Red Cross, or because of private rights, as in the case of signatures and portraits. Partly as a result of an extension of our treaty obligations and partly as a result of requests for protection, the list of such words and designs has been lengthened in Section 9 of the Bill, but this does not involve a change in principle.⁶⁹³

⁶⁹¹ Extending back to the original official marks enactment in 1932 of the *Act Respecting Unfair Competition in Trade and Commerce* in 1932, 22-23 George V, c 38. See the almost identical language in s1 of the 1932 statute, set out below (see Appendix F and Appendix G).

⁶⁹² The term “stoplist” comes from computer science vocabulary, where it originally described a list of words automatically omitted from a computer-generated concordance or index, typically the most frequent words, which would slow down computer processing unacceptably. In a communication emanating from WIPO itself, “WIPOMAGAZINE”, it is noted that the drafting of the international provision concerning matters related to Canada’s Section 9, Article 6*ter* of the Paris Convention (discussed further below) is explained as follows:

The intention of Article 6*bis* is not to create a special form of intellectual property right for States and intergovernmental organizations, but to prevent the signs, names and abbreviations associated with them from being used or appropriate as trademarks without proper authorization.

See WIPOMAGAZINE, online: <wipo.int/wipo_magazine/en/2009/03/article_0009.html>.

⁶⁹³ *Report of Trade Mark Law Revision Committee to the Secretary of State of Canada* (January 20, 1953). The Report is reprinted in Harold G Fox, *The Canadian Law of Trade Marks and Unfair Competition*, 2nd ed, vol 2 (Toronto: Carswell, 1956) (at 1142-1201) at 1155.

It is clear, therefore, from the language of section 9, that these symbols cannot share the characteristics of trademarks: for one thing, they are not involved in the “trademark bargain” whereby trademark owners and their assigns enjoy the legal protection of trademark (keeping others from using the mark in association with given products or services) for however long the public understands that mark as representing the goods or services of the trademark holder.⁶⁹⁴ The protection of the symbols protected under Section 9 is perpetual.

The bulk of the reported modern litigation⁶⁹⁵ involving Section 9 of the *Trademarks Act* has occurred in situations involving s 9(1)(n)(iii):

9(1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for,...

(n) any badge, crest, emblem or mark ...

(iii) adopted and used by any public authority, in Canada as an official mark for goods or services, in respect of which the Registrar has, at the request of Her Majesty or of the university or

⁶⁹⁴ Wilkinson, "What is the Role of New Technologies in Tensions in Intellectual Property?" *supra* note 62. Wilkinson writes (at 14) that

once individual and corporate interests were separated during the nineteenth century – and diverged even more during the twentieth – the concept of “balance” in intellectual property needed to be reconceptualized in terms of “balancing” three sets of interests: those of individuals (as it is undeniably individuals cognitive activity which produces creativity and innovation), those of corporations (which have come to dominate in terms of both ownership ... and influence upon economies), and that of the public.

She points out, earlier in the chapter (at 9), that

[u]p until the mid-nineteenth century, when modern separation 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.

Citing to France’s *Manufacture and Goods Mark Act of 1857*, she notes “legal recognition of trademarks occurred in the mid-nineteenth century, roughly concurrent with the emergence of the legal device of the corporation” and “[c]oincidentally, the original ... Paris [Convention] 1883... appear[ed] either before or just simultaneous with the beginnings of recognition of corporations as separate persons in law (1886 in American courts, 1897 in British...)” (at 12-13). (All footnotes have been omitted).

⁶⁹⁵ Including the litigation in *United States Postal Service v Canada Post Corporation*, 2007 FCA 10 (leave denied by SCC, 27 June 2007) which is noted again in the text at footnote 696 and fully discussed in the section below entitled “D. Justice McTavish’s Taxonomy of Prohibited Marks” (text at footnotes 783-788).

public authority, as the case may be, given public notice of its adoption and use.⁶⁹⁶

The process in s 9(1)(n)(iii) of allowing a “public authority” entity to give “public notice of the adoption [of an adopted symbol]”, rather than having to apply for trademark protection as businesses are required to do, has attracted frequent challenges being brought against those relying upon this section of the *Trademarks Act* from others who believed the marks in question should be protected through the tort of passing off or through registration under the *Trademarks Act* as a trademark.⁶⁹⁷ In other cases, the holders of prohibited marks have challenged others.⁶⁹⁸

Subsection 9(1)(n)(ii) refers to “any badge, crest, emblem or mark” “(ii) of any university”. The case of *University of Texas System v Texas Longhorn Café Inc* (1992) 42 CPR(3d) 211 (Trademark Opposition Board) is a reminder that this subsection is not restricted to Canadian universities. The University of Texas availed itself of the provision, although, in the result, on the merits, the Board found the café could rely upon a mark that combined two of the University of Texas’ prohibited marks and have its mark blending “Texas” and “Longhorns” registered in Canada.⁶⁹⁹

⁶⁹⁶ *Trademarks Act*, *supra* note 22, s 9(1)(n)(iii).

⁶⁹⁷ *Wagon-Wheel Concessions Ltd v Stadium Corp. of Ontario* (1988), 22 CIPR 1 (Fed TD), affirmed (1989) 24 CIPR (FCA).

⁶⁹⁸ See, for instance, *Ontario Federation of Anglers & Hunters v FW Woolworth Co.* (1991), 39 CPR(3d) 272 (TMOB); *British Columbia v Mihaljevic* (1986), 10 CPR(3d) 274 (BCSC).

⁶⁹⁹ Compare this with the situation in *United States Postal Service v Canada Post Corporation*, 2007 FCA 10; *United States Postal Service v Canada Post Corporation*, 2007 FCA 10 (leave denied by SCC, 27 June 2007), noted above in the text at note 692, which was also decided under s 9(1)(n) but involved a ‘public authority’ under s 9(1)(n) (iii) rather than a university under s9(1)(n)(ii). The case is fully discussed in the section below entitled “D. Justice McTavish’s Taxonomy of Prohibited Marks” (text at footnotes 784-789).

Although First Nations of Canada are not specifically mentioned in Section 9, prohibited marks have been used by First Nations peoples as legal tools for protecting their rights. For example, the Skatin Nations, the Kaska Tribal Council, the Council of the Como Band of Indians, the Osoyoos Indian Band and the First Nations Summit have protected the names SKATIN (090873), KASKA (091404), QUENEESH (0916618), NK'MIP (0911487) and FIRST NATIONS SUMMIT (0907696), respectively, under subsection 9(1)(n)(iii).⁷⁰⁰

In Canadian trademark law (both under the *Trademarks Act*⁷⁰¹ and in the common law action for passing off), reputation is a matter often litigated.⁷⁰² Reputation has not been litigated in the context of prohibited marks in Canada – and this is not surprising because, as this chapter will demonstrate, the question of reputation in terms of prohibited marks is one that has been considered and answered by Parliament (by legislating the list of symbols in Section 9). The symbols protected under Section 9 and its predecessor enactments in Canada have been chosen by Parliament for this perpetual protection⁷⁰³ and they have been so chosen in order to protect the reputations associated with them.

⁷⁰⁰ The number in brackets next to each name is the application number in the Canadian Trademarks Database.

⁷⁰¹ *Trademarks Act*, *supra* note 22.

⁷⁰² 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. See Terrance S Carter & U Shen Goh, *Branding and Trademarks: 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.

⁷⁰³ As will be discussed further below, some of the subsections of Section 9 have been affected by Canada’s commitments to its international obligations in public international law and international trade. Even given this international influence on Canadian law, it is still the case that Canada is a sovereign nation and is not

(b) History

(i) Beginnings in 1932

The 1932 revision to Canada's trademark legislation, the *Unfair Competition Act*,⁷⁰⁴ was hailed as an important landmark in Canadian law.⁷⁰⁵

The original list of symbols enacted in Canada was in the 1932 *Act Respecting Unfair Competition in Trade and Commerce*.⁷⁰⁶ The 1932 legislation gave protection to only eleven types of symbols (as opposed to the current list of twenty-three types of protected symbols⁷⁰⁷):

- 14. (1)** No person shall be entitled to adopt for use in connection with his business, as a trade mark or otherwise, any symbol consisting of, or so nearly resembling as to be likely to be mistaken for,
- (a)** the Royal Arms, Crest or Standard;
 - (b)** the arms or crest of any member of the Royal Family;
 - (c)** the national flag in any of its forms;
 - (d)** the standard, arms or crest of His Excellency the Governor-General;
 - (e)** the arms or crest adopted or used at any time by Canada or by any province or municipal corporation in Canada;
 - (f)** any national flag, arms, crest or emblem commonly used as such by any foreign state;
 - (g)** the emblem of the Red Cross Society, consisting of a red cross on a white ground or the expression "Red Cross" or "Geneva Cross;"

legally obliged, under its system of laws, to accept into its domestic law the provisions to which it has agreed by signing either international public law treaties or trade agreements.

⁷⁰⁴ *Unfair Competition Act*, 22-23 Geo V, c 38 (1932).

⁷⁰⁵ EG Gowling, "The Unfair Competition Act" (1932)10:8 Can Bar Rev 507 at 508. Gowling took a historical approach to the history of trademark in Canada, noting that that the "first Canadian statute granting protection to trade marks was passed in 1861, after which followed the first Trade Mark and Design Act of 1868." (Gowling did not include the topic of the prohibited marks provisions in this statute in his discussion.) EG Gowling, "The Unfair Competition Act" (1932)10:8 Can Bar Rev 507 at 507.

⁷⁰⁶ *Unfair Competition Act*, *supra* note 704.

⁷⁰⁷ See Appendix D: Comparison of "Prohibited Marks" in the Current *Trademarks Act* and "Forbidden Marks" in the 1932 *Unfair Competition Act*.

- (h) any national, territorial or civic flag, arms, crest, or emblem of the prohibition of which as a commercial device notice has been received and publicly given by the Registrar pursuant to the provisions of the Convention more than two months before the adoption of the symbol;
- (i) the emblem of any fraternal society, the legal existence of which is recognized under any law in force in Canada;
- (j) any symbol adopted and used by any public authority in Canada as an official mark on similar wares;
- (k) the portrait or signature of any person who is living or has died within thirty years.

(2) Nothing in this section shall prevent the use as a trade mark, or otherwise in connection with a business, of any such symbol as aforesaid with the consent and approval of His Majesty or such other person as may be deemed to have been intended to be protected by the provisions hereof.

At least two⁷⁰⁸ of the provisions of this legislation involve symbols originating outside Canada:

- (f) any national flag, arms, crest or emblem commonly used as such by any foreign state;

and

- (h) any national, territorial or civic flag, arms, crest, or emblem of the prohibition of which as a commercial device notice has been received.

Side by side comparison of the 1932 provision for protection of protected symbols with the current *Trademarks Act* Section 9 (found in its entirety at Appendix D) indicates that, with the exception of subsection (i) (“the emblem of any fraternal society, the legal existence of which is recognized under any law of Canada”), all the statutory provisions of 1932 have been carried forward, in identical or expanded terms, to the present.⁷⁰⁹

⁷⁰⁸ As will be discussed below, provision (g) (“the emblem of the Red Cross Society, consisting of a red cross on a white ground or the expression “Red Cross” or “Geneva Cross”) could have been a domestic initiative just as well as an initiative emanating from outside Canada.

⁷⁰⁹ The provision involving “the emblem of any fraternal society” was dropped from the statute in Canada’s *Trade Marks Act* of 1952 (see **Appendix G**). A “fraternal organization” is defined in Wikipedia as “an organization, society, club or fraternal order traditionally of men associated together for various religious or secular aims”. In the United States, apparently, such organizations are protected under the federal trademark legislation, as Cornell University notes on its website:

By 1932, when Canada's *Act Respecting Unfair Competition in Trade and Commerce*⁷¹⁰ was passed, the 1925 *Hague Revision* to the international 1883 *Paris Convention*,⁷¹¹ was in effect. Article 6ter of the *Paris Convention* appeared as 'armorial bearings, flags, state emblems ..., official signs and hallmarks indicating control and warranty ... and all imitations thereof from a heraldic point of view' (see Appendix E).⁷¹²

Author Nedim Malovic has written about s 4(1)(d) of the UK *Trade Marks Act* 1994, which is similar to Canada's current s 9(2)(a),⁷¹³ saying the UK provision

involves an assessment of the impact that a trade mark would have on the average consumer of the goods and/or services in relation to which the

The Lanham Act [15 USC § 1127] describes a 'collective' as a cooperative, association, or other collective group or organization; fraternal organizations and unions are both considered to be collectives. The mark adopted by a particular collective is only available for use by its members.

See Cornell Law School, Legal Information Institute, https://www.law.cornell.edu/wex/collective_mark. Canada's legislation currently does not include collective marks (see R Nelson Godfrey, "Five Significant Developments Following the June 2019 Changes to Canadian Trademark Law," Gowling WLG, online: <<https://gowlingwlg.com/en/insights-resources/articles/2020/five-changes-to-the-latest-canadian-trademark-law/>>). However, the text of CUSMA (discussed further below in Chapter 8.B (a)) provides

Article 20.18: Collective and Certification Marks

Each Party shall provide that trademarks include **collective marks** and certification marks. A Party is not required 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. [emphasis added; footnote omitted]

⁷¹⁰ *Unfair Competition Act*, 1932, *supra* note 704.

⁷¹¹ Further discussed below, in this chapter.

⁷¹² Article 6ter(1). See **Appendix E**: Article 6ter of the Paris Convention in 1925, 1934, 1958 and 1967.

⁷¹³ UK *Trade Marks Act* (UK), 1994, c 26 pt 1, s 4(1)(d) reads:

4 Specially protected emblems.

(1)A trade mark which consists of or contains—

(d) words, letters or devices likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation, shall not be registered unless it appears to the registrar that consent has been given by or on behalf of Her Majesty or, as the case may be, the relevant member of the Royal family.

Canada's *Trademarks Act*, *supra* note 22, s 9(2) reads:

Nothing in this section prevents the adoption, use or registration as a trademark or otherwise, in connection with any business, of any mark

(a) described in subsection (1) with the consent of Her Majesty or such other person, society, authority or organization as may be considered to have been intended to be protected by this section.

mark would be used, including leading them [the average consumer] to believe that the applicant either has or recently has had Royal patronage or authorization.⁷¹⁴

In discussing the UK provision in the context of Article 6*ter* of the Paris Convention, Malovic notes that “certain royal insignia as trade marks is protected internationally under Article 6*ter* of the Paris Convention.”⁷¹⁵ He continues,

[a] country’s name, flag, emblem of coat of arms can therefore be said to signal to the public that there is a relationship between the nation and the products or services in respect of which it is being used.(1) Not only could this become problematic for a nation, which may or may not have control over the products being distributed using its identity and goodwill, but it might also damage the reputation and brand value that a nation has built up over time.⁷¹⁶

Malovic goes on refer to the UK Intellectual Property Office’s Examination Guide⁷¹⁷, noting

it is specified that not all goods and/or services will prompt a consumer to believe that there is a connection between the mark sought for and the presence of a Royal patronage or authorization. Examples of goods or services for which ‘royal’ may indicate Royal patronage include high quality porcelain or glassware, luxury foods, organic food, confectionery, alcoholic beverages, clothing, and organizations of sporting events. The list is not exhaustive. However, everyday items, insurance or financial services, double glazing services, provision of electricity, or goods which are far enough removed from any association with the Royal family such

⁷¹⁴ Nedim Malovic, “Royal Branding and Trade Marks” (2020) 15:6 J Intell Prop L & Prac 409 at 409.

⁷¹⁵ *Ibid.*

⁷¹⁶ *Ibid.*, citing at footnote 1 to Natalie G.S. Corthésy, “Trade marks, country names ...”, *supra* note 160 at 300.

⁷¹⁷ *Ibid.*, citing at footnote 6 to the “UK IPO, Manual of Trade Marks Practice (2009), p206.”. Malovic concludes by saying, “

Going back to where we began: could the couple [Meghan Markle and Prince Harry] ... still style themselves as ‘royal’ and thus exploit the Sussex Royal brand in doing so, without performing any royal duties? Ultimately, it appears that the safest solution might be first to consult with ... Her Majesty.” (at 410).

as skateboards, computers, computer games or T-shirts would likely escape the application of the provision.⁷¹⁸

Canada's 1932 statute did not just enact "forbidden marks" (as this statute termed 'prohibited marks'), it allowed the use of royal symbols (section 14(2)) "with the consent and approval of His Majesty or such other person as may be deemed to have been intended to be protected by the provisions hereof."⁷¹⁹ The provisions in the statute were structured in two subsections, the first section listing the prohibited marks, followed by a second section listing the exceptions to prohibitions: a structure for Section 9 that has persisted to this day.

In 1934, in *B Houde Co. v Canada (Commissioner of Patents)*,⁷²⁰ Justice Angers delivered a judgment in which he noted that the *Unfair Competition Act* "enumerates the emblems or symbols which may not be adopted as a trade-mark; neither [the provisions enumerating emblems nor the provisions enumerating symbols] forbid the use of the word "Royal."⁷²¹ He wondered "how the words "Royal Flush" used in connection with tobacco, cigars, cigarettes and cigarette papers may possibly be misdescriptive of the character or quality of the wares or of the conditions of their production or of their place

⁷¹⁸ Nedim Malovic, "Royal Branding and Trade Marks" (2020) 15:6 J Intell Prop L & Prac 409 at 409 [footnotes omitted].

⁷¹⁹ *Unfair Competition Act*, (Can.) 1932, c 38 art 14(2) (The *Unfair Competition Act* was passed during the reign of King George V, who served on the throne of the United Kingdom from 1910-1936. Canada, a self-governing Dominion since 1 July 1867, received equal status with the United Kingdom in 1931 within the British Commonwealth of Nations, but only became a fully sovereign country in 1982 with the passing of the *Canada Act 1982*).

⁷²⁰ *B Houde Co. v Canada (Commissioner of Patents)* 1934 CarswellNat 14, [1934] Ex. CR 149.

⁷²¹ *Ibid* at para 6.

of origin"⁷²² In the result, he allowed the petition of the appellant [B. Houde Company] and directed the Commissioner of Patents to register the trade-mark "Royal Flush."⁷²³

In a 1938 decision that involved the 1932 provision for protection of prohibited marks, Justice Angers, in *Simms & Co. v Canada (Commissioner of Patents)*,⁷²⁴ on appeal from the decision of the Registrar of Trade Marks refusing to register a design trade mark that included a representation of the Imperial Crown, held that the Registrar of Trade Marks was right in refusing the appellant's application.⁷²⁵ He based his decision on the fact that "[t]he representation of the Design Mark includes the representation of the Imperial Crown which is not permissible (s 14 of the *Unfair Competition Act.*)"⁷²⁶

On the other hand, one year later, in *Nehi Inc v Canada (Registrar of Trade Marks)*,⁷²⁷ a court allowed registration of the wordmark "Royal Crown" as a trademark, based on doubt that "the public ever associate either of those words, when so used, with the Royal Arms, Crest or Standard."⁷²⁸ A similar result occurred in *Molson Cos v Richmond Breweries Ltd*⁷²⁹ when the evidence did not support a finding that the "ROYAL CANADIAN & DESIGN" mark would lead Canadians to believe that the wares sold were sold under Royal Patronage. The same occurred, in terms of allegations

⁷²² *Ibid* at para 7.

⁷²³ *Ibid* at para 15.

⁷²⁴ *Simms & Co. v Canada (Commissioner of Patents)*, 1938 CarswellNat 34, [1938] 3 DLR 453, [1938] Ex. CR 326.

⁷²⁵ *Ibid* para 16.

⁷²⁶ *Ibid* at para 3.

⁷²⁷ *Nehi Inc. v Canada (Registrar of Trade Marks)*, 1939 CarswellNat 28, [1939] 2 DLR 614, [1939] Ex. CR 217.

⁷²⁸ *Ibid* para 6.

⁷²⁹ *Molson Cos v Richmond Breweries Ltd* (1985), 5 CIPR 79 (TM Opposition Board)

of confusion of Spanish royal patronage being discounted, in *Spain v T.G. Bright & Co.*

⁷³⁰ and the mark “Brights Spanish House” was found not to offend s 9(1)(d).

(ii) Reforms of 1953

In 1947, the Government of Canada established the Trade Mark Law Revision Committee with the primary task of recommending changes to the 1932 *Unfair Competition Act*.⁷³¹ In his article describing the resulting legislation, E Gordon Gowling described the Committee:

It is reassuring to know that the new Canadian *Trade Marks Act* is not the creation of a few men dreaming in an ivory tower but the mature issue of studies that may be unmatched in the history of Canadian legislation[:] ... a committee ... with terms of reference sufficiently broad to enable it to review and make recommendations in the whole field of trade marks and unfair competition. The members were all familiar with the history and operation of the law as it exists. Among themselves, they represented three distinct points of view. There were, first of all, senior departmental officials whose duty it will be to administer the new statute and conduct the day to day affairs of the Trade Marks Office; then there were professional advisors with long and extensive experience in this particular branch of the law; and, finally, there were representatives of industry specially nominated by the Canadian Manufacturers Association and the Canadian Chamber of Commerce ... under the chairmanship of Dr. Harold G. Fox, Q.C. ...⁷³²

In the preliminary stages of its work, in preparation for the revisions to be presented (almost six years later) to the Secretary of State of Canada, the Committee “thought it desirable to ascertain the views of interested persons and bodies, not only in this country, but in Great Britain and the United States of America. Accordingly, [the committee] prepared a questionnaire directed to those points which, in the statute [the

⁷³⁰ *Spain v T.G. Bright & Co.* ⁷³⁰(1987), 13 CIPR 251 (TM Opposition Board)

⁷³¹ Daniel R Bereskin, “Canada’s Ill-Conceived New “Trademark” Law: A Venture into Constitutional Quicksand” (2014) 104:5 Trademark Reporter 1112 at 1115.

