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Translating Trademarks:  
Towards the Equal Treatment of Foreign-Language Marks

Ung Shen Goh

A DISSERTATION SUBMITTED TO  
THE FACULTY OF GRADUATE STUDIES  
IN PARTIAL FULFILLMENT OF THE REQUIRMENTS  
FOR THE DEGREE OF DOCTOR OF PHILOSOPHY

Graduate Program in Law  
York University  
Toronto, Ontario

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# ABSTRACT

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Part A of this dissertation tells the story of The Coca-Cola Company's trademark registrations in Canada in order to illustrate the linguistic issues faced by trademark administrators. A trademark's registrability depends on its distinctiveness, which is its ability to can distinguish its trader's goods and services from those of another trader. Knowing how well a trademark will function to distinguish means ascertaining first what has already been registered, which is no easy task when the databases cannot administer foreign-language marks that are not Romanized. Part A proposes the solution of transcribing foreign-language marks that are not Romanized, so they can be filed/searched appropriately in databases.

Part B of this dissertation tells the story of two competing Chinese bakeries in Canada in order to illustrate the linguistic struggles of the judiciary. These struggles are nothing new, as academics have noted that "[l]ong before the introduction of the registration system [by what was then England in 1875], owners of marks containing terms in foreign languages or scripts could in certain circumstances prevent their use by trade rivals" and that by 1905 English and North American case law "has been fruitful of conflicting holdings." What is new in the 21<sup>st</sup> Century is the increasing frequency of foreign-language marks that are not Romanized, as the added complexity of foreign scripts makes it harder for courts to assess and compare trademarks that they cannot even read or sound out, much less understand. Part B proposes the solution of assuming linguistic knowledge for all foreign-language marks, so they can be assessed and compared appropriately in the case law.

# DEDICATION

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To Dr. Ling Goh:  
Beloved sister,  
Forever friend, and  
Consummate cheerleader!

# ACKNOWLEDGEMENTS

---

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# TABLE OF CONTENTS

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ABSTRACT .....	ii
DEDICATION .....	iii
ACKNOWLEDGEMENTS .....	iv
TABLE OF CONTENTS .....	v
INTRODUCTION .....	1
CHAPTER 1: ADMINISTRATIVE PROBLEM .....	7
1.1 The Problem of Classifying Foreign-Language Marks that are not Romanized .....	7
1.2 The Problem is Widespread in Canada .....	12
1.3 The Problem is Widespread Internationally .....	16
CHAPTER 2: ADMINISTRATIVE SOLUTION .....	20
2.1 The Solution of Transcribing Foreign-Language Marks that are not Romanized .....	20
2.2 The Solution as Illustrated by the Foreign-Language Marks for COCA-COLA .....	21
CHAPTER 3: ADMINISTRATIVE ALTERNATIVES .....	29
3.1 Classify as Design Marks Because not in an Official Language .....	29

3.2	Classify as Design Marks Because not in a Romanized Language .....	32
3.3	Classify as Word Marks by Transcribing Every Dialect .....	36
3.4	Classify as Word Marks by Having Fluent Examiners .....	39
CHAPTER 4: JUDICIAL PROBLEM .....		44
4.1	The Problem as Illustrated by Two Chinese Bakeries in Canada .....	44
4.2	The Problem of Proving Linguistic Knowledge .....	50
4.3	The Problem of Proving Linguistic Knowledge Creates Inequality in Canada .....	58
4.4	The Problem of Proving Linguistic Knowledge Lacks Statutory Basis in Canada .....	64
CHAPTER 5: JUDICIAL SOLUTION .....		68
5.1	The Solution of Assuming Linguistic Knowledge .....	68
5.1.1	Assessing for Distinctiveness .....	70
5.1.2	Comparing for Confusion .....	74
5.1.2A	Comparing for Confusion with Translations .....	77
5.1.2B	Comparing for Confusion with Transliterations .....	80
CHAPTER 6: JUDICIAL ALTERNATIVES .....		86
6.1	American Doctrine of Foreign Equivalentents .....	86
6.1.1	Comparing English to a Foreign Language .....	92
6.1.2	Comparing the Same Foreign Languages .....	93
6.1.3	Comparing Different Foreign Languages .....	95
6.1.4	Multiple Meanings Discourage Translation .....	97