⁷³² E Gordon Gowling, “The New Canadian *Trade Marks Act*.” [1953] 31 Can Bar Rev 664 at 665. It is interesting to note that in the thirteen pages of the article, prohibited marks are nowhere discussed.

committee was] considering, appeared to be unsatisfactory and to have given rise to difficulties of interpretation or operation.”⁷³³

The “Report of the Trade Mark Law Revision Committee to the Secretary of State of Canada” was submitted to the Government of Canada on January 20, 1953. In its Report, the Committee devoted two paragraphs of attention to the “Prohibited Marks”:

Under Section 14 of The Unfair Competition Act, 1932, certain symbols are wholly excluded from registration [as trade marks] and even use. In the main, these are specific words and designs which are withdrawn from general employment because of legislative policy, as in the case of the Royal Arms and the national flag, because of treaty obligations, as in the case of territorial flags and the emblem of the Red Cross, or because of private rights, as in the case of signatures and portraits. Partly as a result of an extension of our treaty obligations and partly as a result of requests for protection, the list of such words and designs has been lengthened in Section 9 of the Bill, but this does not involve a change of principle.

Without attempting to review the situation generally, it might be helpful to mention that Section 9 contains broad provisions directed against the adoption of any word or symbol likely to lead to the belief that wares or services have received Royal, Vice-Regal or Governmental patronage, approval or authority. In addition, the prohibitions exclude any scandalous, obscene or immoral word or device or any matter that may falsely suggest a connection with any living person. The remainder of the provisions of Section 9 deal with particular situations which will be found self-explanatory upon examination.⁷³⁴

The result of the 1953 revision of the 1932 trademark legislation, the *Unfair Competition Act*, was the enactment of “*An Act Relating to Trade Marks and Unfair Competition*,” (cited as the *Trade Marks Act*).⁷³⁵ The changes made in 1953 to the 1932 legislation for Prohibited Marks are illustrated in Appendix F.

⁷³³ *Report of Trade Mark Law Revision Committee to the Secretary of State of Canada* (January 20, 1953). The Report is reprinted in Harold G Fox, *The Canadian Law of Trade Marks and Unfair Competition*, 2nd ed, vol 2 (Toronto: Carswell, 1956) (at 1142-1201) at 1142.

⁷³⁴ *Ibid* at 1155.

⁷³⁵ *Trade-Marks Act*, 1952-53, c 49, s. 1. One of the biggest changes in this legislation in the context of trademark law was to connect Canadian trademarks not just to goods or wares (to which Canadian

In the 1953 Act, under the heading "Unfair Competition and Prohibited Marks," section 9 (titled "Prohibited marks) was comprised of two subsections – retaining the structure originally introduced in 1932 (noted above): the 1953 *Trade-Marks Act* expanded the 1932 prohibited marks section by adding seven new provisions (see Appendix F).

The new subsections introduced in 1953 included prohibition against using as a trademark “(d) any word or symbol likely to lead to the belief that the wares or services in association with which it is used have received, or are produced, sold or performed under royal, vice- regal or governmental patronage, approval or authority”.⁷³⁶

Also included amongst the new prohibitions were the following:

- (i) two new symbols (subsection 9(1)(g) and subsection 9(1)(h)) – the Red Crescent emblem and Red Lion and Sun sign, respectively;
- (ii) any word or symbol that may be confused as being approved by any regal or governmental authority (subsection 9(1)(d);
- (iii) two subsections with general content: subsection 9(1)(j) any scandalous, obscene or immoral word or device, and subsection 9(1)(k) any matter that may falsely suggest a connection with any living individual; and
- (iv) a subsection related to institutions, one international (the United Nations in subsection 9(1)(m)) and the other related to a domestic institution (the Royal Canadian Mounted Police in subsection 9(1)(o)).

trademark legislation had applied in the past) but also to services: see E Gordon Gowling, “The New Canadian *Trade Marks Act*.” [1953] 31 Can Bar Rev 664 at 673.

⁷³⁶ *Ibid*, s 9(1)(d).

In 1964, Justice Dumoulin in *A.B. Statens Skogsindustrier v Registrar of Trade Marks* (referring to the 1939 decision in *Nehi Inc. v Registrar of Trade Marks*⁷³⁷, but making a decision more like the 1938 decision in *Simms & Co. v Canada (Commissioner of Patents*⁷³⁸), allowed the registration of the trademark "Royal Board Three Crowns" which, he held, "does not, in any manner or form, offend against [the new] s 9(1)(d) of the *Trade Marks Act*, 1952-53 (Can.), c. 49, nor against any other section of the aforesaid statute."⁷³⁹

(iii) To the present

There have been revisions to the *Trade Marks Act* since 1953 revision, culminating in revisions made on June 18, 2019. As may be seen in Appendix G, the revisions have been in relation to international symbols.

Since the introduction of 'forbidden marks' in subsection 14(1) of the 1932 *Unfair Competition Act*, through successive revisions to the present (including the 1953 revisions just discussed), the number of provisions for prohibited marks has almost doubled from eleven in 1932 to the present twenty-one provisions. Juxtaposing section 14 of the 1932 *Unfair Competition Act* with the prohibited marks as they appear in section 9 of the current *Trademarks Act* of this chapter makes the comparison visual (see again Appendix D).

⁷³⁷ *Supra*, text at note 725.

⁷³⁸ *Supra*, text at note 722.

⁷³⁹ *AB Statens Skogsindustrier v Registrar of Trade Marks* 1964 CarswellNat 76, 33 Fox Pat. C. 1 at para 1.

C - The International History Relating to Prohibited Marks

(a) Development of the *Paris Convention*

The concept of official marks was recognized in the very first *Paris Convention for the Protection of Industrial Property* [Paris Convention] in 1883. As Ahmad Takouche explains,

The Paris Convention is essentially a compact between the various member nations to accord in their own countries to citizens of the other member nations trademark and other rights comparable to those accorded their own citizens by their domestic law. The underlying principle is that foreign nationals should be given the same treatment in each of the member countries as that country makes available to its own citizens. The Convention is not premised upon the idea that the trademark laws of each member nation shall be given extraterritorial application, but on exactly the converse principle that each nation's law shall have only territorial application. Thus, the Paris Convention creates nothing that even remotely resembles a 'world mark' or an 'international registration'. Rather, it recognizes the principle of the territoriality of trademarks: a mark exists only under the laws of each sovereign nation.⁷⁴⁰

The original 1883 text notes the original nations involved in the Paris Convention:

Article 1. The Governments of France, Belgium, Brazil, Guatemala, Italy, Netherlands, Portugal, Salvador, Serbia, Spain and Switzerland constitute themselves into a Union for the protection of industrial property.

The United Kingdom became a member of the Union in 1884.⁷⁴¹ Although Canada had been made a self-governing country in 1867 through the Constitution Act, 1867⁷⁴², Canada was not independent of Great Britain in matters of foreign affairs until

⁷⁴⁰ Ahmad Takouche, "Well-known, or Not Well-Known? That is the Question. The Paris Convention for the Protection of Industrial Property's Article 6bis in the Context of American Trademark Law" (2019) 9:2 UC Irvine Law Rev 495 at 505, citing to 5 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, (5th ed).

⁷⁴¹ Contracting Parties, Paris Convention, online: https://wipo.int/en/treaties/ShowResults?search_what=C&treaty_id=2

⁷⁴² Constitution Act, 1867, (UK), 30 & 31 Vict, c 3, reprinted in RSC 1985, App II, No 5.

1931 (through Britain's 1931 *Statute of Westminster*⁷⁴³). Therefore, in 1884, when the United Kingdom joined the Paris Union, Canada was involved only through decisions taken by the United Kingdom. In light of the date of the *Statute of Westminster*, it might be thought that Canada would only have been able to join the Paris Convention in its own right after 1931.⁷⁴⁴ Canada, however, signed the Paris Convention in its own right on September 1, 1923.⁷⁴⁵ It was able to do so because of developments in the Paris Union itself, which took place in 1911 at the Washington Conference: an Article (Article 16*bis*) was "adopted, without much debate, ...opening up membership [in the Paris Union] to the colonies, under the control of the colonies themselves or that of their parent states".⁷⁴⁶ Canada, in joining the Paris Union, agreed to bring its domestic law into compliance with the provisions of the Paris Convention at the level of adherence to which it had pledged itself.⁷⁴⁷

⁷⁴³ UK 1931 Statute of Westminster s. 4: "No Act of Parliament of the United Kingdom passed after the commencement of this Act shall extend, or be deemed to extend, to a Dominion as part of the law of that Dominion, unless it is expressly declared in that Act that that Dominion has requested, and consented to, the enactment thereof."

⁷⁴⁴ Indeed, in his 1932 article "The Unfair Competition Act" (1932) 10:8 Can Bar Rev 507, EG Gowling acknowledged Canada's independence, by 1932, in international affairs: "Parliament has accomplished the twofold objective of fulfilling Canada's obligations as a member of the International Convention, and at the same time effecting many improvements in our trade mark laws." (at 508).

⁷⁴⁵ Contracting Parties, Paris Convention, online:
https://wipo.int/en/treaties/ShowResults?search_what=C&treaty_id=2

⁷⁴⁶ Gabriel Galvez-Behar, "The 1883 Paris Convention and the Impossible Unification of Industrial Property", in Graeme Gooday & Steven Wilf, eds, *Patent Cultures: Diversity and Harmonization in Historical Perspective* (Cambridge University Press, 2020) (Part 1, at 38-68) at 64.

⁷⁴⁷ Canada is currently committed to the *Paris Convention* at its most recent, 1967, level. The current Article 25 of the *Paris Convention*, titled "Implementation of the Convention on the Domestic Level" provides

- (1) Any country party to this Convention undertakes to adopt, in accordance with its constitution, the measures necessary to ensure the application of this Convention;
- (2) It is understood that, at the time a country deposits its instrument of ratification or accession, it will be in a position under its domestic law to give effect to the provisions of this Convention.

The heart of the original Paris Convention lay in Article 6, which provided:

Article 6.

[1] Every trade mark duly filed in the country of origin shall be accepted for filing and protected in its original form in the other countries of the Union.

[2] The country in which the applicant has his principal establishment shall be considered as the country of origin.

[3] If the principal establishment is not situated in one of the countries of the Union, the country to which the applicant belongs shall be considered as the country of origin.

[4] The filing may be refused if the object for which it is requested is considered as contrary to morality or public order

It was in subsection (4) of Article 6 that the international commitment to the concept of “official marks” lay: “[a trade mark] filing may be refused if the object for which it is requested is considered as contrary to morality or public order.”⁷⁴⁸

In connection with “official marks” there are two provisions that are of interest in the *Convention of Paris for the Protection of Industrial Property Final Protocol* of March 20th, 1883. First, the Final Protocol clarified that

1. The words ‘industrial property’ should be understood in the broadest sense: they relate not only to the products of industry in the strict sense but also to agricultural products... and mineral products which are put into trade.

And, second, the Final Protocol explained

4 [2] In order to avoid improper interpretation, it is understood that the use of public armorial bearings and decorations may be considered as contrary to public order, in the sense of the last paragraph of Article 6 [which dealt with symbols not to be trademarks].

⁷⁴⁸ *Paris Convention for the Protection of Industrial Property* (March 20, 1883; effective July 7, 1884).

The direct connection between official marks and “morality or public order” was made explicit in 1911 when, at the Washington Conference, Article 6 of the Paris Convention was revised as follows:

- (4) Every trade mark duly registered in the country of origin shall be accepted for filing and protected in its original form in other countries of the [Paris] Union.
- (5) Nevertheless, the following may be refused or invalidated...
 - ...
 - 3. Marks which are contrary to morality or public order.

It was pursuant to existence of these provisions in the 1883 and 1911 versions of the Paris Convention (as mentioned in Chapter 1) that, in the 1925 Hague Revision of the Paris Convention, the concept of prohibiting registration as trademarks marks through creating a list of non-trademarkable categories first appeared: “armorial bearings, flags, state emblems of the contracting countries, official signs and hallmarks indicating control and warranty adopted by them and all imitations thereof from a heraldic point of view”.⁷⁴⁹

It was only two years after Canada acceded to the Paris Convention in 1923, that, at the 1925 Revision Conference of the Hague, Article *6ter* creating “[p]rohibitions concerning State Emblems, Official Hallmarks, and Emblems of Intergovernmental Organizations”⁷⁵⁰ was added to the text of the Convention.

⁷⁴⁹ Article *6ter* (1). See Appendix E.

⁷⁵⁰ See “Article *6ter* of the Paris Convention: Legal and Administrative Aspects” prepared by the Secretariat of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, 15th session (Geneva, Nov 28 to Dec 2, 2005), WIPO October 14, 2005, Annex 1 at 2, online: https://www.wipo.int/edocs/mdocs/sct/en/sct_15/sct_15_3.pdf.

The World Intellectual Property Organization [WIPO], which now administers public international intellectual property treaties,⁷⁵¹ has noted that “Article 6*ter* [of the Paris Convention] does not generate a trademark right, or any other type of [intellectual property] right, over the signs that are covered by that provision.”⁷⁵² In 2009, a piece in “WIPOMAGAZINE”, issued by WIPO, notes “[u]nlike trademarks, which have a commercial purpose and are owned by individual persons, companies and entities, State signs or the signs, names and abbreviations of international governmental organizations cannot be the subject of individual property rights.”⁷⁵³

Unlike trademarks (which have a commercial purpose and are owned by individual persons, companies or entities), official marks, such as State signs or the signs, names and abbreviations of international intergovernmental organizations cannot be the subject of individual property rights. Article 6*ter*, therefore prohibits the registration or use of such signs, names and abbreviations as trademarks. The provision also covers official signs and hallmarks indicating control and warranty adopted by States.

The intention of Article 6*ter* is not to create a special form of intellectual property right⁷⁵⁴ for States and intergovernmental organizations, but to prevent the signs, names

⁷⁵¹ The Paris Union, which is the group of member countries of the Paris Convention, still is the body that considers and would enact any changes to the Paris Convention: it is a body within the World Intellectual Property Organization [WIPO], which was, itself, formed in 1967 (see Convention Establishing the World Intellectual Property Organization, United Nations General Assembly (1967) 14 July 1967, 828 UNTS 3) and became an organ of the United Nations in 1970. The current members of the Paris Union may be found at WIPO, Assembly (Paris Union),

https://wipolex.wipo.int/en/treaties/ShowResults?search_what=B&bo_id=5

⁷⁵² See WIPO, Article 6*ter*, online: <<https://www.wipo.int/article6ter/en/>>.

⁷⁵³ See WIPOMAGAZINE, online: <wipo.int/wipo_magazine/en/2009/03/article_0009.html>.

⁷⁵⁴ Even as early as 1878, Gabriel Galvez-Behar notes that international gatherings were bedeviled with “[t]he recurring question of assimilating industrial property to property under common law... but the lines of the division on this issue did not align with the nationality of those taking part in the debate.” (at 56) Eventually, however, at that 1878 gathering, “industrial property was not entirely identified with a positive right. Nor was it broadly attributed the status of a natural right. The tones and nuances had changed. While the utilitarian and positive position was affirmed on the banks of the Danube, on the banks of the Seine,

and abbreviations associated with them from being used or appropriate as trademarks without proper authorization.

Article 6*ter* has been revised since its inception in 1925, first in the 1934 London Revision to the Paris Convention⁷⁵⁵, then at Lisbon in 1958⁷⁵⁶ and most recently, in the 1967 Stockholm Revision.⁷⁵⁷ (See Appendix E, which presents each article of Article 6*ter* in all the versions of the Paris Convention (with changes from version to version highlighted).

At the 1958 Conference of the Paris Union in Lisbon there was an extensive elaboration of the concepts relevant to prohibited marks. One key aspect of the 1958 Paris Revision was the extension of the provisions of Article 6*ter* to the armorial bearings, flags, other emblems, abbreviations and names of international governmental organizations.⁷⁵⁸ A second new inclusion was the provision that provided that in order for a state or international governmental organization to get protection under Article 6*ter* for prohibited marks (other than flags of states), the state or international governmental

supporters of natural right had received a better hearing without questioning the basic consensus.” (at 58), Gabriel Galvez-Behar, “The 1883 Paris Convention and the Impossible Unification of Industrial Property,” in Graeme Gooday & Steven Wilf, eds, *Patent Cultures: Diversity and Harmonization in Historical Perspective* (Cambridge University Press, 2020) (Part 1, at 38-68).

⁷⁵⁵ *Paris Convention for the Protection of Industrial Property* of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934.

⁷⁵⁶ *Paris Convention for the Protection of Industrial Property* of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958.

⁷⁵⁷ *Paris Convention for the Protection of Industrial Property* of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, at Stockholm on July 14, 1967.

⁷⁵⁸ In 1992 the Paris Union adopted “Guidelines for the Interpretation of Article 6*ter*(1)(b) and 3(b) of the Paris Convention for the Protection of Industrial Property” which are intended to clarify elements concerning the protection of symbology relating to international governmental organizations. See online: wipo.int/article6ter/en/legal_texts/guidelines.html

organization was to communicate with the International Bureau of WIPO.⁷⁵⁹

As can be seen in Appendix E, many of the 1967 changes made to Article 6*ter* were editorial changes. One change made in 1967, however, to Article 1(c), would appear to have substantive implications.

Originally, in 1925, Article 1 read simply

The contracting countries agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags and other State emblems of the contracting countries, official signs and hallmarks indicating control and warranty adopted by them and all imitations thereof from a heraldic point of view.⁷⁶⁰

In 1958 Article 1(b) was added to the *Paris Agreement*, reading:

The provisions of sub-paragraph (a) above apply equally to armorial bearings, flags and other emblems, abbreviations or titles of international intergovernmental organizations of which one or more countries of the Union are members, with the exception of armorial bearings, flags and other emblems, abbreviations or titles that are already the subject of existing international agreements intended to ensure their protection,

and, in that same year (1958), Article 1(c) was added:

No country of the Union shall be required to apply the provisions of sub-paragraph (b) above to the prejudice of the owners of rights acquired in good faith before the entry into force, in that country, of the present Convention. The countries of the Union shall not be required to apply the said provisions when the use or registration covered by sub-paragraph (a) above is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbreviations or titles, or if such use or registration is **clearly not of a nature** to mislead the public as to the existence of a connection between the user and the organization [emphasis added].

⁷⁵⁹ See WIPO, Article 6*ter*, online: <https://www.wipo.int/article6ter/en/general_info.html>

⁷⁶⁰ As can be seen in **Appendix E**, in 1934 the words “contracting countries” were replaced by “countries of the Union”.

In the 1967 revision of the Paris Convention, Article 1(c) was changed to read:

No country of the Union shall be required to apply the provisions of sub-paragraph (b) above to the prejudice of the owners of rights acquired in good faith before the entry into force, in that country, of this Convention. The countries of the Union shall not be required to apply the said provisions when the use or registration referred to in sub-paragraph (a) above is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbreviations and names, or if such use or registration is **probably not of such a nature as** to mislead the public as to the existence of a connection between the user and the organization [emphasis added].

The change in the text of Article 1(c) from “clearly not of a nature to mislead the public” in 1958 to “probably not of such a nature as to mislead the public” in 1967 appears to be a substantive change, not an editorial one.

In the overall context of Article 1(c), the 1967 change would appear to less often require countries to apply Article 6*ter* (1)(a) than was the case previous to the 1967 change.

Recall that Article 6*ter* (1)(a) [quoted above in its original 1925 form and here in its 1967 form] requires states to refuse or invalidate trademarks comprised of (or containing elements of) prohibited marks:

- (a) The countries of the Union agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags and other State emblems of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them and any imitation from a heraldic point of view.

The 1967 change to Article 6*ter* 1(c) allows a country to decide not to refuse or invalidate or prohibit the use of a mark under Article 6*ter* (1)(a) if that mark is “probably” (rather

than the earlier “clearly”) “not of a nature to mislead the public” – which means countries can now, in more cases, prioritize trademarks over prohibited marks.

Article *6ter* (2) of the Paris Convention sets limits on countries’ abilities to impose on a trademark holder in terms of ensuring that a trademark does not use a prohibited mark:

Prohibition of the use of official signs and hallmarks indicating control and warranty shall apply solely in cases where the marks in which they are incorporated are intended to be used on goods of the same or similar kind.

The requirement of countries to involve WIPO’s bureaucracy in administration of prohibited marks (other than flags of States) is made clear in Paris Convention Article

6ter.⁷⁶¹

(3)(a) For the application of these provisions the countries of the Union agree to communicate reciprocally, through the International Bureau, the list of State emblems and official signs and hallmarks indicating control and warranty which they desire, or may hereafter desire, to place wholly or within certain limits under the protection of the present Article, and all subsequent modifications of such list. Each country of the Union shall in due course make available to the public the lists so communicated. Nevertheless such communication is not obligatory in respect of flags of States.

(b) Matters whose inclusion in Article *6ter* of *Paris* has been debated

In 1967, as chronicled by Natalie Corthésy, an international debate arose about whether Article *6ter* protects country names.⁷⁶² The debate raised the possibility that if

⁷⁶¹ Both states and intergovernmental organizations can access WIPO’s processes in this regard through its website at <https://www.wipo.int/article6ter/en/>

⁷⁶² Natalie Corthésy, “Trade Marks, Country Names and Misappropriation of National Identity” (2017) 12:4 J Intell Prop L & Prac 297 at 299.

Article *6ter* did not protect country names, Article *10bis* the Paris Convention's prohibition on 'Unfair Competition' does:

- (1) The countries of the Union are bound to assure to nationals of such countries effective protection against unfair competition.
- (2) Any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition.
- (3) The following in particular shall be prohibited:
 - (i) all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor;
 - (ii) false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor;
 - (iii) indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.

Although at the 1982 WIPO Diplomatic Conference for the revision of the Paris Convention “it was resolved that official names of states would be excluded from the scope of Article *6ter* and ... recommended that protection of country names should be implemented under Article 10 by means of unfair competition”⁷⁶³ there was no change to the wording of Article *6ter* of the Paris Convention.

While claiming that “Article *10bis* ... establishes a well-entrenched negative right of protection against unfair competition”,⁷⁶⁴ Corthésy also admits that “national rules of unfair competition are as varied and unique in each jurisdiction, as country names

⁷⁶³ Natalie Corthésy, “Brand New IP: ‘Country name designation’ – from France with love”, Chapter 16 in Daniel J Gervais, *The Future of Intellectual Property*, ATRIP Intellectual Property Series (Cheltenham: Edward Elgar, 2021) Chapter 16 (at 322-345) at 332.

⁷⁶⁴ *Ibid.*

themselves”⁷⁶⁵ and, despite the 1982 resolution recommending protection of country names under Paris Convention Article 10, Corthésy reports that “[i]nsignias of sovereignty, albeit delimited in Article 6*ter* to flags, emblems, armorial bearings from a heraldic point of view, are nevertheless interpreted by some countries as including country names.”⁷⁶⁶

When discussing Article 6*ter* of the Paris Convention⁷⁶⁷ with respect to its protection of country names, Natalie Corthésy, noted

When branding products with country names, the moral compass guiding the management of industrial property has been ‘Thou shalt not lie.’ Article 6*ter* of the Paris Convention has clearly incorporated this perspective by providing for the protection of national emblems and like indicators from a heraldic point of view. ... However, there is no specific mention of official country names.⁷⁶⁸

Corthésy states that

There is no homogeneity in how WIPO Member States treat with country names in their national IP systems. There is no requirement in most WIPO member states to have or make reference to a list of country names in their examination of trade mark applications. Trade marks examiners will usually be required to search various sources to determine whether the application under review incorporates a country name. These include UN databases, the WIPO database, national trade mark guidelines, gazettes and dictionaries.⁷⁶⁹

⁷⁶⁵ *Ibid.*

⁷⁶⁶ Corthésy, “Trade Marks, Country Names ...”, *supra* note 762 at 303. Corthésy ultimately calls for “a protection-based system that acknowledges that, in modern global trade, a country name has two pivotal functions: the communication of the source of goods for consumer protection, and the communication of the reputation of the quality associated with the nation brand to promote fair competition between producers. This can only be achieved by devising a scheme to protect country names on both economic and moral grounds. Perhaps the better view is that an image rights approach is a more pragmatic method of realising this objective.” (citing to herself in Natalie Corthésy, “Brand New IP” *supra* note 761 at 336).

⁷⁶⁷ Further discussed below in this chapter.

⁷⁶⁸ Corthésy, “Trade Marks, Country Names ...”, *supra* at note 766 at 306.

⁷⁶⁹ Natalie G.S. Corthésy, “Country Name Designation and International IP Protection of National Competitive Identities,” (2021) 16: 4-5 J Intell Prop L & Prac 357 at 360 [footnotes omitted].

She also notes both that “[t]he nexus between the distinctiveness of country names, and their pervasive use in branding is evident”⁷⁷⁰ and that “[e]conomists assert that country names can function as a brand.”⁷⁷¹ Having said that “[t]he distinctiveness of a country name (and all the cultural and qualitative values that it evokes) imbues it with undeniable marketing value.”⁷⁷² Corthésy has, on the other hand, conceded that “country names are widely considered as geographic commons ... [and] a number of economists do not consider some country names as nation brands at all.”⁷⁷³

Corthésy goes on to observe that current “multilateral proposals for increased IP protection of country names should contemplate safeguards for official names of States as distinct from nation brands, as well as rules related co-branding and country of origin labelling”.⁷⁷⁴ She notes, publishing in 2021, that there is present, in international circles, “a request for the WIPO General Assembly to adopt a workable mechanism that will implement a higher threshold of protection for country names”.⁷⁷⁵

Later in Corthésy’s article, she states that

The Paris Convention was not intended to regulate or protect the sovereign personality of its signatories: neither the exclusive right of a State to its name and reputation nor the quasi-property right of a State to determine criteria for co-branding its name in commerce [but]...[i]f it decided that the function of country names has expanded beyond its communication function as an indication of source to prevent unfair competition, surpassed its quality function as an appellation of origin guaranteeing geographic place reputation, exceeded its value multiplier function as a geographical indication that protects evocative value of the geographic name, and now embodies a novel national competitive identity

⁷⁷⁰ Corthésy, “Brand new IP” *supra* note 763 at 330.

⁷⁷¹ *Ibid.*

⁷⁷² Corthésy, “Trade Marks, Country Names ...” *supra* note 766 at 298.

⁷⁷³ Corthésy, “Brand new IP” *supra* note 763 at 331.

⁷⁷⁴ Corthésy, “Country Name Designation ...” *supra* note 769 at 361.

⁷⁷⁵ *Ibid* at 362.

function, consideration should be given to adopting policies related to IP protection of country names to address new and emerging paradigms.⁷⁷⁶

Section 9 of Canada's *Trademarks Act* does not include protection of country names.

(c) Canada's implementation of its international obligations

The provisions of Section 9 of Canada's *Trademarks Act* that deal with international matters to which an international treaty or agreement could apply are (as set out above):

- (g) the emblem of the Red Crescent on a white ground adopted for the same purpose as specified in paragraph (f) [paragraph (f) addressing the Red Cross];
- (g.1) the third Protocol emblem — commonly known as the “Red Crystal” — referred to in Article 2, paragraph 2 of Schedule VII to the Geneva Conventions Act and composed of a red frame in the shape of a square on edge on a white ground, adopted for the same purpose as specified in paragraph (f) [paragraph (f) addressing the Red Cross];
- (h) the equivalent sign of the Red Lion and Sun used by Iran for the same purpose as specified in paragraph (f) [[paragraph (f) addressing the Red Cross];
- (h.1) the international distinctive sign of civil defence (equilateral blue triangle on an orange ground) referred to in Article 66, paragraph 4 of Schedule V to the Geneva Conventions Act;
- (i) any territorial or civic flag or any national, territorial or civic arms, crest or emblem, of a country of the Union, if the flag, arms, crest or emblem is on a list communicated under **article 6ter of the Convention** or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;
- (i.1) any official sign or hallmark indicating control or warranty adopted by a country of the Union, if the sign or hallmark is on a list communicated under **article 6ter of the Convention** or pursuant to the obligations under Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO

⁷⁷⁶ *Ibid* at 363.

Agreement stemming from that article, and the Registrar gives **public notice** of the communication;

- (i.2) any national flag of a country of the Union;
- (i.3) any armorial bearing, flag or other emblem, or the name or any abbreviation of the name, of an international intergovernmental organization, if the armorial bearing, flag, emblem, name or abbreviation is on a list communicated under **article 6ter of the Convention** or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;
- (m) the words “United Nations” or the official seal or emblem of the United Nations.

Procedurally, as noted by Natalie Corthésy, an international consensus was reached in 1967 “that each contracting State should be required to elaborate a list of insignias of sovereignty for which they seek protection and give notice to the international bureau, the WIPO.”⁷⁷⁷

Member states of the World Trade Organization [WTO] are required to observe Article 6ter of the Paris Convention (at the 1967 level), even if they are not members of the Paris Union. This requirement for WTO members arises through Article 2.1 of the TRIPS Agreement⁷⁷⁸: “In respect of Parts II, III and IV of this Agreement, Members shall comply with Articles 1 through 12 [which, of course, includes Article 6ter], and Article 19, of the Paris Convention (1967)”. Article 2.2 of TRIPS continues: “Nothing in Parts I to IV of this Agreement shall derogate from existing obligations that members may have to each other under the Paris Convention...”

When the multilateral TRIPS Agreement was being negotiated, an Agreement

⁷⁷⁷ Corthésy, “Trade Marks ...” *supra* note 766 at 298.

⁷⁷⁸ TRIPS Agreement *supra* note 9, art 2.1.

was concluded between the public international World Intellectual Property Organization and the nascent World Trade Organization, “Agreement Between the World Intellectual Property Organization and the World Trade Organization (1995)”. Article 3 of this agreement deals with “Implementation of Article *6ter* of the Paris Agreement for the Purposes of the TRIPS Agreement.” Article 3 consists of three subsections, the effect of which are, as the WTO advises, that “[t]he International Bureau of WIPO administers the communication procedures under Article *6ter* for the purposes of the TRIPS Agreement in accordance with the procedure applicable under Article *6ter* of the Paris Convention (1967).”⁷⁷⁹

In 2009, WIPO decided that the

The reciprocal communication through the intermediary of the International Bureau, under Article *6ter* (3)(a) and (b) of the Paris Convention ...of signs for which protection under Article *6ter* (1)(a) and (b) is requested will be made through a semi-annual publication, in an electronic database on the website of [WIPO].⁷⁸⁰

As the WTO notes “[a]fter the TRIPS Agreement entered into force, notifications made under Article *6ter* of the Paris Convention became effective under the agreement for all WTO members whether they were parties to the Paris Convention or not.”⁷⁸¹

Canada’s *Trademarks Act*, in subsections 9(1)(i), 9(1)(i.1) and 9(1)(i.3), refer

⁷⁷⁹ WTO, “Procedures for Notifying and Sharing Information: State Emblems”, online: https://www.wto.org/english/tratop_e/trips_e/trips_notif7_sixter_e.htm.

⁷⁸⁰ Decision of the 40th Session of the Paris Union Assembly. See Decision by the Assembly of the Paris Union, online: wipo.int/article6ter/en/legal_texts/decision_14.html. There are now 4131 documents in the Article *6ter* database, found at wipo.int/ipdl-6ter/struct-search/?eng=en

⁷⁸¹ WTO, “Procedures for Notifying and Sharing Information: State Emblems”, online: https://www.wto.org/english/tratop_e/trips_e/trips_notif7_sixter_e.htm.

specifically to both Article 6*ter* of the Paris Convention⁷⁸² and the obligations for the members of the Union arising from the TRIPS Agreement:⁷⁸³

9 (1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for,

(i) any territorial or civic flag or any national, territorial or civic arms, crest or emblem, of a country of the Union, if the flag, arms, crest or emblem is on a list **communicated under article 6^{ter} of the Convention or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article**, and the Registrar gives public notice of the communication [emphasis added];

(i.1) any official sign or hallmark indicating control or warranty adopted by a country of the Union, if the sign or hallmark is on a list **communicated under article 6^{ter} of the Convention or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article**, and the Registrar gives public notice of the communication [emphasis added];

(i.3) any armorial bearing, flag or other emblem, or the name or any abbreviation of the name, of an international intergovernmental organization, if the armorial bearing, flag, emblem, name or abbreviation is on a list communicated **under article 6^{ter} of the Convention or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article**, and the Registrar gives public notice of the communication [emphasis added].

⁷⁸² *Paris Convention for the Protection of Industrial Property* of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, at Stockholm on July 14, 1967.

⁷⁸³ *Trademarks Act*, *supra* note 22, ss 9(1)(i), 9(1)(i.1), and 9(1)(i.3).

D - Justice Mactavish’s Taxonomy of Prohibited Marks

In the 2005 *Canada Post Corporation v United States Postal Service* decision,⁷⁸⁴

Justice Mactavish proposed a conceptual grouping of prohibited marks⁷⁸⁵ as follows:

[53] In this regard, it appears that the provisions of subsection 9(1) can be grouped into four categories:

1. Provisions preventing use of a specific mark or symbol...
2. Provisions that Parliament clearly intended to have application to foreign entities...
3. Provisions that Parliament intended to have apply only to Canadian entities...
4. Provisions intended to apply to any entity regardless of location...

In her judgment, Justice Mactavish, at para 53, lists the four categories set out above and then cites to provisions of Section 9 of the *Trademarks Act* as examples of each of the four categories she has identified. Taken together, the categories and subsections of Section 9 to which Justice Mactavish cited as examples are set out below in Table 4. For whatever reason, Justice Mactavish did not include the following subsection of Section 9⁷⁸⁶ amongst her examples:

⁷⁸⁴ *Canada Post Corporation v United States Postal Service* 2005 FC 1630.

⁷⁸⁵ Justice Mactavish wrote, at paragraph 53, In this regard, it appears that the provisions of subsection 9(1) can be grouped into four categories” and listed the subsections together that appear in this chapter in Table 4. Justice Mactavish did not include subsection 9(1)(g.1) (“the emblem of the Red Crescent on a white ground adopted for the same purpose as specified in paragraph (f)”) in her taxonomy as it was only added in 2007, after she had written her judgment – otherwise, every subsection in the current section 9 but one is included in one of Justice Mactavish’s categories. It appears that subsection 9(1)(d) [“any word or symbol likely to lead to the belief that the goods or services in association with which it is used have received, or are produced, sold or performed under, royal, vice-regal or governmental patronage, approval or authority”] may have been omitted in error. It is hard to speculate whether Justice Mactavish would have included it amongst the subsections listed in Table 4 under “Preventing Use of a Specific Mark or Symbol” or under “Provisions Applying Only to Canadian Entities”.

⁷⁸⁶ Justice Mactavish’s taxonomy also does not include current s 9(1)(g.1) – but this is because this provision had not yet been enacted in the *Trade Marks Act* when she was writing her judgment in 2005. Section 9(1)(g.1) reads

(d) any word or symbol likely to lead to the belief that the goods or services in association with which it is used have received, or are produced, sold or performed under, royal, vice-regal or governmental patronage, approval or authority;

Table 4: Justice Mactavish's Taxonomy of Prohibited Marks, Section 9 of the Trademarks Act

I - Provisions Preventing Use of a Specific Mark or Symbol
(a) the Royal Arms, Crest or Standard;
(b) the arms or crest of any member of the Royal Family;
(c) the standard, arms or crest of His Excellency the Governor General;
(f) the emblem of the Red Cross on a white ground, formed by reversing the federal colours of Switzerland and retained by the Geneva Convention for the Protection of War Victims of 1949 as the emblem and distinctive sign of the Medical Service of armed forces and used by the Canadian Red Cross Society, or the expression “Red Cross” or “Geneva Cross”;
(g) the emblem of the Red Crescent on a white ground adopted for the same purpose as specified in paragraph (f);
(h) the equivalent sign of the Red Lion and Sun used by Iran for the same purpose as specified in paragraph (f);
(h.1) the international distinctive sign of civil defence (equilateral blue triangle on an orange ground) referred to in Article 66, paragraph 4 of Schedule V to the Geneva Conventions Act ;
(j) any scandalous, obscene or immoral word or device;
(k) any matter that may falsely suggest a connection with any living individual;
(l) the portrait or signature of any individual who is living or has died within the preceding thirty years;
(m) the words “United Nations” or the official seal or emblem of the United Nations.
II - Provisions Applying to Foreign Entities
(i) any territorial or civic flag or any national, territorial or civic arms, crest or emblem, of a country of the Union, if the flag, arms, crest or emblem is on a list communicated under article 6ter of the Convention or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;
(i.1) any official sign or hallmark indicating control or warranty adopted by a country of the Union, if the sign or hallmark is on a list communicated under article 6ter of the Convention or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;
(i.2) any national flag of a country of the Union;
(i.3) any armorial bearing, flag or other emblem, or the name or any abbreviation of the name, of an international intergovernmental organization, if the armorial bearing, flag, emblem, name or abbreviation is on a list communicated under article 6ter of the Convention or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;
III - Provisions Applying Only to Canadian Entities

the third Protocol emblem – commonly known as the “Red Crystal” – referred to in Article 2, paragraph 2 of Schedule VII to the Geneva Conventions Act and composed of a red frame in the shape of a square on edge on a white background, adopted for the same purpose as specified in paragraph (f).

(e) the arms, crest or flag adopted and used at any time by Canada or by any province or municipal corporation in Canada in respect of which the Registrar has, at the request of the Government of Canada or of the province or municipal corporation concerned, given public notice of its adoption and use;
(n) (1) Any badge, crest, emblem or mark (i) adopted or used by any of Her Majesty's Forces as defined in the <i>National Defence Act</i>
(n) (1) Any badge, crest, emblem or mark (iii) adopted and used by any public authority, in Canada as an official mark for goods or services, in respect of which the Registrar has, at the request of Her Majesty or of the university or public authority, as the case may be, given public notice of its adoption and use;
(n.1) any armorial bearings granted, recorded or approved for use by a recipient pursuant to the prerogative powers of Her Majesty as exercised by the Governor General in respect of the granting of armorial bearings, if the Registrar has, at the request of the Governor General, given public notice of the grant, recording or approval;
(o) the name "Royal Canadian Mounted Police" or "R.C.M.P." or any other combination of letters relating to the Royal Canadian Mounted Police, or any pictorial representation of a uniformed member thereof.
IV - Provision Intended to Apply to any Entity Regardless of Location
(n) (ii) any badge, crest, emblem or mark ... (ii) of any university

Justice Mactavish does not explain her categorization in her judgment: by inspection, it does not appear that the categorizing factor through which she created her taxonomy could relate to reputation.

The litigation arose because Canada Post Corporation had applied to the Federal Court for judicial review of the Registrar of Trade-marks' decisions "to give public notice of the adoption and use of 13 official marks by the United States Postal Service".⁷⁸⁷ Justice Mactavish held that s 9(1)(n)(iii) does require that a public authority be a Canadian public authority – and set aside decisions of the Registrar to give public notice of the adoption and use of the marks of the United States Postal Service.⁷⁸⁸ On appeal from Justice Mactavish's judgment, the Ontario Court of Appeal again found unanimously (Justice Sharlow for himself and Justices Nadon and Sexton) for Canada Post, in one paragraph:

We are all of the view that this Appeal must be dismissed... to be a 'public authority' within the meaning of subparagraph 9(1)(n)(iii)... an

⁷⁸⁷ *Canada Post Corp. v United States Postal Service*, [2006] 3 FCR 28 at para 1.

⁷⁸⁸ *Ibid* at para 79.

entity must be subject to government control and must engage in activities that benefit the public. In our view, to fulfil the intention of Parliament, the government exercising the control must be a Canadian government. We are not persuaded that this interpretation of the statute offends the Paris Convention for the Protection of Industrial Property or the Agreement on Trade-Related Aspects of Intellectual Property Rights.⁷⁸⁹

E - Olympics and Litigation Involving the Prohibited Marks Legislation

A considerable number of cases regarding the courts' interpretations of "public authority" under subsection 9(1)(n)(iii) have involved the Canadian Olympic Association. The cases *Techniquip Ltd v Canadian Olympic Assn*, 1999 CanLII 8993(FCA), *Canadian Olympic Assn. v Konica Canada Inc.*, (C.A.) 1991 CanLII 8363 (FCA), [1992] 1 FC 797, and *Canadian Olympic Assn. v Gym Tonic Ltd.* (1988), 19 CIPR 127 (Fed. T.D.) are just a few of many.

In connection with the 1988 Calgary Olympics, a case arose, *Canadian Olympic Assn v Hipson* (1987) 15 CIPR 99 (Alta QB), in which the Canadian Olympic Assn (a public authority) was able to rely on s 9(1)(e). Since 2007, however, matters in Canada “respecting the protection of marks related to the Olympic Games and the Paralympic Games and protection against certain misleading business associations ...”⁷⁹⁰ have been dealt with through a specific federal enactment: the *Olympic and Paralympic Marks Act*, SC 2007, c 25, which has been amended by SC 2014 c 20 and c 32, and by SC 2017 c 6. This legislation deals with prohibited marks. The term “reputation” does not appear anywhere in the statute.

⁷⁸⁹ See *United States Postal Service v Canada Post Corporation*, 2007 FCA 10 (leave denied by SCC, 27 June 2007, Justices Binnie, Deschamps and Abella).

⁷⁹⁰ This language is included in the full title of the statute: see SC 2007, c 25.

F - Concluding Remarks on Reputation as Implied in Prohibited Marks

The term “reputation” does not appear in any of the provisions of section 9 of the *Trademarks Act*. However, the historical and social significance of all the individuals and institutions listed as bearers of symbols protected by prohibited marks legislation indicate reputation as an inseparable characteristic of their existence (e.g., the arms or crest of any member of the Royal Family (s 9(1)(b)), or the standard, arms or crest of Her Excellency the Governor General (s 9(1)(c)); the emblem of the Red Cross (s 9(1)(m)) the words "United Nations" or the official seal or emblem of the United Nations (s 9(1)(m)); the name "Royal Canadian Mounted Police" or "R.C.M.P." (s 9(1)(o)).

Certain of the provisions of Section 9 contain language that appears to broadcast the connection of the provision with the concept of “reputation”. As Teresa Scassa notes, in reference to subsections 9(1)(a), 9(1)(b) and 9(1)(c), “the use of words ‘royal’ or ‘crown’ will be allowed in trademarks so long as there is no likelihood that the public will believe there has been royal endorsement or approval.”⁷⁹¹ Inverting her statement, it can be seen that if the public believes that there has been royal endorsement or approval where there has not, it could bring the reputations of the royal persons involved in subsections (a) and (b) and Her Excellency the Governor General (in subsection (c)) into disrepute. In addition to subsection 9(1)(a), (b), and (c), it appears clear that reputation is directly involved in consideration of the following subsections of Section 9:

- subsection (d), “any word or symbol likely to lead to the belief that the goods or services in association with which it is used have received, or are produced, sold or performed under, royal, vice-regal or governmental patronage, approval or authority [emphasis added]” focuses directly on the reputations of “royal, vice-regal or

⁷⁹¹ Scassa, *supra* note 21 (Ch 4 “Prohibited Marks”) at 204.

governmental” individuals;

- subsection (k), “any matter that may falsely suggest a connection with any living individual”: this language is very similar to language found in defamation cases and moral rights legislation and cases (particularly, in the case of moral rights, in connection with the right of paternity) – Johnny Carson’s reputation helped defeat an application to register a trademark “HERE’S JOHNNY” on the ground that to do so would violate s 9(1)(k) (*Carson v Reynolds* (1980), 49 CPR(2d) 57 (Fed. T.D.) – and in *Baron Philippe de Rothschild SA v Casa de Habana Inc* (1987), 17 CIPR 185 (Ont HC), the Court held the Casa de Habana could not use “Rothschild” as a trademark or tradename because the name would give the impression to the public that the establishment was prestigious, through a connection with a living individual: use of the name was found to be grossly improper even without proof of actual injury or damage;
- subsection 9(l) “in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for the portrait or signature of any individual who is living or has died within the preceding thirty years”.