6.1.5	Marketplace Meaning Discourages Translation .....	98
6.1.6	Language Combination Discourages Translation .....	98
6.2	European Approach .....	100
6.2.1	Official & Working Languages .....	101
6.2.2	Indigenous, Regional & Minority Languages .....	103
6.2.3	Foreign Languages .....	104
6.3	Chinese Approach .....	105
6.3.1	Example of TRUMP .....	106
6.3.2	Example of JORDAN .....	109
CHAPTER 7: LINGUISTIC KNOWLEDGE .....		114
7.1	Registrability of Trademarks .....	114
7.1.1	Names or Surnames .....	115
7.1.2	Distinctiveness of Trademarks .....	117
7.1.2.1	Inherently Distinctive Marks .....	119
7.1.2.2	Suggestive Marks .....	120
7.1.2.3	Descriptive/Misdescriptive Marks .....	120
7.1.2.4	Generic Marks .....	121
7.1.3	Confusion of Trademarks .....	122
7.1.3.1	Reference Sources .....	123
7.1.3.2	Social Influences .....	124



7.1.3.3	Government Documents .....	126
7.1.3.4	Corporate Materials .....	128
7.1.3.5	Expert Witnesses .....	129
7.1.3.6	Lay Testimonies .....	129
7.1.3.7	Translations vs Transliterations .....	130
7.1.4	Prohibited Marks .....	132
7.1.5	Plant Breeders' Rights Act .....	136
7.1.6	Geographical Indications .....	137
7.1.7	Olympic and Paralympic Marks Act .....	138
7.2	Rights of (Limits/Defences to) Registration .....	138
7.2.1	Right against Infringement .....	142
7.2.1.1	Rights without End .....	144
7.2.1.2	Rights without Exceptions .....	149
7.2.1.3	Rights without Responsibilities .....	153
7.2.2	Right against Depreciation .....	154
7.2.2.1	Dilution of Trademark .....	156
7.2.2.2	Dilution of Goods and Services .....	161
7.2.2.3	Dilution of Use .....	165
7.2.2.4	Dilution of Territory .....	171
7.2.3	Right to License .....	173
7.2.4	Right to Translate .....	177
7.2.4.1	Dilution by Blurring .....	179

7.2.4.2 Dilution by Tarnishment .....	181
7.2.4.3 Free Riding .....	182
CONCLUSION .....	186
BIBLIOGRAPHY .....	188

# INTRODUCTION

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Law is a social construct that often features fictitious characters. Criminal law applies the standard of *the reasonable person* to establish criminal negligence.<sup>1</sup> Civil law applies the same standard to establish tort liability for negligence.<sup>2</sup> Intellectual property law also has its legal fictions. Patent law imagines *a person skilled in the art* to assess non-obviousness.<sup>3</sup> Copyright law imagines a similar person or a lay person to assess copying,<sup>4</sup> as well as *the author* to assess originality.<sup>5</sup> Trademark law imagines *the consumer* to assess confusion.<sup>6</sup>

The trademark consumer is split into further fictitious characters, which is where the social construct starts to fall apart because the fictitious characters are arbitrarily given contradictory personalities. Examples include *the sovereign* versus *the fool*;<sup>7</sup> *the passive*

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<sup>1</sup> *R v Hill*, [1986] 1 SCR 313 at 324-325 (“The criminal law is concerned among other things with fixing standards for human behavior. We seek to encourage conduct that complies with certain societal standards of reasonableness and responsibility. In doing this, the law quite logically employs the objective standard of the reasonable person.”).

<sup>2</sup> *Vaughan v Menlove*, (1937) 132 ER 490 (CP) (“The care taken by a prudent man has always been the rule laid down; ... Instead, therefore, of saying that the liability for negligence should be co-extensive with the judgment of each individual, which would be as variable as the length of the foot of each individual, we ought rather to adhere to the rule which requires in all cases a regard to caution such as a man of ordinary prudence would observe.”).

<sup>3</sup> *Beloit Canada Ltd v Valmet Oy* (1986), 8 CPR (3d) 289 at 294 (“The question to be asked is whether this mythical creature (the man in the Clapham omnibus of patent law) would, in the light of the state of the art and of common general knowledge as at the claimed date of invention, have come directly and without difficulty to the solution taught by the patent.”).