The language of “likely to believe”, emphasized above in the quotation of s 9(1)(d) is very close to the language of defamation litigation, as described in Chapter 3.

Although not explicitly articulated, ‘reputation’ has been demonstrated in this chapter as a pre-existing element that has led historically to these prohibited marks being protected under the *Trademarks Act*. The answer to the first part of the question set out at the beginning of this chapter is that the concept of reputation is, indeed, involved in Canada's prohibited marks.

The answer to the second part of the question is explained as follows. In Canada's *Trademarks Act*, the protection of prohibited marks is legislated as an exception to trademark protection. In addition to being non-tradeable, non-transferable, and non-licensable (and thus inalienable), these marks should not be characterized as classic intellectual property (like trademarks). As noted early in this chapter, prohibited marks

are not involved in the “trademark bargain” whereby trademark owners and their assigns enjoy the legal protection of trademark (keeping others from using the mark in association with given products or services) for however long the public understands that mark as representing the goods or services of the trademark holder.⁷⁹² The protection of the symbols protected under Section 9 is perpetual.

Although the word “reputation” does not appear in Section 9 of the *Trademarks Act*, in legislating marks into Section 9, as this chapter has demonstrated, Parliament has recognized the inherent value of reputation to the holders of these marks – and has legislated to protect it, by making these marks. In some cases, this recognition of the inherent value of a mark’s reputation is recognition that Parliament has legislated – but, as has been demonstrated, in a number of the categories listed in Section 9, Canada’s recognition of an inherent reputation has been at least reinforced, if not dictated, by Canada’s participation in the World Intellectual Property Organization (acting on behalf of both the Paris Convention and the World Trade Organization).

⁷⁹² See again Wilkinson, “What is the Role of New Technologies” *supra* note 62. Wilkinson writes (at p 14) that

once individual and corporate interests were separated during the nineteenth century – and diverged even more during the twentieth – the concept of “balance” in intellectual property needed to be reconceptualized in terms of “balancing” three sets of interests: those of individuals (as it is undeniably individuals cognitive activity which produces creativity and innovation), those of corporations (which have come to dominate in terms of both ownership ... and influence upon economies), and that of the public.

Wilkinson points out, earlier in the chapter (at p 9) that

[u]p until the mid-nineteenth century, when modern separation 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.

Citing to France’s *Manufacture and Goods Mark Act* of 1857, she points (at pp 12-13) to the fact that “legal recognition of trademarks occurred in the mid-nineteenth century, roughly concurrent with the emergence of the legal device of the corporation” and notes that “[c]oincidentally, the original ... Paris [Convention] 1883... appear[ed] either before or just simultaneous with the beginnings of recognition of corporations as separate persons in law (1886 in American courts, 1897 in British...)” (All footnotes have been omitted).

This demonstrates that the value of reputation captured by the provisions of Section 9 of Canada's *Trademarks Act* that are echoed in the Paris Convention is a shared value across virtually every nation state on the globe.

Unlike reputation in moral rights as seen in Chapter 4, in this chapter, exploring reputation in prohibited marks - there is no articulation of the term reputation in Section 9 of Canada's *Trademarks Act*. However, as seen in this chapter, Parliament has recognized the inherent value of reputation to the holders of symbols listed in Section 9 of the trademark statute. It is noteworthy that the progenitors of the 1883 Paris Convention protected prohibited marks from commercialization even as they were creating an international structure for trademark.

The context of prohibited marks in the *Trademarks Act* is not dissimilar to the context of the moral rights in the *Copyright Act*. Neither prohibited marks nor moral rights are tradable, licensable or transferable rights (whereas both copyright and trademarks are).

Both moral rights and prohibited marks clearly involve reputation, albeit at different stages.

The reputations protected in prohibited marks are reputations Parliament recognized before legislating the prohibited marks, but the reputations connected with moral rights must be proven when asserting the moral rights.

CHAPTER 6 - REPUTATION AS EXPRESSED IN THE CANADIAN LAW OF GEOGRAPHICAL INDICATIONS

The findings from the previous two chapters (Chapter 4 and Chapter 5) have shown that there are similarities between moral rights in the *Copyright Act* and prohibited marks in the *Trademarks Act*: particularly, that, although reputation in prohibited marks is differently demonstrated (being recognized by Parliament before these marks are legislated), reputation is the concept that links prohibited marks to moral rights because the concept of reputation is also expressed in moral rights (reputation being identified directly in moral rights enactment). Jurisprudence regarding reputation, however, is scarce for prohibited marks just as it is for moral rights.

This chapter will analyze the concept of reputation in geographical indications. It will also consider whether the concept of reputation inherent in defamation law can in any way assist with understanding the concept of reputation in geographical indications.

A – The Arrival of Geographical Indications in International Law

(a) The origin of the term

Article 1(2) of the original 1883 Paris Convention notes

The 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 [emphasis added].

However, despite inclusion of “indications of source” and “appellations of origin” in the list of the objects of industrial property, the 1883 Paris Convention did not include any provisions related to the governance of indications of source or appellations of origin.

The concepts of indications of source and appellations of origin had been emerging in Europe (and, particularly, in France) since the eighteenth century.⁷⁹³ Particularly in the case of the initial French preoccupation with protecting “Champagne” through legislation in the nineteenth century, Dev Gangjee has noted that “[r]eputation and quality were not central to the enquiry”⁷⁹⁴—“the initial emphasis [was] on physical geography in wine regulation systems.”⁷⁹⁵

The name Champagne (a wine region in France) and wines produced from the specific type of grapes grown in the Champagne region have been legally protected in the countries of Europe since the 1891 Madrid Treaty.⁷⁹⁶ Article 1 of the Madrid Treaty says that “[a]ll goods bearing a false or deceptive **indication** by which one of the countries to

⁷⁹³ Dev Gangjee. *Relocating the Law of Geographical Indications*. Cambridge: Cambridge University Press, 2012, “The Appellation of Origin in France”

⁷⁹⁴ *Ibid* at 97.

⁷⁹⁵ *Ibid* at 125.

⁷⁹⁶ *Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods*, 14 April 1891, (Act revised at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, and at Lisbon on October 31, 1958) [Madrid Agreement], online: <<https://wipo.int/en/text/286776>>. The 1891 Madrid Agreement came only eight years after the *Paris Convention for the Protection of Industrial Property* of March 20, 1883 (later revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, at Stockholm on July 14, 1967). Since the inception of the Madrid Agreement, the term “indication of source” has appeared in Article 10.1 and has remained almost unchanged into the latest 1967 Stockholm revision of the Paris Convention, which reads as follows:

Article 10 [False Indications: Seizure, on Importation, etc., of Goods Bearing False Indications as to their Source or the Identity of the Producer]:

- (1) The provisions of the preceding Article shall apply in cases of direct or indirect use of a false **indication of the source** of the goods or the identity of the producer, manufacturer, or merchant.
- (2) Any producer, manufacturer, or merchant, whether a natural person or a legal entity, engaged in the production or manufacture of or trade in such goods and established either in the locality falsely indicated as the source, or in the region where such locality is situated, or in the country falsely indicated, or in the country where the false **indication of source** is used, shall in any case be deemed an interested party. [emphasis added]

It was through in the 1925 Hague revision of the Paris Convention that, in Article 1(1)(2), the phrase “indications of source or appellations of origin” appeared for the first time. In the latest 1967 Stockholm Revision of the Paris Convention, it reads as follows:

Article 1(1)(2) The 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.

which this Agreement applies, or a place situated therein, is directly or indirectly indicated as being **the country or place of origin** shall be seized on importation into any of the said countries"⁷⁹⁷ [emphasis added]. Standards defining the quality of wine production and marking the zone of the Champagne region were further regulated by French laws in the twentieth century, which led to the establishment of the principle of Appellation d'Origine Contrôlée (AOC) and the establishment of the *Institut national de l'origine et de la qualité* (INAO) (which regulates and controls the origin and quality of the Champagne wine to this day).

The opening paragraph of a case brought before the Trademarks Opposition Board of the Canadian Intellectual Property Office (CIPO)⁷⁹⁸ notes that

[t]he *Institut national de l'origine et de la qualité* (INAO) is a French government agency that has for responsibility, ... to define the controlled designations of origin (*appellation d'origine contrôlée* (AOC))...[while] the *Comité interprofessionnel du vin de Champagne* (CIVC) is a French organization ... of the Champagne winemaking region in France and has for mission ... to insure the **recognition and the protection around the world of the Champagne controlled designation of origin** ... including

⁷⁹⁷ *Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods*, (14 April 1891, last revised 31 October 1958) [Madrid Agreement] art 1(1). Article 1 reads:

- (1) All goods bearing a false or deceptive indication by which one of the countries to which this Agreement applies, or a place situated therein, is directly or indirectly indicated as being the country or place of origin shall be seized on importation into any of the said countries.
- (2) Seizure shall also be effected in the country where the false or deceptive **indication of source** has been applied, or into which the goods bearing the false or deceptive indication have been imported.
- (3) If the laws of a country do not permit seizure upon importation, such seizure shall be replaced by prohibition of importation.
- (4) If the laws of a country permit neither seizure upon importation nor prohibition of importation nor seizure within the country, then, until such time as the laws are modified accordingly, those measures shall be replaced by the actions and remedies available in such cases to nationals under the laws of such country.
- (5) In the absence of any special sanctions ensuring the repression of false or deceptive **indications of source**, the sanctions provided by the corresponding provisions of the laws relating to marks or trade names shall be applicable. [emphasis added].

⁷⁹⁸ *Institut national de l'origine et de la qualité and Comité interprofessionnel du vin de Champagne v Sugarfina, Inc.*, 2021 TMOB [Trademarks Opposition Board] 238. [INAO v Sugarfina].

the requirements that these wines meet ... their **geographical origin and conditions of production.**⁷⁹⁹ [emphasis added]

In addition to geography, Gangjee notes a “gradual recognition of human factors”⁸⁰⁰ including recognition that “historic ties serve as an anchor [but] ... the emphasis on human intervention and methods of production implies that tools and techniques can migrate, perhaps with perfect fidelity.”⁸⁰¹

The legal protection of the "appellation of origin" that began in France led eventually to the internationally recognized protection of "geographical indications" at the end of the twentieth century under the TRIPS Agreement.⁸⁰²

Part II of the TRIPS Agreement (Standards Concerning the Availability, Scope and Use of Intellectual Property Rights) contains a discrete section, Section 3 (comprised of articles 22, 23 and 24) dealing with geographical indications.⁸⁰³

Section 3 begins with Article 22: Protection of Geographical Indications. Its first subsection provides the first definition of “geographical indications” in any multilateral international instrument. Article 22(1) reads as follows:

Geographical indications are, for the purposes of this Agreement, indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, **reputation** or other characteristic of the good is essentially attributable to its geographical origin.⁸⁰⁴ [emphasis added]

⁷⁹⁹ *Ibid* at para 1.

⁸⁰⁰ Gangjee, *Relocating the Law...*, *supra* note 793 at 125.

⁸⁰¹ *Ibid*.

⁸⁰² TRIPS Agreement, *supra* note 9.

⁸⁰³ TRIPS Agreement, *supra* note 9, arts 22-24.

⁸⁰⁴ *Ibid*, art 22(1) [emphasis added].

This definition does not impose any legal obligation upon member states. It is Article 23 that requires TRIPS member states to legally regulate protection of geographical indications – and only geographical indications specific to wines and spirits:

[e]ach Member shall provide the legal means ... to prevent use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question ... even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like.⁸⁰⁵

Irene Calboli has noted, however,

TRIPs' inclusion of the word "reputation" in the definition of art.22(1) clearly validated not only the trend of products not entirely made in the GI-denominated regions, but also the **possibility of securing a monopoly on the exploitation of the value of the reputation associated** with GIs on a commercial scale. Not surprisingly, in an increasingly competitive (and less subsidised) marketplace for both agricultural and non-agricultural products, the value of GIs as signifiers of quality, tradition, and, in turn, reputation, can be paramount to securing a large market share against competing products.⁸⁰⁶ [emphasis added]

The subsequent and final article dealing with geographical indications (Article 24) is titled "International Negotiations: Exceptions". Its first paragraph states "[m]embers agree to enter into negotiations to increase the protection of individual geographical indications under Article 23. ...".

⁸⁰⁵ *Ibid.*, art 23.1.

⁸⁰⁶ Irene Calboli, "In Territorio Veritas? Bringing Geographical Coherence into the Ambiguous Definition of Geographical Indications Origin" (2014) 6:1 WIPO Journal 6:1 57 at 67 [emphasis added]. She goes on to note, at 67, however, that "This status quo, however, runs directly against the rationale for GI protection—providing accurate information to consumers about the geographical origin of the products, while offering incentives to local communities to invest in local production."

(b) Beyond wines and spirits

The question of expansion of geographical indications beyond wines and spirits led to one of the longest international negotiations that took place during the formation of the World Trade Organization, a round of negotiations known as the Doha Round.⁸⁰⁷ These negotiations over the expansion of geographical indications were described as an “Old World – New World” contest between the "Old World" countries of Europe, with centuries long traditions (especially in wine making), and the "New World" countries relatively new to wine making, such as Canada, the United States, and Australia but also New Zealand, Argentina, Chile and South Africa.⁸⁰⁸

Some countries, particularly an enthusiastic group of "Old World" countries, insisted any expansion of geographical indications be also regulated to a ‘higher level of protection’ than was already the case with wines and spirits.⁸⁰⁹

The Doha Round⁸¹⁰ did advance the agenda on geographical indications to exploring possibilities for creating an internationally acceptable common approach to

⁸⁰⁷ See *The Doha Round Texts and Related Documents* (Geneva: WTO, 2009), online: https://www.wto.org/english/res_e/booksp_e/doha_round_texts_e.pdf.

⁸⁰⁸ In this research, the “Old World” term generally refers to Europe. It is used in conversation about ‘Old World’ – ‘New World’ contest relevant in making decisions about granting the geographical indications protection domestically and in international negotiations. For example, Europe is a natural adopter of geographical indications because of its long history, while, on the other hand, ‘New World’ countries are relatively new to wine making that has been known for centuries in the countries of the ‘Old World’. The discussion about “Old World” – “New World” has been discussed in Sara Zborovski & Patrick Duke, "Shining a Light on the Protection of Geographic Indications in Canada: The Battle Between GIS and Generic Terms" (2013) 29:2 CIPR 201; also addressed in Loucks, *Trademarks and Geographical Indications*, *supra* note 27; and in Michele Ballagh, "Geographical Indications Versus Trade-Marks: Collective Versus Private Rights?" (2009) 25:1 CIPR 137 at 143.

⁸⁰⁹ World Trade Organization, TRIPS-Geographical Indications: Background and the Current Situation. Extending the “Higher Level of Protection” Beyond Wines and Spirits (2008) online: https://www.wto.org/english/tratop_e/trips_e/gi_background_e.htm.

⁸¹⁰ The Doha Ministerial Declaration adopted 14 November 2001, WT/MIN(01)/DEC/1 in *The Doha Round Texts and Related Documents* (Geneva: WTO, 2009) at para 18, at 27 [Doha Round] Paragraph 18 reads as follows:

regulating various “foodstuff”⁸¹¹ (in addition to the already established protection for selected wines and spirits, predominantly from wine regions across Europe).

Eventually, negotiations focused on creating a multilateral register for the geographical indications for wines and spirits (already protected in the TRIPS Agreement, Article 23) were separated from negotiations with respect to extending the TRIPS Agreement of geographical indications beyond wines and spirits to encompassing food and agricultural products.⁸¹²

The initiative to add required geographical indication protection for food and agricultural products into the TRIPS Agreement came from Europe, the birthplace of “appellation of origin.”⁸¹³ The concept of appellation of origin is analogous in some ways to the concept of geographical indication: international protection of appellations of origin predates protection of geographical indications: the *Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration*, was, as noted

18. With a view to completing the work started in the Council for Trade-Related Aspects of Intellectual Property Rights (Council for TRIPS) on the implementation of Article 23.4, we agree to negotiate the establishment of a multilateral system of notification and registration of geographical indications for wines and spirits by the Fifth Session of the Ministerial Conference. We note that issues related to the extension of the protection of geographical indications provided for in Article 23 to **products other than wines and spirits** will be addressed in the Council for TRIPS pursuant to paragraph 12 of this Declaration, online:

https://www.wto.org/english/res_e/booksp_e/doha_round_texts_e.pdf [emphasis added].

⁸¹¹ The term “foodstuff” appears in EU documents. See e.g., Council Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs.

⁸¹² The Doha Round Texts, *supra* note 807. “Multilateral register for wines and spirits.” (“The work began in 1997 under Article 23.4 of the TRIPS Agreement and now also comes under the Doha Agenda (the Doha Declaration’s paragraph 18)”).

⁸¹³ A term defined in the 1958 Lisbon Agreement, *supra* note 78. There are currently thirty member countries.

in Chapter 1, agreed in 1958 but only entered into force, for its members, in 1983.⁸¹⁴ As noted above in Chapter 1, Canada has never been, and is still not, a member.⁸¹⁵

The enthusiasm from European countries (but also other countries worldwide) in the Doha Round to include in the TRIPS Agreement protection of geographical indications beyond wines and spirits (i.e., for various agricultural products and food) was understandable considering the production of handicrafts and various food and agricultural products where centuries-long renown or renommé was directly associated with the quality or reputation built upon the terroir of their origin. The idea of adding appellations of origin to TRIPS was also supported by several developing and least-developed countries.⁸¹⁶ These countries viewed the expansion of geographical indications as an opportunity, especially for their small food and agricultural producers, to seize a valuable niche in the global market. These countries recognized that expanding the protection of geographical indications beyond wines and spirits (especially in those countries where wine making was not part of traditional culture) could become a powerful instrument in securing a better position in international trade (through

⁸¹⁴ Although Canada is not signatory to the Lisbon Agreement, certain regulatory regimes analogous to the type of protection protected under the Lisbon Agreement have been introduced by Canadian provinces. Protection of ‘appellations’ for wines have been introduced by Ontario under its *Vintners Quality Alliance Act*, 1999, SO 1999, c 3 (see VQA Ontario Appellations of Origin, online: <https://www.vqaontario.ca/Appellations>) and by British Columbia under its Wines of Marked Quality Regulation, BC Reg 168/2018, pursuant to the *Food and Agricultural Products Classification Act*, SBC 2016, c.1. In April 2022, Nova Scotia passed the *Nova Scotia Wine Authority Act*, SNS 2022, c 6. In Québec, on the other hand, an appellation of origin for Québec wines has been secured by obtaining the geographical indication “Vin du Québec”, listed in the Canadian government’s CIPO database (and thus enforceable) as of 1 June 2022.

⁸¹⁵ See text at note 78.

⁸¹⁶ The WTO recognizes as least-developed countries (LDCs) those countries which have been designated as such by the United Nations. There are currently 49 least-developed countries on the UN list, 30 of which to date have become WTO members, online: https://www.wto.org/english/thewto_e/minist_e/minist_e/brief_e/brief03_e.htm > [accessed 20 March 2022]

acceptable and recognizable identification of their unique agricultural and food products), therefore, creating a broader social and political space for them on the world map. In most cases, least-developed countries already have traditional, predominantly agricultural products having a "quality, reputation or other characteristic" attributable to the territory of their origin. On the other hand, many of these least-developed countries lacked adequate domestic regulatory instruments to protect those products even within their own national boundaries. The lack of domestic legal instruments for protecting geographical indications creates a considerable obstacle in preparing these products for competitive global markets.⁸¹⁷

(c) Old World versus New World

At a time when the least-developed countries were recognizing possibilities to access global markets through an accessible, standardized geographical indications registry, WTO member states with advanced economies, such as Canada, had a different view on expanding geographical indications.⁸¹⁸ Regardless of their advanced economies, in terms of geographical indications, the countries of the "New World" could not respond to the "Old World" with reciprocity in terms of a number of products capable of being promoted for geographical indication protection.

⁸¹⁷ Envisioning the importance of the expansion of geographical indications for economic growth, cultural development, and a way to reduce poverty, Uganda, for example, adopted *The Geographical Indications Act* No 8 of 2013, a *sui generis* system for the protection and registration of geographical indications.

⁸¹⁸ See e.g., Michelle Agdomar, "Removing the Greek from Feta and Adding Korbel to Champagne: The Paradox of Geographical Indications in International Law" (2008) 18:2 *Fordham Intell Prop Media & Ent LJ* 541 at 543.

CETA⁸¹⁹ provides an example of the disparity between a “New World” nation, Canada, and the European Union's 28 “Old World” countries⁸²⁰: in Annex 20-A to CETA, the 2017 trade agreement between Canada and European Union, Part A contains a list of 172 products originating in the European Union, while part B, “*Geographical Indications Identifying a Product Originating in Canada*” lists no products at all.⁸²¹

WTO members like Canada, Australia and New Zealand opposed the proposal for broader inclusion of products for inclusion as geographical indications in a revised TRIPS Agreement that are already covered in the original TRIPS Agreement: these countries saw the expansion of geographical indications protection beyond wines and spirits as an administrative burden as well as a limitation on free production, export, and trade.⁸²²

In the production of goods aspiring to geographical indications protection, the balance between human input and a "quality, reputation or other characteristic" originating in the specific geographic region (i.e., strictly tied to the nature-related features of the locality) was another issue for the "New World" countries. Knowledge of

⁸¹⁹ CETA, *supra* note 94.