<sup>4</sup> *Cinar Corporation v Robinson*, 2013 SCC 73, [2013] 3 SCR 1168 at para 51 (“However, the question remains whether a substantial part of the plaintiff’s work was copied. This question should be answered from the perspective of a person whose senses and knowledge allow him or her to fully assess and appreciate all relevant aspects – patent and latent – of the works at issue. In some cases, it may be necessary to go beyond the perspective of a lay person in the intended audience for the work, and to call upon an expert to place the trial judge in the shoes of ‘someone reasonably versed in the relevant art or technology’: Vaver, at p. 187.”) [*Cinar*].

<sup>5</sup> Jane Ginsburg, “The Concept of Authorship in Comparative Copyright Law” (2003) Columbia Law School, Public Law Research Paper No 03-51 at 4 (“Many of the latter contend that copyright, or *droit d’auteur*, obsoletely relies on the Romantic figure – or perhaps fiction – of the genius “auteur.” But we know today, indeed we probably have always known, that this character is neither so virtuosic, nor so individual, as the “Romantic” vision suggests.”).

<sup>6</sup> Frank Schechter, “The Rational Basis of Trademark Protection” (1927) 40 Harv L Rev 813 at 818 (“The fact that through his trademark the manufacturer or importer may “reach over the shoulder of the retailer” and across the latter’s counter straight to the consumer cannot be overemphasized, for therein lies the key to any effective scheme of trademark protection.”) [Schechter].

<sup>7</sup> Barton Beebe, “Search and Persuasion in Trademark Law” (2004) 103 Mich L Rev 2020 at 2025 (“The result is that trademark apologists – and plaintiffs – tend to adduce the sovereign when they speak of the basis of protection and the fool when they speak of the scope. Trademark restrictionists – and defendants – do the reverse. They adduce

*consumer* versus *the active co-creator of value*;<sup>8</sup> and, *the illiterate consumer* versus *the fluent consumer*.<sup>9</sup> Although the courts may find fictitious characters helpful in explaining and deciding complex issues, it is important to develop such characters in a consistent manner or risk undermining the credibility of the social construct.

I propose to look at the last aspect of trademark's fictitious character: what I call *the illiterate consumer* versus *the fluent consumer* (i.e., someone who does not understand the language used in the trademark being assessed versus someone who does). There is a gap in the literature when it comes to the linguistic knowledge of the trademark consumer. Most articles discussing the mind of the consumer make no mention of linguistic capability, as they focus on how a consumer perceives a mark,<sup>10</sup> differentiates one mark from another mark,<sup>11</sup> or participates in the development of a mark.<sup>12</sup> The literature coupling linguistics and trademarks do not discuss foreign languages, as they centre on how trademarks communicate meaning,<sup>13</sup> express ideas,<sup>14</sup>

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the fool when they speak of the basis, and the sovereign when they speak of the scope. Both camps thus suffer from, at the same time that they seek to exploit, what amounts to a dialectic in trademark theory, in which information and persuasion each contain within themselves the countervailing force of the other.” [Beebe].

<sup>8</sup> Alex Kozinski, “Trademarks Unplugged” (1993) 68 NYUL Rev 960 at 960 (“The originator must understand that the mark or symbol or image is no longer entirely its own, and that in some sense it also belongs to all those other minds who have received and integrated it.”); Rochelle Dreyfuss, “We Are Symbols and Inhibit Symbols, So Should We Be Paying Rent? Deconstructing the Lanham Act and Rights of Publicity” (1996) 20 Colum J L & Arts 123 at 129 (“At the least, the purveyor and the audience should be considered co-creators of the value. If rights are determined by the existence of value, then purveyors and audience should be treated as joint authors or co-inventors.”); Jessica Litman, “Breakfast with Batman: The Public Interest in the Advertising Age” (1999) 108 Yale LJ 1717 at 1730 (“If that’s so, however, Warner Brothers, Anheuser-Busch, R.J. Reynolds, and L’Oréal can hardly take all the credit. They built up all the mystique with their customers’ money and active collaboration.”).

<sup>9</sup> *Cheung Kong (Holdings) Ltd v Living Realty Inc* (1999), [2000] 2 FCR 501, 1999 CanLII 9394 (FCTD) at paras 53-54 (“Counsel for Cheung Kong was able to refer me to no decision holding that, in determining the question of confusion reasonably likely to be caused by a mark comprising foreign words or characters, the Registrar must consider the question from the perspective of an average consumer who understands the language in which the mark is expressed. Indeed, what authorities there are would seem to point in the opposite direction.”) [*Cheung Kong*].

<sup>10</sup> Lionel Bently, “From Communication to Thing: Historical Aspects of the Conceptualisation of Trade Marks as Property” (2007) University of Iowa Legal Studies Research Paper No 07-31 in Graeme Dinwoodie & Mark Janis, eds, *Trademarks Law and Theory: A Handbook of Contemporary Research* (Edward Elgar Publishers, 2008) 3.

<sup>11</sup> Beebe, *supra* note 7 at 2025.

<sup>12</sup> Deborah Gerhardt, “Consumer Investment in Trademarks” (2010) 88:3 NCL Rev 427 [Gerhardt].

<sup>13</sup> Graeme Dinwoodie, “What Linguistics Can Do for Trademark Law” in Lionel Bently et al, eds, *Trade Marks and Brands: An Interdisciplinary Critique* (New York: Cambridge University Press, 2008).

<sup>14</sup> Laura Heymann, “The Grammar of Trademarks” (2011) William & Mary Law School Research Paper No 09-67 in 14:4 Lewis & Clark L Rev.

identify source or provide information.<sup>15</sup> I propose to fill the gap regarding the linguistic knowledge of the trademark consumer in order to develop a workable model for assessing and comparing registered trademarks in a foreign language (*i.e.*, any language that is not an official language of the country assessing the trademark).

Part A of this dissertation tells the story of The Coca-Cola Company's trademark registrations in Canada in order to illustrate the linguistic issues faced by trademark administrators. A trademark's registrability depends on its distinctiveness, which is its ability to can distinguish its trader's goods and services from those of another trader.<sup>16</sup> Knowing how well a trademark will function to distinguish means ascertaining first what has already been registered, which is no easy task when the databases cannot administer foreign-language marks that are not Romanized. Part A proposes the solution of transcribing foreign-language marks that are not Romanized, so they can be filed/searched appropriately in databases.

Part B of this dissertation tells the story of two competing Chinese bakeries in Canada in order to illustrate the linguistic struggles of the judiciary. These struggles are nothing new, as academics have noted that “[l]ong before the introduction of the registration system [by what was then England in 1875], owners of marks containing terms in foreign languages or scripts could in certain circumstances prevent their use by trade rivals” and that by 1905 English and

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<sup>15</sup> Ariel Katz, “Beyond Search Costs: The Linguistic and Trust Functions of Trademarks” (2010) BYUL Rev 1555 [Katz].

<sup>16</sup> This is different from sumptuary laws that distinguish a person's class, as the trader selling the goods owns the trademark on the goods whereas the person buying the goods does not. Having said that, the distinguishing function of trademarks can add social value not just to goods but also to persons according to Barton Beebe, “Intellectual Property Law and the Sumptuary Code” (2010) 123:4 Harvard L Rev 809 at 813-814 (“Sumptuary law did not disappear with industrialization and democratization, as is generally believed. Rather, it has taken on a new – though still quite eccentric – form: intellectual property law. ... We are thus increasingly relying on intellectual property law not so much to enforce social hierarchy as simply to conserve – or in Pierre Bourdieu's terminology, to ‘reproduce’ – our system of consumption-based social distinction and the social structures and norms based upon it.”).

North American case law “has been fruitful of conflicting holdings.”<sup>17</sup> What is new in the 21<sup>st</sup> Century is the increasing frequency of foreign-language marks that are not Romanized, as the added complexity of foreign scripts makes it harder for courts to assess and compare trademarks that they cannot even read or sound out, much less understand. Part B proposes the solution of assuming linguistic knowledge for all foreign-language marks, so they can be assessed and compared appropriately in the case law.

Readers may find it odd for a dissertation to start from the practical to the theoretical (or from specific to general), but this approach seemed best in order to address factual assumptions that might later impede an appreciation of the legal issues. This is why the discussion of case law blatantly ignores cases comparing *two* foreign-language marks that are not Romanized. First, I intentionally chose cases comparing “COCA-COLA to 可口可樂” and “SAINT ANNA to 聖安娜” in order to illustrate how foreign-language marks that are not Romanized relate to those that are. Second, I intentionally chose cases containing English-language marks in order to point out linguistic assumptions or judicial errors because such marks do not blind and paralyze us with their “foreign-ness”. This dissertation is replete with examples in order to familiarize a non-Chinese reader<sup>18</sup> with the language from as many angles as possible so that the non-Chinese reader may be informed enough to assess the solutions being proposed (and to make counter-proposals).