⁸²⁰ The number of EU member countries is down to 27 since the United Kingdom left the EU in 2020.

⁸²¹ CETA, *supra* note 94, Annex 20-A, Part A-- Geographical Indications Identifying a Product Originating in the European Union; Part B -- Geographical Indications Identifying a Product Originating in Canada, online: <<https://www.international.gc.ca/trade-commerce/trade-agreements-accords-commerciaux/agr-acc/ceta-aecg/text-texte/20-A.aspx?lang=eng#a>> This data reflects the number of products as they were at the time the agreement was signed (in 2017): it is expected that these numbers will change as new products are added to the two lists over time).

⁸²² World Trade Organization, *TRIPS-Geographical Indications: Background and the Current Situation. Extending the "Higher Level of Protection" Beyond Wines and Spirits* (2008) ("They caution that providing enhanced protection would be a burden and would disrupt existing legitimate marketing practices. They also reject the "usurping" accusation, particularly when migrants have taken the methods of making the products and the names with them to their new homes and have been using them in good faith."), online: <https://www.wto.org/english/tratop_e/trips_e/gi_background_e.htm#protection>.

production processes have been transferred from the Old World and recreated in "New World" territories -- but geographical indications will not protect (indeed, will be a barrier to) these products when emanating from the "New World."⁸²³

While protection of geographical indications for wines and spirits was relatively smoothly accepted worldwide through the TRIPS Agreement, global expansion of geographical indication protection beyond wines and spirits has faltered. The lengthy Doha Round of negotiations failed to secure widespread multilateral international agreement on expanded geographical indications. International expansion of categories of protection through geographical indications, at this point, has been limited to bilateral and smaller multilateral free trade agreements between countries.⁸²⁴

Daniel Gervais noted, after geographical indications entered the TRIPS Agreement but in light of the failure of a further attempt to enhance multilateral geographical indication protection during negotiations for the Lisbon Agreement⁸²⁵, that

Reputation could be considered at first glance as a soft, subjective criterion. However, it can be measured. Reputation is the result of years of work in association with a product that has created a mental link between that product and its geographical origin, but reputation is also a cause that can be measured by its effects. For example, consumer surveys, price differentials attributable to the perceived advantage of the product because of its origin, etc. The other criteria mentioned in TRIPS Article 22.1 are "harder" and perhaps easier to prove, namely the quality and (other) characteristics of the product itself. But even "quality" may be defined in a number of ways according to a consumer's priorities. In the same vein, at least the selection of which (other) characteristics are relevant may be subject to the same criticism. In other words, while all the criteria mentioned in Article 22 are potentially partially "subjective," they can be considered by way of rational demonstration and comparative

⁸²³ Irene Calboli, "In Territorio Veritas? Bringing Geographical Coherence into the Ambiguous Definition of Geographical Indications Origin" (2014) 6:1 WIPO Journal 57 at 59-60.

⁸²⁴ See, for example, the *Canada-Korea* FTA, art 16.10.

⁸²⁵ *Supra* note 78.

analysis. Presumably, if potential buyers of a product want it because of a quality or characteristic associated with it stem from its geographical origin (whether the cause is human or natural factors or a combination of both), then that product could be said to have a given reputation. The difference in treatment of reputation between Lisbon and TRIPS would then not be *functionally* different. [emphasis in original]⁸²⁶

B - Reputation in geographical indications in Canadian law

(a) In the *Trademarks Act*

In the light of its obligations arising from the TRIPS Agreement, Canada, in 1996, amended its *Trade-marks Act* definition section (Section 2), to include, for the first time, a definition of "geographical indications". That definition read as follows:

geographical indication means, **in respect of a wine or spirit**, an indication that

(a) identifies the wine or spirit as originating in the territory of a WTO Member, or a region or locality of that territory, where a **quality, reputation or other characteristic** of the wine or spirit is essentially attributable to its geographical origin, and

(b) except in the case of an indication identifying a wine or spirit originating in Canada, is protected by the laws applicable to that WTO Member. [emphasis added]⁸²⁷

In the same amendment, the term "reputation" was added as part of new section

11.12(3)(e) of the *Trade-marks Act*:

(3) For the purpose of subsection (2), the statement by the Minister must set out all of the following information in respect of an indication:

⁸²⁶ Daniel Gervais, "The Lisbon Agreement's Misunderstood Potential" (2009) 22:1 IPJ 57 at 61 [emphasis in original].

⁸²⁷ *Trade-marks Act*, *supra* note 22, s 2 (1996-2012). The current text of this definition in s 2 is set out below in the text a footnote 828.

(e) the quality, **reputation** or other characteristic of the wine or spirit that, in the opinion of the Minister, qualifies that indication as a geographical indication. [emphasis added]⁸²⁸

While global multilateral international negotiations have failed since the TRIPS Agreement to extend standards respecting geographical indications beyond those for wines and spirits, the failure of those negotiations has not prevented WTO members from entering into bilateral and multilateral agreements in which geographical indications respecting food and other agricultural products have been agreed. The first step in this direction for Canada was the 2014 *Canada-Korea Free Trade Agreement*,⁸²⁹ followed by CETA⁸³⁰.

In the Canada-Korea FTA, the term "reputation" appears only in the definition of geographical indications (the text of that definition is almost identical to the definition of geographical indications in the TRIPS Agreement).⁸³¹ Article 16.10 of the Canada-Korea FTA articulates further legal obligations regarding geographical indications for the parties. It reads as follows:

1. Canada shall, with respect to the geographical indications of "GoryeoHongsam", "GoryeoBaeksam", "GoryeoSusam", and "IcheonSsal" and their translations, respectively, "Korean Red Ginseng", "Korean White Ginseng", "Korean Fresh Ginseng" and "Icheon Rice", **provide the legal means** for interested parties to prevent

⁸²⁸ *Trade-marks Act*, *supra* note 22.

⁸²⁹ Canada-Korea FTA, *supra* note 93, art 16.10 "Protection of Geographical Indications".

⁸³⁰ *Supra* note 93.

⁸³¹ Canada-Korea FTA, *supra* note 93, art 16.10 Footnote 3: Geographical indications are, for the purposes of this Article, indications which identify a good as originating in the territory of a Party, or a region or locality in that territory, where a given quality, **reputation** or other characteristic of the good is essentially attributable to its geographical origin." [emphasis added].

- (a) the use of any means in the designation or originates in a geographical area other than the true place of origin in a manner that misleads the public as to the geographical origin of the good;
 - (b) the use of any of these geographical indications for ginseng or rice, as the case may be, that does not originate in the place indicated by the geographical indication in question, even where the true origin of the relevant good is indicated or the geographical indication is used in translation or transcription or accompanied by expressions such as “kind”, “type”, “style”, “imitation” or the like; and
 - (c) any other use that constitutes an act of unfair competition within the meaning of Article 10*bis* of the Paris Convention.
2. Korea shall, with respect to the geographical indications of “Canadian Whisky” and “Canadian Rye Whisky”, **provide the legal means** for interested parties to prevent
- (a) the use of any means in the designation or originates in a geographical area other than the true place of origin in a manner that misleads the public as to the geographical origin of the good;
 - (b) the use of any of these geographical indications for ginseng or rice, as the case may be, that does not originate in the place indicated by the geographical indication in question, even where the true origin of the relevant good is indicated or the geographical indication is used in translation or transcription or accompanied by expressions such as “kind”, “type”, “style”, “imitation” or the like; and
 - (c) any other use that constitutes an act of unfair competition within the meaning of Article 10*bis* of the Paris Convention.
- [footnotes omitted] [emphasis added] ⁸³²

As a result of Canada-Korea FTA and CETA, Canada amended its *Trade-marks Act* provisions respecting geographical indications. The definition of ‘geographical indication’ was changed to the current definition:

⁸³² Canada-Korea FTA, *supra* note 93, art 16.10.

geographical indication means an indication that identifies a wine or spirit, **or an agricultural product or food of a category set out in the schedule**, as originating in the territory of a WTO Member, or a region or locality of that territory, if a quality, reputation or other characteristic of the wine or spirit **or the agricultural product or food** is essentially attributable to its geographical origin [emphasis added]⁸³³

This definition incorporates any "agricultural product or food of a category set out in the schedule."⁸³⁴ The schedule currently consists of a list of 24 categories of food and agricultural products.⁸³⁵

Section 11.12(3)(e) of the *Trade-marks Act*, quoted above as containing the term "reputation", was amended, in light of the Canada-Korea FTA, to reflect the inclusion of agricultural products and food. It now reads as follows:

(e) the quality, reputation or other characteristic of the wine or spirit **or the agricultural product or food** that, in the Minister's opinion, qualifies that indication as a geographical indication [emphasis added]

As set out in the Canada-Korea FTA, Canada was required to protect a number of Korean food products: a list was added in 2017 to the *Trade-marks Act* at s 11.23.⁸³⁶

⁸³³ *Trade-marks Act*, *supra* note 22, s 2.

⁸³⁴ *Ibid*, Schedule, online: <https://laws-lois.justice.gc.ca/eng/acts/t-13/>.

⁸³⁵ See online: <https://laws-lois.justice.gc.ca/eng/acts/t-13/>.

⁸³⁶ Trademarks Act, *supra* note 22, s 11.23 (added by SC 2017, c 6, s 67):

Canada — Korea indications

Paragraphs 11.18(2)(a) and (c) and section 11.21 do not apply with respect to an indication that is a protected geographical indication and that is included in the following list:

- (a) GoryeoHongsam;
- (b) GoryeoBaeksam;
- (c) GoryeoSusam;
- (d) IcheonSsal;
- (e) ginseng rouge de Corée;
- (f) ginseng blanc de Corée;
- (g) ginseng frais de Corée;
- (h) riz Icheon;
- (i) Korean Red Ginseng;
- (j) Korean White Ginseng;

After Canada signed the Comprehensive Economic Agreement between the European Union and Canada in 2016 (an agreement which entered into force in 2017),⁸³⁷ in addition to the list of 24 agricultural products and food categories already added to its trademark statute following an earlier Canada-Korea Free Trade Agreement, Canada added 172 specific geographical indications identifying various categories of agricultural products and food originating in the countries of European Union.⁸³⁸ The applicable provision of the Canadian *Trademarks Act* (s 11.22) now states, however, that the list of wines, spirits, agricultural products or foods from Korea whose geographical indications are to be protected in Canada can be "amended from time to time."⁸³⁹

In CETA Chapter 20 Intellectual Property, Sub-section C – Geographical Indications, Article 20.16 – Definitions, it is provided that

For the purposes of this Sub-section:

geographical indication means an indication which identifies an agricultural product or foodstuff as originating in the territory of a Party, or a region or locality in that territory, where a given quality, **reputation** or other characteristic of the product is essentially attributable to its geographical origin; and product class means a product class listed in Annex 20-C [emphasis added].⁸⁴⁰

-
- (k) Korean Fresh Ginseng;
 - (l) Icheon Rice.

⁸³⁷ See again CETA, *supra* note 94, Annex 20-A, Part A- Geographical Indications Identifying a Product Originating in the European Union; Part B - Geographical Indications Identifying a Product Originating in Canada, online: <<https://www.international.gc.ca/trade-commerce/trade-agreements-accords-commerciaux/agr-acc/ceta-aecg/text-texte/20-A.aspx?lang=eng#a>>

⁸³⁸ See *Trade-marks Act*, *supra* note 22, Schedule 6. As noted by Ed White (“‘Geographical indications’ can have mixed results” <https://www.producer.com/markets/geographical-indications-can-have-mixed-results/>, May 27, 2021), “In the Canada-EU CETA deal, Canada accepted GIs for many European-based foods, although it won an exception for existing Canadian feta cheese makers.”

⁸³⁹ *Ibid*, s 11.22.

⁸⁴⁰ CETA, *supra* note 94, Chapter 20: Intellectual property, Sub-section C -Geographical Indications, art 20.16.

When Canada became a member of the Comprehensive and Progressive Agreement for Trans-Pacific Partnership (CPTPP), which came into effect 30 December 2018 and now comprises Australia, Brunei, Canada, Chile, Japan, Malaysia, Mexico, New Zealand, Peru, Singapore, and Vietnam, it took on, amongst many other things, an obligation relating to geographical indications that, again, expressly links geographical indications to reputation:

Chapter 18 – Intellectual Property
Section A: General Provisions

...

Article 18.1: Definitions

...

geographical indication means an indication that identifies a good as originating in the territory of a Party, or a region or locality in that territory, where a given quality, **reputation** or other characteristic of the good is essentially attributable to its geographical origin;⁸⁴¹

Canada, Mexico and the United States have entered into CUSMA,⁸⁴² which includes “TRIPS-plus”⁸⁴³ provisions for geographical indications, including, in Section A: General Provisions:

Article 20.1 Definitions

1. For the purposes of this Chapter: **geographical indication** means an indication that identifies a good as originating in the territory of a Party, or a region or locality in that territory, where a given quality, **reputation**, or other characteristic of the good is essentially attributable to its geographical origin [emphasis added]⁸⁴⁴

⁸⁴¹ Consolidated TPP Text -- Chapter 18- Intellectual Property, online: <https://www.international.gc.ca/trade-commerce/trade-agreements-accords-commerciaux/agr-acc/tpp-tp/text-texte/18.aspx?lang=eng>.

⁸⁴² *Supra* note 102.

⁸⁴³ “TRIPS-Plus” is an informal term for protection of intellectual property rights that goes beyond the requirements in the TRIPS Agreement.

⁸⁴⁴ *Canada - United States - Mexico Agreement* (CUSMA) 2020, Chapter 20 - Intellectual Property Rights - Section A: General Provisions, art 20.1: Definitions

When the United Kingdom left the European Union at the start of 2020, Canada and the UK agreed by December 2020 to the *Canada-United Kingdom Trade Continuity Agreement*, which entered into force on 1 April 2021.⁸⁴⁵ This Canada-UK agreement incorporated the text of CETA and did not make any substantive changes to the provisions already instantiated in the CETA.

None of these trade agreements to which Canada has become signatory since TRIPS⁸⁴⁶ have required Canada to make any changes to its *Trademarks Act* that have had any impact regarding the concept of reputation as already expressed in Canada's geographical indications law.

(b) Protection of geographical indications

Canada protects geographical indications by applying numerous provisions of its *Trademarks Act*. For example, section 11.12 empowers the Registrar to supervise the list of geographical indications. It reads as follows:

11.12 (1) There shall be kept under the supervision of the Registrar a list of geographical indications and, in the case of geographical indications identifying an agricultural product or food, translations of those indications.⁸⁴⁷

The prohibition against adopting geographical indications for wine and spirits "in connection with a business, as a trademark or otherwise" is set out in section 11.14, and

⁸⁴⁵ Canada - UK Trade Continuity Agreement (Canada - UK TCA) <https://www.international.gc.ca/trade-commerce/trade-agreements-accords-commerciaux/agr-acc/cuktca-accru/agreement_trade_continuity-accord_continuite_commerciale.aspx?lang=eng>

⁸⁴⁶ In addition to the Canada-Korea FTA, *supra* note 93, and CETA, discussed above, Canada has also entered into the *Canada - United States - Mexico Agreement (CUSMA)*, which entered into force 1 July 2020, and the *Comprehensive and Progressive Agreement for Trans-Pacific Partnership (CPTPP)*, entered into force 30 December 2018.

⁸⁴⁷ *Trademarks Act*, *supra* note 22, s 11.12.

the prohibition against adopting geographical indications for agricultural products and food as trademarks is in section 11.15 of the *Trademarks Act*.⁸⁴⁸

The Canadian Intellectual Property Office (CIPO) is the government body that processes a request⁸⁴⁹ that a geographical indication be entered on Canada's list of geographical indications.⁸⁵⁰ Tesh Dagne indicated in 2016 that

[i]n Canada, there [had] not been significant initiative to use GIs as instruments of marketing regional identity in agricultural production. In recent years, however, the province of Québec has become a leader in the use of GIs after it launched the *produits du terroir* initiative.⁸⁵¹

On the CIPO website, a current search of the Canadian Trademarks Database for the category "geographical indications" retrieved 867 entries (data current as of 23 March 2022.) Geographical indications for wines and spirits and agricultural and food products were amongst those retrieved. A few entries were found to have "removed" status notifications and others were in the process of "advertising". The full list of Canadian geographical indications on Canada's list of recognized geographical indications has only twenty-seven entries on it.⁸⁵²

⁸⁴⁸ *Trademarks Act*, *supra* note 22, ss 11.14, 11.15.

⁸⁴⁹ Process to register a geographical indication is found on the CIPO website: <<https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr04244.html>>.

⁸⁵⁰ For the list of geographical indications see online: <<https://www.ic.gc.ca/cipo/listgiws.nsf/gimenu-eng?readForm>>.

⁸⁵¹ Tesh W Dagne, "The Narrowing Transatlantic Divide: Geographical Indications in Canada's Trade Agreements" (2016) 10 *European Review of Intellectual Property Law* 598 at 609.

⁸⁵² This list is the full list of geographical indications recognized in Canada – with the option to select the list of Canada's geographical indications, online: <<https://www.ic.gc.ca/cipo/listgiws.nsf/gimenu-eng?readform&sort=region&order=CA>>.

(c) Geographical indications in Canadian case law

Considering that geographical indications entered the Canadian intellectual property legal environment relatively recently (first only for wines and spirits (following the 1995 TRIPS Agreement), and even more recently following the 2014 *Canada-Korea Free Trade Agreement* and the 2017 *Comprehensive Economic and Trade Agreement* between Canada and the European Union), it may be understandable that litigated disputes involving geographical indications appear to be scarce.⁸⁵³

To register a geographical indication requires a "responsible authority" to apply for registration directly to the Canadian Intellectual Property Office, which then rigorously examines the application. It is not known how many details contained in those applications are evidence of "reputation," mainly because the definition in the *Trademarks Act* reads "if a **quality, reputation or other characteristic** of the wine or spirit or the agricultural product or food is essentially attributable to its geographical origin" [emphasis added].⁸⁵⁴ Because the requirement for registration is not simply for "reputation" but is for "reputation or other characteristic", it is not possible to isolate

⁸⁵³ Nonetheless, Renata Watkin, writing in the *Intellectual Property Journal* in 2018, proffers an interesting constitutional argument based on the concept of "reputation" that is inherent in the protection of geographical indications:

These constitutional issues permeate the process of identification and establishment of GIs. The assessment of the "essentially attributable characteristics" of origin-specific products seems to fall under provincial jurisdiction. Assessing reputation would arguably involve concurrent or overlapping federal-provincial jurisdiction as both federal trademark law and the common law tort of passing off protect reputation. Where a product's renown is linked to a production method, the determination as to whether the method itself is distinctive is a matter of exclusive provincial jurisdiction.

See Renata Watkin, "Placing Canadian Geographical Indications on the Map" (2018) 30:2 IPJ 271 at 284.

⁸⁵⁴ *Trademarks Act*, *supra* note 22, s 2, "geographical indication"

those applications which dealt with reputation from those that dealt with other characteristics.

There appears to be little litigation concerning the prohibitions for the use of geographical indications legislated in the *Trademarks Act* (sections 11.14 and 11.15).

There are, however, cases in which Canadian courts have denied trademark registration to an applicant because the applicant was attempting to register (as a trademark, not a geographical indication), a mark that included a protected geographical indication. The case regarding the use of the term Champagne, *Institut national de l'origine et de la qualité and Comité interprofessionnel du vin de Champagne v Sugarfina, Inc.*,⁸⁵⁵ mentioned at the very beginning of this chapter, is such a case:

[22] The Opponent submits that the Mark is clearly descriptive, in English, of the character and/or quality of the applied-for goods because it clearly describes bear-shaped candies that contain Champagne wine. In this respect, the Opponent essentially argues that:

- Champagne wine has a considerable, if not legendary, **reputation** which extends to comestible products and so even when the word CHAMPAGNE is used in the context of such products including those covered by the application for the Mark, Canadian consumers would be aware that it is indicative of a specific wine, with specific features, from a specific geographical area, produced according to specific standards;
- The word BEAR(S) is descriptive of a mammal with a specific silhouette and when it is used in association with candies (including gummy candies), the word
- The Applicant's goods used in association with the Mark are in fact bear-shaped candies ("gummy bears") having Champagne wine as one of their ingredients.

...

Conclusion as to non-registrability

⁸⁵⁵ *Supra* note 798.

[33] The Opponent has filed evidence showing that Champagne is a controlled designation of origin (AOC) and a recently registered geographical indication covering “wine”. It has also provided some evidence of the fame of the alcoholic beverage Champagne. Hearsay and deficiencies aside, I am satisfied that a fair review of the whole of the Opponent’s evidence establishes that the average Canadian consumer would be familiar with the word “champagne” being used in respect of wine and would likely associate it to a sparkling wine from the wine-making region of Champagne in France.

[34] That said, I am far from convinced that whatever **reputation** the Opponent has established for Champagne wine in any way extends to food products. Similarly, I cannot subscribe to the Applicant’s contention that the evidence properly establishes the “commonness of the word ‘champagne’ on third party food products”. Besides, depending on the context, the word “champagne” nevertheless is and can be used descriptively in association with same. In fact, from the limited instances where the context of the third party uses of this term can be inferred from the evidence, I note that it mostly appears in a clearly descriptive sense to identify a food product’s component, rather than as some kind of color or laudatory reference. I will shortly come back to this point. [emphasis added]⁸⁵⁶

C - Conclusions From This Chapter

This chapter has demonstrated that reputation is involved in the concept of geographical indications. It also establishes, though the case law on geographical indications in Canada is very limited, that the concept of reputation as it is used in defamation cases (discussed earlier in Chapter 3) is not related to the concept of reputation as it is involved in litigation about geographical indications.

Melissa Loucks has pointed out, in *Trademarks and Geographical Indications: Conflict or Co-existence?*, that geographical indications and trademarks “do not engage the interests of the same types of parties nor accomplish the same business goals.”⁸⁵⁷ This

⁸⁵⁶ *Ibid* at para 34 [emphasis added].

⁸⁵⁷ Loucks, *Trademarks and Geographical Indications*, *supra* note 27 at 119.

thesis confirms the strict connection that a geographical indication must have with a specific locality, a connection which separates the concept of geographical indication from the concept of trademark: a trademark is a symbol that can theoretically become identified with any good or service a proprietor chooses. The goals sought to be achieved by trademark protection and geographical indication protection also differ: a geographical indication application is required to have evidence of reputation (for quality or other characteristics) *before* a geographical indication can be registered whereas a trademark can be first registered and then, afterward, acquire reputation.

The term 'geographical indication' has a statutory definition, in the definition section of the *Trademarks Act*: this distinguishes geographical indications from both moral rights (although the term 'moral right' appears in the definition section of the *Copyright Act*, Chapter 4 shows that it is not actually a definition of moral rights rather a reference to moral rights sections in the Act) and prohibited marks (of which, as established in Chapter 5, there exists no statutory definition). The definition of geographical indication in the *Trademarks Act* is particularly important to this research because it establishes clearly, in its inclusion of the term "reputation", the importance of reputation to geographical indications.

In Chapter 4, this research established that, though both authors and performers are involved with moral rights and copyright, moral rights and copyright differ completely in the goals sought to be achieved. It is the moral rights which protect reputation (and are not alienable). Similarly, in Chapter 5, this research established that prohibited marks and trademark differ completely in the types of parties involved and the goals sought to be achieved. Prohibited marks are inalienable and statutorily protected

from being used in connection with trademarks because of the reputations of the entities involved, whereas trademarks (which, unlike prohibited marks, are alienable) are legally protected precisely in order to allow them to develop commercial value from any reputation in the marketplace they can develop in connection with goods and services. In this chapter, Chapter 6, it has been established that reputation is a foundational aspect of protecting geographical indications.

The reputation involved with moral rights must be proven when asserting the moral rights in court. The reputation involved with prohibited marks has been protected by Parliament through inclusion in s 9 of the current *Trademarks Act* (as a mark which cannot be used as a trademark). The interest protected by geographical indication protection, as described in this Chapter 6, is the ongoing reputation arising from connection to a given geography (and can involve physical, historical and social aspects of geography).

CHAPTER 7: CONCLUSION

This thesis began by asking the following overall question:

- Does the concept of ‘reputation’ form a unique link bringing the concepts of moral rights, prohibited marks and geographical indications uniquely together?

The answer to this question, established through this research, is ‘yes.’

From this overarching question, three specific questions emerged:

1. Is the concept of reputation involved in each of the moral rights, prohibited marks and geographical indications?
2. Can the concept of reputation in defamation law contribute to an understanding of the concept of reputation involved in moral rights, prohibited marks and geographical indications?
3. Does the concept of reputation distinguish the moral rights, prohibited marks and geographical indications from the classic triad in intellectual property (copyright, patent and trademark)?

With respect to the **first specific question**, this research has established that yes, indeed, the concept of ‘reputation’ forms a unique link between the moral rights, prohibited marks and geographical indications which, in turn, uniquely identifies this group of devices as a set.

While it may have been thought that the moral rights, because of their association with authors and performers, were associated with people (in the same way that reputation in defamation can be associated with individuals), moral rights *only* arise in connection with works and performances, not directly with individuals. This is most

clearly evidenced from the fact that the moral rights can outlast the lifetimes of their authors and performers.

From this perspective, the “reputation” protected in the moral rights is not dissimilar to the reputation involved in the prohibited marks, where the reputation accrues to institutions, organizations, and nations -- and to individuals, but only to individuals by virtue of their positions (and where individuals are protected by prohibited marks, in the cases of both moral rights and prohibited marks is the *position* that is protected: when the current individual protected by a prohibited mark leaves the role, the positions do not end and will be filled by other individuals, who will then be protected in the role; an individual has the benefit of moral rights protection only in the role of author or performer, not in a personal capacity).

The reputation earned by businesses seeking the protection of geographical indications is, like the reputations involved in the moral rights and the prohibited marks, also inevitably a direct result of the efforts of the people involved (sometimes over generations) with the products seeking geographical indications status, but, as in the cases of both the moral rights and the prohibited marks, it is not the people directly that gain the protection of geographical indications: it is the symbols of the origin of the goods or services that gain geographical indications protection -- and then the goods and services draw upon reputation through the association of the goods or services with the geographical indication.

It is the connection between reputation and identity (reputation and works in the case of the moral rights; reputation for protected positions and institutions in the case of

prohibited marks; and reputations for identified products and services in the case of the geographical indications) that, this thesis establishes, links moral rights, prohibited marks and geographical indications together.

This thesis demonstrates that the connection with reputation in each of the cases of moral rights, prohibited marks and geographical indications occurred at a different point in the life cycle of the device of moral right, a prohibited mark, and a geographical indication (as described in Chapters 4, 5 and 6), reputation (as ‘esteem’) has been demonstrated to be critical to all three (moral rights, prohibited marks and geographical indications).

For prohibited marks Parliament recognizes the reputational interest involved and legislates the protection of the mark. On the other hand, for geographical indications Parliament has legislated categories of products which may claim geographical indications protection, but a producer must apply through an administrative process to get geographical indication protection for any particular product. By contrast with prohibited marks and geographical indications Parliament has legislated reputation into the moral rights protection for authors and performers under the Copyright Act. Every author and performer is entitled to the protection of their reputation but should any difficulty arise, it is up to the author or performer to take recourse through an infringement action. Therefore, all three have shared interests in the concept of reputation, a person protected under prohibited marks, a person seeking geographical indication and an author or performer enjoying moral rights protection will become engaged with reputation at different stages. Nonetheless, in all three cases the meaning of reputation is the same: a question of the esteem in which the person protected by prohibited marks is held, the

esteem in which the geographical indication is held and the esteem in which an author or performer is held.

All of the people and institutions protected by Canada's prohibited marks legislation⁸⁵⁸ are protected going forward (after being included in the prohibited marks section of the *Trademarks Act*) from having use of their identities occur as trademarks in connection with commercial enterprises, thus protecting their reputations. It is not surprising, then, that, in the relatively small number of decisions that have resulted in Canada from litigation over prohibited marks, reputation has not been an issue: reputation has been a given in the litigation since it is brought under the current section 9 of the *Trademarks Act*, which, as noted above, has predetermined that the protected person or institution has a reputation worthy of protection.

As demonstrated in chapter 6, reputation is a core concept in geographical indications: there is no registration of a geographical indication without evidence proving reputation being presented to the registering authority. In Canada, in including an indication on the list of protected geographical indications in Canada under section 11.12, the required statement of the Minister must include information including

- (e) the quality, **reputation** or other characteristic of the wine or spirit or the agricultural product or food that, in the Minister's opinion, qualifies that indication as a geographical indication [emphasis added].

⁸⁵⁸ There is no criminal provision in Canadian law that relates to protection of prohibited marks.

As noted in Chapter 6, the current list of geographical indications in Canada is extensive,⁸⁵⁹ of which, as reported in Chapter 6, twenty-seven are listed for use with Canadian products.⁸⁶⁰

Even though, as noted in Chapter 6, there has not been much litigation involving geographical indications in Canada, it is clear from the legislation that an applicant can provide evidence of reputation sufficient to support the awarding of geographical indication protection in order to satisfy the federal Minister during the application process and thus get a geographical indication added to the list. As described in Chapter 6, what litigation involving geographical indications has been reported in Canada demonstrates that discussion of reputation in the judgments is common.

With respect to the **second specific question**, about defamation law, this thesis has found that the concept of reputation in defamation law cannot make any contribution. The theoretical writing on reputation in defamation (explored in Chapter 2) cannot be related to the role of reputation revealed in this research in connection with moral rights, prohibited marks or geographical indications protection. The exploration of Canadian defamation jurisprudence (in Chapter 3) has demonstrated, first, that the presence of juries in Canadian defamation trials – and their unique role with respect to making findings about reputation in defamation cases – makes analysis of how reputation is determined in Canadian defamation in jury cases impossible because jury deliberations are required to remain strictly confidential to the jury in each case. The comments about

⁸⁵⁹ <<https://www.ic.gc.ca/cipo/listgiws.nsf/gimenu-eng?readForm>>. Note that the website itself appears to indicate that this current list has been static since June 14, 2019.

⁸⁶⁰ <<https://www.ic.gc.ca/cipo/listgiws.nsf/gimenu-eng?readform&sort=region&order=CA>>.

reputation made by judges at any level where a jury has been involved at trial must and (as is seen in the discussion in Chapter 3) do remain wholly speculative and general. However, in addition to demonstrating that there can be no evidence of the effect of reputation in defamation cases tried by juries, this research has also established that, even where judges sit alone (the less common occurrence in Canadian defamation litigation), judges are not explicit in their judgments about their own factual findings about reputation. Judges sitting alone have spoken speculatively and in general about reputation in their reasons, just as judges were found to do in cases where juries were involved and the role of deciding questions of reputation did not lie with the judges.

Substantively, this research has confirmed that there is a considerable body of theoretical writing associated with defamation law – and, indeed, theoretical exploration of the concept of reputation in defamation. In particular, a theoretical construct about reputation as involving notions of property, honour and dignity as aspects of reputation in defamation has gained considerable currency: an exploration initiated by American scholar Robert C. Post⁸⁶¹. This theoretical “school” was explored in this thesis, in Chapter 2, in terms of both its expression by Canadian authors and the extent to which it has been applied in the Canadian context.

⁸⁶¹ Post, *supra* note 165.

In Chapter 2, the works of four authors connected to Canada were amongst those explored: Bob Tarantino,⁸⁶² Chris D.L. Hunt,⁸⁶³ Katie Duke⁸⁶⁴ and Megan Richardson.⁸⁶⁵ As discussed in Chapter 2, Megan Richardson's piece contains no reference to Canadian jurisprudence. The articles published by Hunt and Duke make almost no reference to Canadian jurisprudence.⁸⁶⁶

Only Canadian Bob Tarantino, in the entire body of work discussing Post's ideas, cites much from Canadian civil defamation decisions.⁸⁶⁷ In his piece, Tarantino cited to six of the ten Canadian judgments analyzed in Chapter 3 of this thesis: the civil cases *Vander Zalm v Times* (1979), *Simpson v WIC Radio* (2004), *Hill v Church of Scientology* (1992), *Grant v Torstar* (2008), and *Quan v Casson* (2007), and the criminal decision in *R v Lucas* (1998).⁸⁶⁸ Tarantino comments, in discussing the Supreme Court's decision in *Hill v Scientology*

The SCC framed its reasoning in *Hill* as a determination of whether the common law of defamation had struck an appropriate balance between

⁸⁶² Tarantino, *supra* note 236.

⁸⁶³ Hunt, *supra* note 246.

⁸⁶⁴ Katie Duke, *supra* note 248.

⁸⁶⁵ Megan Richardson, *supra* note 254. Megan Richardson is included in these comments because she published this article in a Canadian journal: the *Canadian Journal of Comparative and Contemporary Law* is published by the Faculty of Law of the University of Thompson Rivers. Richardson, herself, may not have any other connection with Canada.

⁸⁶⁶ For instance, in his article Hunt, *supra* note 246, refers once to *Hill v Church of Scientology* (1995); Katie Duke, *supra* note 248, refers once to *Simpson v WIC Radio* (2008), twice, at 76 and 77, to *Hill v Church of Scientology* (1995), and once, at 75, to *Grant v Torstar* (2009).

⁸⁶⁷ In the latter portion of his article, Tarantino, *supra* note 236, embarks on a project to describe a defamation tort for public figures (at 621-638) also citing to Canadian jurisprudence.

⁸⁶⁸ Tarantino, *supra* note 236, did not include in his discussion either the early case of *Currie v Preston and Wilson*, [1928] or the relatively historic case of *Lefolli et al. v Gouzenko*, [1969] SCR 3. In addition, because his article published in 2010 predates the Supreme Court of Canada judgment in the matter, Tarantino did not discuss *Crookes v Newton*, 2011 SCC 47, [2011] 3 SCR 269. While Tarantino did discuss the criminal case of *R v Lucas* (1998) nine times (at 596, 598, 599, 602, 603, 611, 614, 621), he did not discuss the earlier criminal case *R v Stevens* (either at trial (1993, *supra* note 110), or on appeal (1995, *supra* note 528)).

values of reputation and freedom of expression... **For all that rhetorical flight, what actually constitutes a reputation was left unexplained** [emphasis added], though there are indications that the SCC conceived of reputation as an instrumental good – it serves the “fundamentally important purpose of fostering our self-image and sense of self-worth,” and it is the “fundamental foundation on which people are able to interact with each other in social environments. [emphasis added]⁸⁶⁹

This finding of Tarantino’s -- that, in *Hill v Scientology*, “what actually constitutes a reputation was left unexplained” --- echoes exactly this author’s analysis of the case in Chapter 3.

In discussing *Vander Zalm*, and *WIC Radio* Tarantino notes “[i]n short the reputation of an individual is what is protected by the tort [of defamation]”,⁸⁷⁰ and continues “however, as noted by the SCC in *Hill*, very little has been written by the courts about that central concept and its constitutive elements.”⁸⁷¹ This may explain why, as discussed in Chapter 3 of this present study, none of these three cases (*Vander Zalm*, *WIC Radio* or *Hill*) was found to deal directly with the concept of reputation in the judgments.

The theoretical literature discussed in Chapter 2 (written by Canadians or others) has not been cited in any of the Canadian decisions examined in this thesis.

One reason for the lack of connection found between theories of reputation in defamation law and the jurisprudence of defamation in Canadian law may well be the existence of juries in civil and criminal defamation matters in Canada. As has been

⁸⁶⁹ Tarantino, *supra* note 236 at 600-601 [footnotes omitted].

⁸⁷⁰ *Ibid* at 612 [footnotes omitted].

⁸⁷¹ *Ibid* at 612, giving no pinpoint reference to *Hill*.

demonstrated in Chapter 3, civil defamation actions are, across Canada, amongst the very few remaining civil causes of action that can be tried by a judge and jury, as opposed to being tried by judge alone. The ability to be tried by judge and jury, rather than by judge alone, as also explained in Chapter 3, also exists for cases of criminal libel. As has been described in Chapter 3, where there is a jury, the jury decides all matters of fact – and jury deliberations, across Canada, are, by law, confidential to the jury: not even the presiding judge is privy to them. This means that no evidence of the interpretation of reputation where a jury was involved was available to this researcher for examination – and, of course, nor would it be available to scholars working on theories of reputation in defamation.

Recall, from Chapter 3, that the extensive history of the Currie trial presented by Robert Sharpe, included a quotation from the trial which detailed evidence of reputation that was entered at trial – but, as it was a jury trial, no one can say whether the jury took this evidence into account in finding for former General Currie or, if they did take it into account, what weight they may have given to it:

Q Do you know General Currie?

A I do, sir.

Q Do you know his **reputation**?

A I do.

Q As a military man?

A I do.

Q What is it?

A Well, I should say that any man that could have a military reputation such as General Currie would be envied. [emphasis added]⁸⁷²

⁸⁷² Sharpe, *supra* note 374 at 212-213 [emphasis added].

There were trials involved in the review of Canadian defamation cases presented in Chapter 3 of this thesis in which no juries were involved. Theoretically, it would have been possible in these cases to find, in the trial judge's judgment, findings made with respect to the plaintiff's reputation and to see, in them, connections made by the judge to the evidence before him or her. As discussed in Chapter 3, in one of the two instances of civil litigation examined in which a jury was not involved, *Vander Zalm v Times Publishers*, the judgment of Justice Monroe at trial does not discuss the precise evidence before him that led to his finding that the plaintiff had a protectable reputation.⁸⁷³ In the other, *Simpson v Mair and WIC Radio Ltd.*, Madam Justice Koeningsberg found (as set out in Chapter 3) that the plaintiff Simpson

had a significant public profile before the alleged defamation ... [and that] ... she had a public reputation as a leader of those opposed to schools teaching acceptance of a gay lifestyle. Simpson's reputation was earned as a result of her very public actions and words.⁸⁷⁴

Although reputation in defamation has been frequently pointed to as a touchstone for interpretation of reputation generally, this thesis has established that reputation in defamation could not serve that role in interpretation of reputation in the context of moral rights, prohibited marks or geographical indications.

Finally, this thesis establishes that the concept of reputation, in the sense of 'esteem', not only distinguishes the moral rights, prohibited marks and geographical indications from the classic triad in intellectual property (copyright, patent and trademark), but also sets the moral rights, prohibited marks and geographical indications

⁸⁷³ See *Vander Zalm v Times Publishers*, (1979), 96 DLR (3d) 172

⁸⁷⁴ *Simpson v Mair and WIC Radio Ltd.*, 2004 BCSC 754 at para 10

uniquely apart as a group. While there are matters of reputation involved in trademark law, the reputation involved in that area of classic intellectual property is reputation in a sense different from the sense of reputation as esteem that unites the concepts of moral rights, prohibited marks and geographical indications.

This thesis demonstrated that reputation in trademark law, as discussed in Chapter 1, can be distinguished in terms of both meaning and use from the concept of reputation (as esteem) which uniquely unites the moral rights, prohibited marks and geographical indications. The concept of reputation in trademark law is a concept of reputation in the sense of being a communication of association (in the case of trademark, association of a symbol with particular goods or services in the minds of the public). It is at least in part because of the sense of ‘reputation’ as esteem present in the more modern devices of moral rights, prohibited marks and geographical indications that, whether or not the existence of moral rights, prohibited marks or geographical indications have any economic impact, they remain, in all three cases, ‘inalienable.’⁸⁷⁵

The finding in this thesis that the role of reputation in moral rights, prohibited marks and geographical indications, each associated with a classic form of intellectual property (moral rights with copyright and prohibited marks and geographical indications with trademark), is one unique to the device in question and yet not unlike the presence

⁸⁷⁵ It is not argued here that these three devices, moral rights, prohibited marks and geographical indications, are unique in having an inalienable character amongst the devices grouped with classic intellectual property: as Margaret Ann Wilkinson has demonstrated, the technological protections measures (found in modern copyright enactments), the rights management provisions (also found in modern copyright enactments), the data protection provisions (found enacted in modern times in patent enactments) and confidential information law (protection of which, in Canada, remains at common law) all also possess the characteristic of inalienability. See Wilkinson, “What is the Role...”, *supra* note 62.

of reputation as a characteristic associated with the other two (and not with any other intellectual property-related device), is not inconsistent with the work of Margaret Ann Wilkinson who has written that “the shift from individual to corporate ownership of patents, copyrights and trademarks [that occurred in the mid-nineteenth century] is the key challenge to understanding the current contribution of intellectual property to societal interests.”⁸⁷⁶ She explains that prior to the “modern legal separation of a corporation from its owners . . ., inventors, authors and creators were exclusively individuals who, in turn, could only engage in business with other individuals – a business’s goodwill [in the sense of reputation] was only the goodwill of the individual or individuals operating it.”⁸⁷⁷ Wilkinson notes that “balance in intellectual property now has to be achieved in an environment of a triad of interests (individual, corporate and societal) and not as in the original intellectual property environment of dual interests (individual and societal).”⁸⁷⁸

The unique positions of moral rights, prohibited marks and geographical indications, each with its own unique association with a particular aspect of reputation, alongside the classic intellectual property devices of copyright and trademark, may be seen to be adaptations made by governments, including the Canadian government, as modern intellectual property is required to adapt to function in a more complex environment and other rights must be created to represent interests other than those of the classic intellectual property rights holders.

⁸⁷⁶ *Ibid* at 21.

⁸⁷⁷ *Ibid* at 9.

⁸⁷⁸ *Ibid* at 34.

This thesis has demonstrated that moral rights, prohibited marks, and geographical indications are one set of rights created to function in modern society alongside of, but independent of, the classic intellectual property rights of copyright and trademark. It is the concept of reputation, in the sense of 'esteem', that distinguishes moral rights, prohibited marks and geographical indications from copyright and trademark and creates, of them, a unique set of rights, none of which poses the classic characteristics of intellectual property.

APPENDICES

Appendix A: Statutory Provisions Relating to the Role of Judge and Jury in Civil Defamation Proceedings Across Common Law Canada

[emphasis added throughout on concepts such as “jury”, “judge”, etc.]

Newfoundland and Labrador

Defamation Act, RSNL 1990, c D-3

General or special verdict

8. On the trial of an action for defamation before a **jury**

(a) the **jury** may give a general verdict upon the whole matter in issue in the action, and shall not be required or directed to find for the plaintiff merely on proof of publication by the defendant of the alleged defamation and of the sense ascribed to it in the action;

(b) the court shall, according to its discretion, give its opinion and directions to the **jury** on the matter in issue as in other cases; and

(c) the **jury** may on the issue upon being directed to do so by the court find a special verdict, if they think fit to do so, and the proceedings after verdict, whether general or special, shall be the same as in other cases.

Nova Scotia

Defamation Act, RSNS 1989, c 122

Verdict of jury

8 On the trial of an action for defamation the **jury** may give a general verdict upon the whole matter in issue in the action, and shall not be required or directed to find for the plaintiff merely on proof of publication by the defendant of the alleged defamation and of the sense ascribed to it in the action; but the **court** shall, according to its discretion, give its opinion and **directions to the jury** on the matter in issue as in other cases; and the **jury** may on such issue find a special verdict, if they think fit so to do and the proceedings after verdict, whether general or special, shall be the same as in other cases.

Separate verdicts

12 (1) In a consolidated action under Section 11 **the court or jury** shall assess the whole amount of the damages, if any, in one sum, but a separate verdict shall be given for or against each defendant in the same way as if the actions consolidated had been tried separately.