Readers may also notice that this dissertation focuses on registered trademarks. First, there is no discussion of common law rights for unregistered trademarks. This ranges from the

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<sup>17</sup> Ellen Gredley, “Foreign-language Words as Trade Marks” in Norma Dawson & Alison Firth, eds, *Trade marks retrospective* (London: Sweet & Maxwell, 2000) 85 at 85-86 [Gredley].

<sup>18</sup> This dissertation apologizes in advance to any and all Chinese readers who are sure to criticize the examples by pointing out that Mandarin can have a fifth tone that is neutral, PinYin is not the only phonetic system that is Romanized, a generation name is not the same as a middle name technically, *etc.* Please understand that this dissertation generalizes the examples in order to minimize the time spent on factual issues (Chinese) in order to maximize the time for legal issues (trademarks).

tort of passing off and its statutory version in Canada's *Trademarks Act*<sup>19</sup> to other torts that cause economic injury, even without deception or confusion, and their statutory versions in Canada's *Competition Act*.<sup>20</sup> Second, there is no discussion of the copyright that may or may not be attached to trademarks. A simple example is the possibility of a copyright claim in respect of foreign-language marks that are automatically classified as design marks by the Canadian Trademarks Database.<sup>21</sup> A more complex example is claiming copyright for dead and obscure languages that cannot be trademarked, just as copyright claims were made for constructed and invented languages such as computer programming<sup>22</sup> and Klingon.<sup>23</sup>

In conclusion, the proposed model for assessing and comparing registered trademarks in a foreign language should be consistent with the purpose of trademark law:

“The purpose underlying any trademark statute was twofold. One was to protect the public so it may be confident that, in purchasing a product bearing a particular trademark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner of a trademark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its appropriation by pirates and cheats. This is the well-established rule of law protecting both the public and the trademark owner.”<sup>24</sup>

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<sup>19</sup> *Trade-marks Act*, RSC 1985, c T-13 [*Trademarks Act*].

<sup>20</sup> *Competition Act*, RSC 1985, c C-34.

<sup>21</sup> David Vaver, *Intellectual Property Law: Copyright, Patents, Trademarks*, 2nd ed (Toronto: Irwin Law, 2011) at 81 (“Even signatures such as Pablo Picasso’s or those drawn or painted in Chinese or Japanese calligraphy may qualify, although most people write, rather than do art, when they sign.”) discussed cases recognizing copyright in *Australian Chinese Newspapers Pty Ltd v Melbourne Chinese Pty Ltd*, [2003] FCA 878 (Austl Fed Ct), aff’d [2004] FCAFC 201 (Austl Full Fed Ct); *Picasso, succession v PRC Inc*, [1996] FCJ No 969; *Anne Frank TM*, [1998] RPC 379 (UKTMO) [Vaver].

<sup>22</sup> *Oracle America, Inc v Google Inc*, 750 F (3d) 1339 (Fed Cir 2014) [*Oracle*].

<sup>23</sup> *Paramount Pictures Corporation and CBS Studios Inc v Axanar Productions, Inc*, Case No 2:15-cv-09938-RGK-E, Document 1, Filed 12/29/15 [*Paramount*].

<sup>24</sup> United States Senate Report No 79-1333 at 3 (1946), as reprinted in 1946 USCCAN 1274, 1277.

Therefore, the administrative and judicial solutions proposed in the following chapters are workable only to the extent that they support the paragraph quoted above. Their credibility depends on how well they serve the dual purposes of trademark law in protecting the consumer from confusion and the trader from unfair competition.<sup>25</sup>

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<sup>25</sup> Frank Schechter, *The Historical Foundations of the Law Relating to Trade-Marks* (New York: Columbia 1925) at 20-21 [Schechter on *The Historical Foundations*].



# 1 ADMINISTRATIVE PROBLEM

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It was 1975. The Internet did not exist. E-commerce was unheard of. The World Trade Organization had not been established. The Agreement on Trade-Related Aspects of Intellectual Property Rights was inconceivable. It would be another four years before the restoration of Chinese-American foreign relations, when The Coca-Cola Company would become the first international business to re-enter China as a result.<sup>26</sup>

Yet, 1975 was when The Coca-Cola Company started trademarking the Chinese translations of its products. That was the year it filed Canadian applications for four trademarks in Chinese, all of which were registered shortly thereafter. Alas! Although the business world was ready to embrace the economic benefits of recognizing foreign languages, the administrative and judicial systems were slower to identify and resolve the challenges related to doing so.

This chapter compares the trademark registrations in Canada for COCA-COLA and its Chinese equivalent in order to illustrate the administrative challenge of classifying foreign-language marks (*e.g.*, trademarks not in Canada's official languages of English or French) that are not Romanized.

## **1.1 The Problem of Classifying Foreign-Language Marks that are not Romanized**

The Canadian Trademarks Database classifies trademarks as either word marks or design marks. Only trademarks consisting of letters, numerals, French accents and common punctuation

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<sup>26</sup> “Celebrating 35 Years of Coca-Cola in China”, The Coca-Cola Company (24 Nov 2014), online: <<http://www.coca-colacompany.com/stories/celebrating-35-years-of-coca-cola-in-china>>. Although The Coca-Cola Company signed its historic agreement with the Chinese government on December 13, 1978, its first shipment to China was not until January 1979 [“Celebrating 35 Years”].

marks are classified as word marks.<sup>27</sup> All other trademarks are classified automatically as design marks. This means any foreign-language mark that are not Romanized is deemed to be a design mark, even if the trademark is actually a word in the foreign language. For example, the English letters COCA-COLA would be considered a word mark, but the equivalent Chinese characters 可口可樂 would be considered a design mark. This automatic classification of all foreign-language marks that are not Romanized as design marks has more than trivial administrative consequences.

One serious consequence is how the automatic classification handicaps the protection of the trademark. Word marks are protected even where used in a different font, size, and colour from their registrations.<sup>28</sup> The protection extended to design marks is more limited: they must be registered as used, and they must be used as registered. This means that “with every variation the owner of the trade mark is playing with fire. In the words of Maclean P., ‘the practice of departing from the precise form of a trademark as registered is objectionable, and is very dangerous to the registrant’.”<sup>29</sup> Similarly, a competitor may use a design mark differently from the one registered and so not infringe the trader’s rights – or at least have a better argument that he is not infringing those rights than in the comparable case of the use of a word mark.

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<sup>27</sup> Canadian Intellectual Property Office, *Trademarks Examination Manual* (Ottawa: Innovation, Science and Economic Development Canada, 20 October 2016) at 2 of 5, online: <<https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr03634.html#ii.3>>. Section II.5.3 states, “A trademark is considered to be a word mark that is not in special form if it consists of:

- a. A word or words in upper case letter.
- b. A word of words including lower case letters.
- c. A word or words including numerals.
- d. A word or words including French accents.
- e. A word or words including any of the punctuation marks found on standard English or French keyboards.”

<sup>28</sup> *Bill C-31, An Act to implement certain provisions of the budget tabled in Parliament on February 11, 2014 and other measures (Economic Action Plan 2014, No. 1)*, 2nd Sess, 41st Parl, 2014, cl 339 (assented to June 19, 2014) (**Sections 30 to 33 of the Act are replaced by the following: Standard characters** – “31. An applicant who seeks to register a trademark that consists only of letters, numerals, punctuation marks, diacritics or typographical symbols, or any combination of them, without limiting the trademark to any particular font, size or colour shall ...”) [*Bill C-31*].



<sup>29</sup> *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 at 70, [1992] FCJ No 611 (QL) (FCA).

The difference in protection afforded to word marks versus design marks is a handicap to foreign-language marks that are not Romanized, as many of them can be written in a variety of ways. For example, the chart below shows how Chinese can be written in different directions, different scripts, or different fonts. This leads to a discrepancy where the English letters COCA-COLA need to be registered only once with minimal cost to receive full protection, but the equivalent Chinese characters 可口可樂 need to be registered multiple times with increased costs to receive the equivalent protection. Failure to do so could lead to unfavourable findings of lack of use in expungement proceedings<sup>30</sup> or lack of confusion in infringement proceedings.<sup>31</sup>