(2) If **the court or jury** gives a verdict against defendants in more than one of the actions so consolidated it shall apportion the amount of the damages between and against those defendants, and, if the plaintiff is awarded the costs of the action, the **judge** shall make such order as he considers just for the apportionment of the costs between and against those defendants.

Prince Edward Island

Defamation Act, RSPEI 1988, C D-5

Jurisdiction of jury and court in action

6 On the **trial** of an action for defamation the **jury** may give a general verdict upon the whole matter in issue in the action, and shall not be required or directed to find for the plaintiff merely on proof of publication by the defendant of the alleged defamation and of the sense ascribed to it in the action; but the **court** shall, according to its discretion, give its opinion and directions to the **jury** on the matter in issue as in other cases; and the **jury** may on such issue find a special verdict, and the proceedings after verdict, whether general or special, shall be the same as in other cases.

Consolidated actions, jurisdiction of jury

8(1) In a consolidated action under section 7 the **jury** shall assess the whole amount of the damages, if any, in one sum, but a separate verdict shall be taken for or against each defendant in the same way as if the actions consolidated had been tried separately.

Apportionment of damages between defendants

(2) If the **jury** finds a verdict against the defendants in more than one of the actions so consolidated, they shall apportion the amount of the damages between and against these defendants; and, if the plaintiff is awarded the costs of the action the **judge** shall make an order for the apportionment of the costs between and against these defendants.

New Brunswick

Defamation Act, RSNB 2011, c 139

General or special verdict

6(1) On the **trial** of an action for defamation, the **jury** may give a general verdict on the whole matter in issue in the action and shall not be required or directed to find for the plaintiff merely on proof of publication by the defendant of the alleged defamation and of the sense ascribed to it in the action

(2) According to its discretion, the **court** shall give its opinion and directions to the **jury** on the matter in issue as in other cases.

(3) If they think fit to do so, the **jury** may find a special verdict on the matter in issue in the action.

(4) The proceedings after verdict, whether general or special, shall be the same as in other cases.

Damages in a consolidated action

8(1) In a consolidated action under section 7, the **court or jury** shall assess the whole amount of the damages, if any, in one sum, but a separate verdict shall be given for or against each defendant in the same way as if the actions consolidated had been tried separately.

(2) If the **court or jury** gives a verdict against defendants in more than one of the consolidated actions, it shall apportion the amount of the damages between and against those defendants.

(3) If the plaintiff is awarded the costs of the action, the **judge** shall make the order that the **judge** considers just for the apportionment of the costs between and against the defendants.

Ontario

Libel and Slander Act, RSO 1990, c L-12

Assessment of damages and apportionment of damages and costs

11(2) In a consolidated action under this section, the **jury** shall assess the whole amount of the damages, if any, in one sum, but a separate verdict shall be taken for or against each defendant in the same way as if the actions consolidated had been tried separately,

and, if the **jury** finds a verdict against the defendant or defendants in more than one of the actions so consolidated, the **jury** shall apportion the amount of the damages between and against the last-mentioned defendants, and **the judge at the trial**, in the event of the plaintiff being awarded the costs of the action, shall thereupon make such order as he or she considers just for the apportionment of the costs between and against such defendants.

Verdicts

14 On the **trial** of an action for libel, the **jury** may give a general verdict upon the whole matter in issue in the action and shall not be required or directed to find for the plaintiff merely on proof of publication by the defendant of the alleged libel and of the sense ascribed to it in the action, but the **court** shall, according to its discretion, give its opinion and directions to the **jury** on the matter in issue as in other cases, and the **jury** may on such issue find a special verdict, if they think fit so to do, and the proceedings after verdict, whether general or special, shall be the same as in other cases.

Manitoba

The Defamation Act, CCSM 2002, c D20

General or special verdict

On the trial of an action for defamation

6(a) the jury may give a general verdict upon the whole matter in issue in the action, and shall not be required or directed to find for the plaintiff merely on proof of publication by the defendant of the alleged defamation and of the sense ascribed to it in the action;

(b) the **court** shall, according to its discretion, give its opinion and directions to the **jury** on the matter in issue as in other cases; and

(c) the **jury** may on such issue find a special verdict if they think fit so to do; and the proceedings after verdict, whether general or special, shall be the same as in other cases.

Assessment and apportionment of damages and costs

8(1) In a consolidated action under section 7 the **court or jury** shall assess the whole amount of the damages, if any, in one sum; but a separate verdict shall be given for or against each defendant in the same way as if the actions consolidated had been tried separately.

Apportionment

(2) If the **court or jury** gives a verdict against defendants in more than one of the actions so consolidated, it shall apportion the amount of the damages between and against those defendants; and, if the plaintiff is awarded the costs of the action, the **judge** shall make such order as he deems just for the apportionment of the costs between and against those defendants.

Saskatchewan

Libel and Slander Act, RSS 1978, c L-14

Powers of judge or jury as to verdict

5 On the **trial** of an action for libel, the **jury** may give a general verdict upon the whole matter in issue in the action and shall not be required or directed to find for the plaintiff merely on proof of publication by the defendant of the alleged libel and of the sense ascribed to it in the action, but the **court** shall, according to its discretion, give its opinion and directions to the **jury** on the matter in issue as in other cases, and the **jury** may on the issue find a special verdict if it thinks fit to do so, and the proceedings after verdict whether general or special shall be same as in other cases.

Consolidation of different actions for same libel

6(1) The **court or a judge** upon an application by two or more defendants in any two or more actions for the same or substantially the same libel, or for a libel or libels contained in articles the same or substantially the same published in different newspapers, brought by the same person, may make an order for the consolidation of the actions so that they shall be tried together, and, after the order has been made and before the **trial** of the actions, the defendants in any new actions instituted in respect of any such libel or libels shall also be entitled to be joined in a common action upon a joint application being made by the new defendants and the defendants in the actions already consolidated.

Damages and costs assessed thereon

(2) In a consolidated action under this section the **jury** shall assess the whole amount of the damages, if any, in one sum, but a separate verdict shall be taken for or against each defendant in the same way as if the actions consolidated had been tried separately, and, if the **jury** finds a verdict against the defendant or defendants in more than one of the actions so consolidated, it shall apportion the amount of the damages between and against the last mentioned defendants, and the **judge** at the **trial**, if the plaintiff is awarded the costs of the action, shall thereupon make such order as he deems just for the apportionment of the costs between and against those defendants.

Alberta

Defamation Act, RSA 2000, c D-7

General and special verdicts

6(1) On the **trial** of an action for defamation, the **jury**

- (a) may give a general verdict on the whole matter in issue in the action, and
- (b) shall not be required or directed to find for the plaintiff merely on proof of publication by the defendant of the alleged defamation and of the sense ascribed to it in the action, but the **court** shall, according to its discretion, give its opinion and directions to the **jury** on the matter in issue as in other cases, and the **jury** may on the issue find a special verdict if it thinks fit to do so.

(2) The proceedings after verdict, whether general or special, shall be the same as in other cases.

Damages in consolidated action

8(1) In a consolidated action under section 7, the **court or jury** shall assess the whole amount of the damages, if any, in one sum, but a separate verdict shall be given for or against each defendant in the same way as if the actions consolidated had been tried separately.

(2) If the **court or jury** gives a verdict against defendants in more than one of the actions so consolidated, it shall apportion the amount of the damages between and against those defendants, and if the plaintiff is awarded the costs of the action the **judge** shall make an order as the **judge** considers just for the apportionment of the costs between and against those defendants.

British Columbia

Libel and Slander Act, RSBC 1996, c 263

Direction to jury and return of verdict

14 (1) On the **trial** of an action for making or publishing a libel, on the plea of not guilty pleaded, the **jury** sworn to try the issue may give a general verdict of guilty or not guilty on the whole matter put in issue in the action.

(2) The **jury** must not be required or directed by the court before which the action is tried to find the defendant guilty merely on the proof of publication by the defendant of the paper charged to be a libel, and of the sense ascribed to it in the action.

(3) The court before which the **trial** is held must, in its discretion, give the opinion and directions of the court to the **jury** on the matter in issue, as in other cases.

(4) The **jury** may on the issue find a special verdict, if they think fit to do so.

(5) The defendant, if found guilty, may move for a stay of judgment on the grounds and in a manner he might have done before the coming into force of this Act.

Verdict, damages and costs in consolidated actions

16 (1) In a consolidated action under section 15, the **court or jury** must assess the whole amount of the damages, if any, in one sum, but a separate verdict must be taken for or against each defendant, in the same way as if the actions consolidated had been tried separately.

(2) If the **court or jury** finds a verdict against the defendant or defendants in more than one of the actions consolidated, they must proceed to apportion the amount of damages that they have found between and against the defendants.

(3) If the **court** awards costs to the plaintiff, the court must make an order it thinks just for the apportionment of costs between and against the defendants.

Northwest Territories

Defamation Act, RSNWT 1988, c D-1

General or special verdict

6. (1) Where an action for defamation is **tried with a jury**, the **jury** may give a general verdict on the whole matter in issue in the action and shall not be required or directed to find for the plaintiff merely on proof of

(a) publication by the defendant of the alleged defamation, and

(b) the sense ascribed to the defamation in the action, but the **presiding judge** shall, according to his or her discretion, give his or her opinion and directions to the **jury** on the matter in issue as in other cases and the **jury** may on that issue give a special verdict if they think fit to do so.

Proceedings after verdict

(2) The proceedings after verdict by a **jury**, whether general or special, shall be the same as in other cases.

General or special finding by judge

7 Where an action for defamation is **tried by a judge without a jury**, the **judge** may make a finding of a general or special nature as the judge thinks fit.

Assessment of damages in consolidated action

9(1) In an action consolidated under section 8, the **jury or judge**, as the case may be, shall assess the whole amount of the damages, if any, in one sum, but a separate verdict or finding shall be given for or against each defendant in the same way as if the actions had been tried separately.

Apportionment of damages and costs

(2) A **jury or judge** that makes a verdict or finding against the defendants in more than one action consolidated under section 8 shall apportion the amount of the damages between and against the defendants and where the plaintiff is awarded the costs of the action, the **judge** shall make an order that the **judge** considers just apportioning the costs between and against the defendants.

Nunavut

The Northwest Territories *Defamation Act* applies

Definitions

"judge" means a judge of the Nunavut Court of Justice;

Yukon

Defamation Act, RSY 2002, c 52

General or special verdict at jury trial

6(1) If an action for defamation is **tried with a jury**, the **jury** may give a general verdict on the whole matter in issue in the action, and shall not be required or directed to find for the plaintiff merely on proof of publication by the defendant of the alleged defamation and of the sense ascribed to it in the action; but the **presiding judge** shall, according to discretion, give the judge's opinion and directions to the **jury** on the matter in issue as in other cases; and the **jury** may on that issue find a special verdict, if they think fit so to do, and the proceedings after verdict, whether general or special, shall be the same as in other cases.

(2) If an action for defamation is **tried by a judge without jury**, the **judge** may make any finding of a general or special nature as the judge sees fit.

Damages and costs in consolidated actions

9(1) In a consolidated action under section 7, the **jury** or a **judge**, as the case may be, shall assess the whole amount of the damages, if any, in one sum, but a separate verdict or finding shall be taken for or against each defendant in the same way as if the actions consolidated had been tried separately.

(2) If the **jury** or a **judge**, as the case may be, makes a verdict or finding against the defendants in more than one of the actions so consolidated, the amount of the damages shall be apportioned between and against the defendants; and, if the plaintiff is awarded the costs of the action, the **judge** shall make any order considered just for the apportionment of the costs between and against the defendants.

Appendix B: Moral Rights in Canada's *Copyright Act*

Copyright Act, RSC 1985, c C-42

Note: Headings are as in the Statute; emphasis added

PART I

Copyright and Moral Rights in Works

Definitions, s 2

moral rights means the rights described in subsections **14.1(1)** and **17.1(1)**; (*droits moraux*)

Compilations

2.1 (1) A compilation containing two or more of the categories of literary, dramatic, musical or artistic works shall be deemed to be a compilation of the category making up the most substantial part of the compilation.

Idem

(2) The mere fact that a work is included in a compilation does not increase, decrease or otherwise affect the protection conferred by this Act in respect of the copyright in the work or the **moral rights** in respect of the work.

Moral rights

14.1 (1) The author of a work has, subject to section **28.2**, the right to the integrity of the work and, in connection with an act mentioned in section 3, the right, where reasonable in the circumstances, to be associated with the work as its author by name or under a pseudonym and the right to remain anonymous.

No assignment of moral rights

(2) **Moral rights** may not be assigned but may be waived in whole or in part.

No waiver by assignment

(3) An assignment of copyright in a work does not by that act alone constitute a waiver of any **moral rights**.

Effect of waiver

(4) Where a waiver of any moral right is made in favour of an owner or a licensee of copyright, it may be invoked by any person authorized by the owner or licensee to use the work, unless there is an indication to the contrary in the waiver.

Term

14.2 (1) Moral rights in respect of a work subsist for the same term as the copyright in the work.

Succession

(2) The **moral rights** in respect of a work pass, on the death of its author, to

(a) the person to whom those rights are specifically bequeathed;

(b) where there is no specific bequest of those moral rights and the author dies testate in respect of the copyright in the work, the person to whom that copyright is bequeathed; or

(c) where there is no person described in paragraph (a) or (b), the person entitled to any other property in respect of which the author dies intestate.

Subsequent succession

(3) Subsection (2) applies, with such modifications as the circumstances require, on the death of any person who holds **moral rights**.

Moral rights

17.1 (1) In the cases referred to in subsections **15(2.1)** and **(2.2)**, a performer of a live aural performance or a performance fixed in a sound recording has, subject to subsection **28.2(1)**, the right to the integrity of the performance, and — in connection with an act mentioned in subsection **15(1.1)** or one for which the performer has a right to remuneration under section 19 — the right, if it is reasonable in the circumstances, to be associated with the performance as its performer by name or under a pseudonym and the right to remain anonymous.

No assignment of moral rights

(2) **Moral rights** may not be assigned but may be waived in whole or in part.

No waiver by assignment

(3) An assignment of copyright in a performer's performance does not by itself constitute a waiver of any moral rights.

Effect of waiver

(4) If a waiver of any moral right is made in favour of an owner or a licensee of a copyright, it may be invoked by any person authorized by the owner or licensee to use the performer's performance, unless there is an indication to the contrary in the waiver.

Application and term

17.2 (1) Subsection **17.1(1)** applies only in respect of a performer's performance that occurs after the coming into force of that subsection. The **moral rights** subsist for the same term as the copyright in that performer's performance.

Succession

(2) The **moral rights** in respect of a performer's performance pass, on the performer's death, to

- (a) the person to whom those rights are specifically bequeathed;
- (b) if there is not a specific bequest of those **moral rights** and the performer dies testate in respect of the copyright in the performer's performance, the person to whom that copyright is bequeathed; or
- (c) if there is not a person as described in paragraph (a) or (b), the person entitled to any other property in respect of which the performer dies intestate.

Subsequent succession

(3) Subsection (2) applies, with any modifications that the circumstances require, on the death of any person who holds **moral rights**.

Moral Rights Infringement

Infringement generally

28.1 Any act or omission that is contrary to any of the **moral rights** of the author of a work or of the performer of a performer's performance is, in the absence of the author's or performer's consent, an infringement of those rights.

Nature of right of integrity

28.2 (1) The author's or performer's right to the integrity of a work or performer's performance is infringed only if the work or the performance is, to the prejudice of its author's or performer's **honour or reputation**,

- (a) distorted, mutilated or otherwise modified; or
- (b) used in association with a product, service, cause or institution.

Where prejudice deemed

(2) In the case of a painting, sculpture or engraving, the prejudice referred to in subsection (1) shall be deemed to have occurred as a result of any distortion, mutilation or other modification of the work.

When work not distorted, etc.

(3) For the purposes of this section,

(a) a change in the location of a work, the physical means by which a work is exposed or the physical structure containing a work, or

(b) steps taken in good faith to restore or preserve the Work shall not, by that act alone, constitute a distortion, mutilation or other modification of the work.

Appendix C : Prohibited Marks - Section 9 of the *Trademarks Act*, RSC 1985 c T-13

Unfair Competition and Prohibited Signs

9 (1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for,

- (a) the Royal Arms, Crest or Standard;
- (b) the arms or crest of any member of the Royal Family;
- (c) the standard, arms or crest of His Excellency the Governor General;
- (d) any word or symbol likely to lead to the belief that the goods or services in association with which it is used have received, or are produced, sold or performed under, royal, vice-regal or governmental patronage, approval or authority;
- (e) the arms, crest or flag adopted and used at any time by Canada or by any province or municipal corporation in Canada in respect of which the Registrar has, at the request of the Government of Canada or of the province or municipal corporation concerned, given public notice of its adoption and use;
- (f) the emblem of the Red Cross on a white ground, formed by reversing the federal colours of Switzerland and retained by the Geneva Convention for the Protection of War Victims of 1949 as the emblem and distinctive sign of the Medical Service of armed forces and used by the Canadian Red Cross Society, or the expression “Red Cross” or “Geneva Cross”;
- (g) the emblem of the Red Crescent on a white ground adopted for the same purpose as specified in paragraph (f);
- (g.1) the third Protocol emblem — commonly known as the “Red Crystal” — referred to in Article 2, paragraph 2 of Schedule VII to the [Geneva Conventions Act](#) and composed of a red frame in the shape of a square on edge on a white ground, adopted for the same purpose as specified in paragraph (f);
- (h) the equivalent sign of the Red Lion and Sun used by Iran for the same purpose as specified in paragraph (f);
- (h.1) the international distinctive sign of civil defence (equilateral blue triangle on an orange ground) referred to in Article 66, paragraph 4 of Schedule V to the [Geneva Conventions Act](#);
 - (i) any territorial or civic flag or any national, territorial or civic arms, crest or emblem, of a country of the Union, if the flag, arms, crest or emblem is on a list communicated under article 6^{ter} of the Convention or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;
 - (i.1) any official sign or hallmark indicating control or warranty adopted by a country of the Union, if the sign or hallmark is on a list communicated under article 6^{ter} of the Convention or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;
 - (i.2) any national flag of a country of the Union;

(i.3) any armorial bearing, flag or other emblem, or the name or any abbreviation of the name, of an international intergovernmental organization, if the armorial bearing, flag, emblem, name or abbreviation is on a list communicated under article 6^{ter} of the Convention or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;

(j) any scandalous, obscene or immoral word or device;

(k) any matter that may falsely suggest a connection with any living individual;

(l) the portrait or signature of any individual who is living or has died within the preceding thirty years;

(m) the words “United Nations” or the official seal or emblem of the United Nations;

(n) any badge, crest, emblem or mark

(i) adopted or used by any of Her Majesty’s Forces as defined in the [National Defence Act](#),

(ii) of any university, or

(iii) adopted and used by any public authority, in Canada as an official mark for goods or services, in respect of which the Registrar has, at the request of Her Majesty or of the university or public authority, as the case may be, given public notice of its adoption and use;

(n.1) any armorial bearings granted, recorded or approved for use by a recipient pursuant to the prerogative powers of Her Majesty as exercised by the Governor General in respect of the granting of armorial bearings, if the Registrar has, at the request of the Governor General, given public notice of the grant, recording or approval; or

(o) the name “Royal Canadian Mounted Police” or “R.C.M.P.” or any other combination of letters relating to the Royal Canadian Mounted Police, or any pictorial representation of a uniformed member thereof.

Excepted uses

(2) Nothing in this section prevents the adoption, use or registration as a trade-mark or otherwise, in connection with a business, of any mark

(a) described in subsection (1) with the consent of Her Majesty or such other person, society, authority or organization as may be considered to have been intended to be protected by this section; or

(b) consisting of, or so nearly resembling as to be likely to be mistaken for

(i) an official sign or hallmark mentioned in paragraph (1)(i.1), except in respect of goods that are the same or similar to the goods in respect of which the official sign or hallmark has been adopted, or

(ii) an armorial bearing, flag, emblem or abbreviation mentioned in paragraph (1)(i.3), unless the use of the mark is likely to mislead the public as to a connection between the user and the organization.

Appendix D : Comparison of “Prohibited Marks” in the Current *Trademarks Act* and “Forbidden Marks” in the 1932 *Unfair Competition Act*.

<i>Trademarks Act, RSC 1985, c T-13</i> (last amended on June 18, 2019)	<i>1932 An Act respecting Unfair Competition in Trade and Commerce</i>
9 (1) No person shall adopt in connection with a business, as a trademark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for	14. (1) No person shall be entitled to adopt for use in connection with his business, as a trade mark or otherwise, any symbol consisting of, or so nearly resembling as to be likely to be mistaken for,
(a) the Royal Arms, Crest or Standard;	(a) the Royal Arms, Crest or Standard;
(b) the arms or crest of any member of the Royal Family;	(b) the arms or crest of any member of the Royal Family;
	(c) the national flag in any of its forms;
(c) the standard, arms or crest of His Excellency the Governor General;	(d) the standard, arms or crest of His Excellency the Governor-General;
(d) any word or symbol likely to lead to the belief that the goods or services in association with which it is used have received, or are produced, sold or performed under, royal, vice-regal or governmental patronage, approval or authority;	
(e) the arms, crest or flag adopted and used at any time by Canada or by any province or municipal corporation in Canada in respect of which the Registrar has, at the request of the Government of Canada or of the province or municipal corporation concerned, given public notice of its adoption and use;	(e) the arms or crest adopted and used at any time by Canada or by any province or municipal corporation in Canada;
(f) the emblem of the Red Cross on a white ground formed by reversing the federal colours of Switzerland and retained by the Geneva Convention for the Protection of War Victims of 1949 as the emblem and distinctive sign of the Medical Service of armed forces and used by the Canadian Red Cross Society, or the expression “Red Cross” or “Geneva Cross”;	(g) the emblem of the Red Cross Society, consisting of a red cross on a white ground or the expression “Red Cross” or “Geneva Cross;”
(g) the emblem of the Red Crescent on a white ground adopted for the same purpose as specified in paragraph (f);	
(g.1) the third Protocol emblem — commonly known as the “Red Crystal” — referred to in Article 2, paragraph 2 of Schedule VII to the Geneva Conventions Act and composed of a red frame in the shape of a square on edge on a white ground, adopted for the same purpose as specified in paragraph (f);	
(h) the equivalent sign of the Red Lion and Sun used by Iran for the same purpose as specified in paragraph (f);	

	(i) the emblem of any fraternal society, the legal existence of which is recognized under any law in force in Canada;
(h.1) the international distinctive sign of civil defence (equilateral blue triangle on an orange ground) referred to in Article 66, paragraph 4 of Schedule V to the Geneva Conventions Act ;	
(i) any territorial or civic flag or any national, territorial or civic arms, crest or emblem, of a country of the Union, if the flag, arms, crest or emblem is on a list communicated under article 6ter of the Convention or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;	(h) any national, territorial or civic flag, arms, crest, or emblem of the prohibition of which as a commercial device notice has been received and publicly given by the Registrar pursuant to the provisions of the Convention more than two months before the adoption of the symbol;
(i.1) any official sign or hallmark indicating control or warranty adopted by a country of the Union, if the sign or hallmark is on a list communicated under article 6ter of the Convention or pursuant to the obligations under Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;	(h)
(i.2) any national flag of a country of the Union;	(f) any national flag, arms, crest or emblem commonly used as such by any foreign state;
(i.3) any armorial bearing, flag or other emblem, or the name or any abbreviation of the name, of an international intergovernmental organization, if the armorial bearing, flag, emblem, name or abbreviation is on a list communicated under article 6ter of the Convention or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;	(h)
(j) any scandalous, obscene or immoral word or device;	
(k) any matter that may falsely suggest a connection with any living individual;	
(l) the portrait or signature of any individual who is living or has died within the preceding thirty years;	(k) the portrait or signature of any person who is living or has died within thirty years.
(m) the words “United Nations” or the official seal or emblem of the United Nations;	

<p>(n) any badge, crest, emblem or mark</p> <p>(i) adopted or used by any of Her Majesty's Forces as defined in the National Defence Act,</p> <p>(ii) of any university, or</p> <p>(iii) adopted and used by any public authority, in Canada as an official mark for goods or services, in respect of which the Registrar has, at the request of Her Majesty or of the university or public authority, as the case may be, given public notice of its adoption and use;</p>	<p>(j) any symbol adopted and used by any public authority in Canada as an official mark on similar wares;</p>
<p>(n.1) any armorial bearings granted, recorded or approved for use by a recipient pursuant to the prerogative powers of Her Majesty as exercised by the Governor General in respect of the granting of armorial bearings, if the Registrar has, at the request of the Governor General, given public notice of the grant, recording or approval; or</p>	
<p>(o) the name "Royal Canadian Mounted Police" or "R.C.M.P." or any other combination of letters relating to the Royal Canadian Mounted Police, or any pictorial representation of a uniformed member thereof.</p>	
<p>9 (2) Nothing in this section prevents the adoption, use or registration as a trademark or otherwise, in connection with a business, of any mark</p>	<p>14 (2) Nothing in this section shall prevent the use as a trade mark, or otherwise in connection with a business, of any such symbol as aforesaid with the consent and approval of His Majesty or such other person as may be deemed to have been intended to be protected by the provisions hereof.</p>
<p>(a) described in subsection (1) with the consent of Her Majesty or such other person, society, authority or organization as may be considered to have been intended to be protected by this section; or</p>	
<p>(b) consisting of, or so nearly resembling as to be likely to be mistaken for</p> <p>(i) an official sign or hallmark mentioned in paragraph (1)(i.1), except in respect to goods that are the same or similar to the goods in respect of which the official sign or hallmark has been adopted, or</p> <p>(ii) an armorial bearing, flag, emblem, name or abbreviation mentioned in paragraph (1)(i.3), unless the use of the mark is likely to mislead the public as to a connection between the user and the organization</p>	

Appendix E: Article 6^{ter} of the Paris Convention in 1925, 1934, 1958 and 1967

1925

Hague Revision

Article 6^{ter}.

[1] The contracting countries agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags and other State emblems of the contracting countries, official signs and hallmarks indicating control and warranty adopted by them and all imitations thereof from a heraldic point of view.

[2] The prohibition of the use of official signs and hallmarks indicating control and warranty shall apply solely in cases where the marks which contain them are intended to be used on goods of the same or a similar kind.

[3] For the application of these provisions the contracting countries agree to communicate reciprocally, through the International Bureau at Berne, the list of State emblems and official signs and hallmarks indicating control and warranty which they desire, or may hereafter desire, to place wholly or within certain limits under the protection of the present Article and all subsequent modifications of this list. Each contracting country shall in due course make available to the public the lists so communicated.

[4] Each contracting country may, within a period of twelve months from the receipt of the communication, transmit through the International Bureau of Berne its objections, if any, to the country concerned.

[5] In the case of well-known State emblems, the measures prescribed by paragraph [1] shall apply solely to marks registered after the signature of the present Act.

[6] In the case of State emblems which are not well known, and in the case of official signs and hallmarks, these provisions shall be applicable only to marks registered more than two months after the receipt of the communication provided for in paragraph [3].

[7] In cases of bad faith the countries shall have the right to cancel the registration of marks that contain State emblems, signs or hallmarks even though registered before the signature of the present Act.

[8] Nationals of each country who are authorized to make use of State emblems, signs or hallmarks of their country, may use them even though they are similar to those of another country.

[9] The contracting countries undertake to prohibit the unauthorized use in trade of the State armorial bearings of the other contracting countries, when the use is of such a nature as to be misleading as to the origin of the goods.

[10] The above provisions shall not prevent the countries from exercising the power given in paragraph [2] (No. 3) of Article 6, to refuse or to cancel the registration of marks containing, without authorization, the armorial bearings, flags, decorations, and other State emblems or official signs or hallmarks adopted by a country of the Union.

1934

London revision

Article 6ter.

- (1) The countries of the Union agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags and other State emblems of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them and all imitations thereof from an heraldic point of view.
- (2) The prohibition of the use of official signs and hallmarks indicating control and warranty shall apply solely in cases where the marks which contain them are intended to be used on goods of the same or a similar kind.
- (3) For the application of these provisions the countries of the Union agree to communicate reciprocally, through the International Bureau, the list of State emblems and official signs and hallmarks indicating control and warranty which they desire, or may thereafter desire, to place wholly or within certain limits under the protection of the present Article and all subsequent modifications of this list. Each country of the Union shall in due course make available to the public the lists so communicated.
- (4) Any country of the Union may, within a period of twelve months from the receipt of the communication, transmit through the International Bureau its objections, if any, to the country concerned.
- (5) In the case of well-known State emblems, the measures prescribed by paragraph (1) shall apply solely to marks registered after 6th November, 1925.
- (6) In the case of State emblems which are not well known, and in the case of official signs and hallmarks, these provisions shall be applicable only to marks registered more than two months after the receipt of the communication provided for in paragraph (3).
- (7) In cases of bad faith the countries shall have the right to cancel the registration of marks that contain State emblems, signs or hallmarks even though registered before 6th November, 1925.
- (8) Nationals of each country who are authorized to make use of State emblems, signs or hallmarks of their country, may use them even though they are similar to those of another country.
- (9) The countries of the Union undertake to prohibit the unauthorized use in trade of the State armorial bearings of the other countries of the Union, when the use is of such a nature as to be misleading as to the origin of the goods.
- (10) The above provisions shall not prevent the countries from exercising the power given in paragraph (1)(No. 3) of Article 6B, to refuse or to cancel the registration of marks containing, without authorization, the armorial bearings, flags, decorations and other State emblems or official signs or hallmarks adopted by a country of the Union.

1958

Lisbon revision

Article 6ter.

(I)(a) The countries of the Union agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags and other State emblems of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them and all imitations thereof from a heraldic point of view, (b) The provisions of sub-paragraph (a) above apply equally to armorial bearings, flags and other emblems, abbreviations or titles of international intergovernmental organizations of which one or more countries of the Union are members, with the exception of armorial bearings, flags and other emblems, abbreviations or titles that are already the subject of existing international agreements intended to ensure their protection,

(c) No country of the Union shall be required to apply the provisions of sub-paragraph (b) above to the prejudice of the owners of rights acquired in good faith before the entry into force, in that country, of the present Convention. The countries of the Union shall not be required to apply the said provisions when the use or registration covered by sub-paragraph (a) above is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbreviations or titles, or if such use or registration is clearly not of a nature to mislead the public as to the existence of a connection between the user and the organization.

(2) The prohibition of the use of official signs and hallmarks indicating control and warranty shall apply solely in cases where the marks which contain them are intended to be used on goods of the same or a similar kind.

(3)(a)[1] For the application of these provisions the countries of the Union agree to communicate reciprocally, through the International Bureau, the list of State emblems and official signs and hallmarks indicating control and warranty which they desire, or may thereafter desire, to place wholly or within certain limits under the protection of the present Article and all subsequent modifications of this list. Each country of the Union shall in due course make available to the public the lists so communicated. [2] Nevertheless, this communication is not obligatory so far as the flags of States are concerned, (b) The provisions of subparagraph (b) of paragraph (1) of this Article shall only apply to armorial bearings, flags and other emblems, abbreviations or titles of international intergovernmental organizations that the latter have communicated to the countries of the Union through the International Bureau.

(4) Any country of the Union may, within a period of twelve months from the receipt of the communication, transmit through the International Bureau its objections, if any, to the country or international intergovernmental organization concerned.

(5) In the case of State flags, the measures prescribed by paragraph (1) above shall apply solely to marks registered after 6th November, 1925. (6) In the case of State emblems other than flags, and of official signs and hallmarks of the countries of the Union and in the case of armorial bearings, flags and other emblems, abbreviations or titles of international intergovernmental organizations, these provisions shall be applicable only to marks registered more than two months after the receipt of the communication provided for in paragraph (3) above.

(7) In cases of bad faith the countries shall have the right to cancel the registration of marks that contain State emblems, signs or hallmarks even though registered before 6th November, 1925.

(8) Nationals of each country who are authorized to make use of State emblems, signs or hallmarks of their country, may use them even though they are similar to those of another country.

(9) The countries of the Union undertake to prohibit the unauthorized use in trade of the State armorial bearings of the other countries of the Union, when the use is of such a nature as to be misleading as to the origin of the goods.

(10) The above provisions shall not prevent the countries from exercising the power given in paragraph (3) of Article *bquinquies* B, to refuse or to cancel the registration of marks containing, without authorization, the armorial bearings, flags and other State emblems or official signs or hallmarks adopted by a country of the Union as well as the distinctive signs of international intergovernmental organizations mentioned in paragraph (1) of this Article.

Appendix F: The Changes Made in 1953 to the 1932 Legislation for Prohibited Marks

<i>Trade-Marks Act, 1952-53, c 49</i>	<i>1932 An Act respecting Unfair Competition in Trade and Commerce</i>
9. (1) No person shall adopt in connection with a business, as a trade mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for	14. (1) No person shall be entitled to adopt for use in connection with his business, as a trade mark or otherwise, any symbol consisting of, or so nearly resembling as to be likely to be mistaken for,
(a) the Royal Arms, Crest or Standard;	(a) the Royal Arms, Crest or Standard;
(b) the arms or crest of any member of the Royal Family	(b) the arms or crest of any member of the Royal Family;
	(c) the national flag in any of its forms;
(c) the standard, arms or crest of His Excellency the Governor General;	(d) the standard, arms or crest of His Excellency the Governor-General;
NEW (d) any word or symbol likely to lead to the belief that the wares or services in association with which it is used have received, or are produced, sold or performed under royal, vice- regal or governmental patronage, approval or authority;	
(e) the arms, crest or flag adopted and used at any time by Canada or by any province or municipal corporation in Canada in respect of which the Registrar has at the request of the Government of Canada or of the province or municipal corporation concerned, given public notice of its adoption and use;	(e) the arms or crest adopted and used at any time by Canada or by any province or municipal corporation in Canada;
	(f) any national flag, arms, crest or emblem commonly used as such by any foreign state;
(f) the heraldic emblem of the Red Cross on a white ground, formed by reversing the federal colours of Switzerland and retained by the Geneva Convention for the Protection of War Victims of 1949, as the emblem and distinctive sign of the Medical Service of armed forces and used by the Canadian Red Cross Society; or the expression "Red Cross "or" Geneva Cross";	(g) the emblem of the Red Cross Society, consisting of a red cross on a white ground or the expression "Red Cross" or "Geneva Cross;"
NEW (g) the heraldic emblem of the Red Crescent on a white ground adopted for the same purpose as specified in paragraph (f) by a number of Moslem countries;	
NEW (h) the equivalent sign of the Red Lion and Sun used by Iran for the same purpose as specified in paragraph (f);	

SUBSECTION (i) FROM 1932 DOES NOT APPEAR IN THE STATUTE IN 1953	(i) the emblem of any fraternal society, the legal existence of which is recognized under any law in force in Canada;
(i) any national, territorial or civic flag, arms, crest or emblem, or official control and guarantee sign or stamp, notice of the objection to the use of which as a commercial device has been received pursuant to the provisions of the Convention and publicly given by the Registrar;	(h) any national, territorial or civic flag, arms, crest, or emblem of the prohibition of which as a commercial device notice has been received and publicly given by the Registrar pursuant to the provisions of the Convention more than two months before the adoption of the symbol;
NEW (j) any scandalous, obscene or immoral word or device;	
NEW (k) any matter that may falsely suggest a connection with any living individual;	
(l) the portrait or signature of any individual who is living or has died within the preceding thirty years;	(k) the portrait or signature of any person who is living or has died within thirty years.
NEW (m) the words "United Nations" or the official seal or emblem of the United Nations;	
(n) any badge, crest, emblem or mark (i) adopted or used by any of Her Majesty's naval, army or air forces, (ii) of any university, or (iii) adopted and used by any public authority in Canada as an official mark for wares or services, in respect of which the Registrar has at the request of Her Majesty or of the university or public authority as the case may be, given public notice of its adoption and use, or	(j) any symbol adopted and used by any public authority in Canada as an official mark on similar wares;
NEW (o) the name "Royal Canadian Mounted Police" or "R.C.M.P." or any other combination of letters relating to the Royal Canadian Mounted Police, or any pictorial representation of a uniformed member thereof.	
9 (2) Nothing in this section prevents the use as a trade mark or otherwise, in connection with a business, of any mark described in subsection (1) with the consent of Her Majesty or such other person, society, authority or organization as may be considered to have been intended to be protected by this section.	14 (2) Nothing in this section shall prevent the use as a trade mark, or otherwise in connection with a business, of any such symbol as aforesaid with the consent and approval of His Majesty or such other person as may be deemed to have been intended to be protected by the provisions hereof.

Appendix G: The Changes Made in 2019 to 1953 Legislation for Prohibited Marks

<i>Trademarks Act, RSC 1985, c T-13 (last amended on June 18, 2019)</i>	<i>Trade Marks Act, 1952-53, c 4, s 1</i>
9 (1) No person shall adopt in connection with a business, as a trademark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for	9. (1) No person shall adopt in connection with a business, as a trade mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for
(a) the Royal Arms, Crest or Standard;	(a) the Royal Arms, Crest or Standard;
(b) the arms or crest of any member of the Royal Family;	(b) the arms or crest of any member of the Royal Family;
(c) the standard, arms or crest of His Excellency the Governor General;	(c) the standard, arms or crest of His Excellency the Governor General;
(d) any word or symbol likely to lead to the belief that the goods or services in association with which it is used have received, or are produced, sold or performed under, royal, vice-regal or governmental patronage, approval or authority;	(d) any word or symbol likely to lead to the belief that the wares or services in association with which it is used have received or are produced, sold or performed under royal, vice-regal or governmental patronage, approval or authority;
(e) the arms, crest or flag adopted and used at any time by Canada or by any province or municipal corporation in Canada in respect of which the Registrar has, at the request of the Government of Canada or of the province or municipal corporation concerned, given public notice of its adoption and use;	(e) the arms, crest or flag adopted and used at any time by Canada or by any province or municipal corporation in Canada in respect of which the Registrar has at the request of the Government of Canada or of the province or municipal corporation concerned, given public notice of its adoption and use;
(f) the emblem of the Red Cross on a white ground, formed by reversing the federal colours of Switzerland and retained by the Geneva Convention for the Protection of War Victims of 1949 as the emblem and distinctive sign of the Medical Service of armed forces and used by the Canadian Red Cross Society, or the expression “Red Cross” or “Geneva Cross”;	(f) the heraldic emblem of the Red Cross on a white ground, formed by reversing the federal colours of Switzerland and retained by the Geneva Convention for the Protection of War Victims of 1949, as the emblem and distinctive sign of the Medical Service of armed forces and used by the Canadian Red Cross Society; or the expression "Red Cross "or" Geneva Cross";
(g) the emblem of the Red Crescent on a white ground Adopted for the same purpose as specified in paragraph (f);	(g) the heraldic emblem of the Red Crescent on a white ground adopted for the same purpose as specified in paragraph (f) by a number of Moslem countries;

<p>(g.1) the third Protocol emblem — commonly known as the “Red Crystal” — referred to in Article 2, paragraph 2 of Schedule VII to the Geneva Conventions Act and composed of a red frame in the shape of a square on edge on a white ground, adopted for the same purpose as specified in paragraph (f);</p>	
<p>(h) the equivalent sign of the Red Lion and Sun used by Iran for the same purpose as specified in paragraph (f);</p>	<p>(h) the equivalent sign of the Red Lion and Sun used by Iran for the same purpose as specified in paragraph (f);</p>
<p>(h.1) the international distinctive sign of civil defence (equilateral blue triangle on an orange ground) referred to in Article 66, paragraph 4 of Schedule V to the Geneva Conventions Act;</p>	
<p>(i) any territorial or civic flag or any national, territorial or civic arms, crest or emblem, of a country of the Union, if the flag, arms, crest or emblem is on a list communicated under article 6ter of the Convention or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;</p>	<p>(i) any national, territorial or civic flag, arms, crest or emblem, or official control and guarantee sign or stamp, notice of the objection to the use of which as a commercial device has been received pursuant to the provisions of the Convention and publicly given by the Registrar;</p>
<p>(i.1) any official sign or hallmark indicating control or Warranty adopted by a country of the Union, if the sign or hallmark is on a list communicated under article 6ter of the Convention or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;</p>	
<p>(i.2) any national flag of a country of the Union;</p>	
<p>(i.3) any armorial bearing, flag or other emblem, or the name or any abbreviation of the name, of an international intergovernmental organization, if the armorial bearing, flag, emblem, name or abbreviation is on a list communicated under article 6ter of the Convention or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;</p>	
<p>(j) any scandalous, obscene or immoral word or device;</p>	<p>(j) any scandalous, obscene or immoral word or device;</p>
<p>(k) any matter that may falsely suggest a connection with any living individual;</p>	<p>(k) any matter that may falsely suggest a connection with any living Individual;</p>

<p>(l) the portrait or signature of any individual who is living or has died within the preceding thirty years;</p>	<p>(l) the portrait or signature of any individual who is living or has died within the preceding thirty years;</p>
<p>(m) the words “United Nations” or the official seal or emblem of the United Nations;</p>	<p>(m) the words "United Nations" or the official seal or emblem of the United Nations;</p>
<p>(n) any badge, crest, emblem or mark</p> <ul style="list-style-type: none"> (i) adopted or used by any of Her Majesty’s Forces as defined in the National Defence Act, (ii) of any university, or (iii) adopted and used by any public authority, in Canada as an official mark for goods or services, in respect of which the Registrar has, at the request of Her Majesty or of the university or public authority, as the case may be, given public notice of its adoption and use; 	<p>(n) any badge, crest, emblem or mark</p> <ul style="list-style-type: none"> (i) adopted or used by any of Her Majesty's naval, army or air forces, (ii) of any university, or (iii) adopted and used by any public authority in Canada as an official mark for wares or services, in respect of which the Registrar has, at the request of Her Majesty or of the university or public authority as the case may be, given public notice of its adoption and use; or
<p>(n.1) any armorial bearings granted, recorded or approved for use by a recipient pursuant to the prerogative powers of Her Majesty as exercised by the Governor General in respect of the granting of armorial bearings, if the Registrar has, at the request of the Governor General, given public notice of the grant, recording or approval; or</p>	
<p>(o) the name “Royal Canadian Mounted Police” or “R.C.M.P.” or any other combination of letters relating to the Royal Canadian Mounted Police, or any pictorial representation of a uniformed member thereof.</p>	<p>(o) the name "Royal Canadian Mounted Police" or "R.C.M.P." or any other combination of letters relating to the Royal Canadian Mounted Police, or any pictorial representation of a uniformed member thereof.</p>
<p>9 (2) Nothing in this section prevents the adoption, use or registration as a trademark or otherwise, in connection with a business, of any mark</p>	<p>9 (2) Nothing in this section prevents the use as a trade mark or otherwise, in connection with a business, of any mark described in subsection (1) with the consent of Her Majesty or such other person, society, authority or organization as may be considered to have been intended to be protected by this section.</p>
<p>(a) described in subsection (1) with the consent of Her Majesty or such other person, society, authority or organization as may be considered to have been intended to be protected by this section; or</p>	

(b) consisting of, or so nearly resembling as to be likely to be mistaken for

(i) an **official sign or hallmark** mentioned in paragraph (1)(i.1), except in respect to goods that are the same or similar to the goods in respect of which the official sign or hallmark has been adopted, or

(ii) an armorial bearing, flag, emblem, name or abbreviation mentioned in paragraph (1)(i.3), unless the use of the mark is likely to mislead the public as to a connection between the user and the organization

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