<p>1. Chinese was traditionally written in a vertical manner, and read from right to left. The English equivalent is:</p> <p>C O C A - C O L A</p>	
<p>2. Chinese can still be read from right to left, even after it became acceptable to write it in a horizontal manner. The English equivalent is:</p> <p><b>ALOC-ACOC</b></p>	

<sup>30</sup> *Trademarks Act, supra* note 19, s 45(3) (**Effect of non-use** – “Where, by reason of the evidence furnished to the Registrar or the failure to furnish any evidence, it appears to the Registrar that a trade-mark, either with respect to all of the goods or services specified in the registration or with respect to any of those goods or services, was not used in Canada at any time during the three year period immediately preceding the date of the notice and that the absence of use has not been due to special circumstances that excuse the absence of use, the registration of the trade-mark is liable to be expunged or amended accordingly.”).

<sup>31</sup> *Trademarks Act, supra* note 19, s 20(1) (**Infringement** – “The right of the owner of a registered trademark to its exclusive use is deemed to be infringed by any person who is not entitled to its use under this Act and who (a) sells, distributes or advertises any goods or services in association with a confusing trademark or trade-name; (b) manufactures, causes to be manufactured, possesses, imports, exports or attempts to export any goods in association with a confusing trademark or trade-name, ...”).

<p>3. Chinese can now be read from left to right, in addition to it being acceptable to write it in a horizontal manner. The English equivalent is:</p> <p><b>COCA-COLA</b></p>	
<p>4. Chinese can also be written using traditional script or simplified script. The result is that many (but not all) Chinese characters can now be written in two ways. While not equivalent, an English example is:</p> <p><b>coca-cola</b></p> <p>English can be written in capital letters or non-capital letters. The result is that many (but not all) English letters can be written in two ways. A consumer with no understanding of English would not know that A=a or that L=l.</p>	<p>可口可樂 (Traditional Script, as shown in the three pictures above)</p> <p>可口可樂 (Simplified Script, as shown in the picture below)</p>
<p>5. Chinese can also be written using different fonts, in the same way that English is written using different fonts.</p> <p>This is a culture that writes auspicious Chinese characters such as “Blessing” or “Longevity” in 100 different ways as a calligraphy exercise, and then presents it as a gift to an esteemed recipient.</p>	

Another serious consequence is how the automatic classification impedes the filing/searching of foreign-language marks that are not Romanized. A trademarks database provides the public with information as to “what sign is protected and in which commercial spheres it is to be protected” in order to reduce disputes and increase certainty for traders.<sup>32</sup> However, this requires that the filing/searching functions of the database enable traders to communicate the scope of their claims to the world, as “economic operators must, with clarity and precision, be able to find out about registrations or applications for registration made by their

<sup>32</sup> Lionel Bently & Brad Sherman, *Intellectual Property Law*, 2nd ed (New York: Oxford University Press, 2004) at 765 [Bently & Sherman].

current or potential competitors and thus to receive relevant information about the rights of third parties.”<sup>33</sup>

The Canadian database currently impedes the filing/searching foreign-language marks that are not Romanized. For example, a search for the English letters COCA-COLA produces the actual trademark along with other similarities. This enables The Coca-Cola Company to monitor for applications that may infringe its trademark. It also enables other trademark applicants to find out whether or not the English letters COCA-COLA are already claimed, by whom, since when, in association with what goods and services, *etc.*, in order to assess whether what they plan to do may be legally objectionable and, if so, what alternative trademarks can be claimed instead. Contrast the scenario above with a search for the equivalent Chinese characters 可 □ 可 樂. The Coca-Cola Company cannot monitor for applications without expertise or expense, as only an experienced searcher would know how to find trademarks that cannot be filed alphabetically. Other trademark applicants trying to find out whether or not the equivalent Chinese characters 可 □ 可 樂 are already claimed will find themselves searching for a needle in a haystack, unless they have the good fortune of narrowing the search by already knowing who might be the registrant or what might be the goods and services claimed. This is because all Chinese-language marks in the Canadian database are indexed under the unhelpful descriptive reference of “CHINESE CHARACTER DESIGN”.

The problem of classifying foreign-language marks that are not Romanized also impacts the discussion in Part B, as the test for confusion depends on the similarity between a registered trademark and a second trademark (instead of whether or not the second trader intended to create

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<sup>33</sup> *Sieckmann v Deutsches Patent-Und Markenamt*, [2003] RCP 38 in NG-LOY Wee Loon, “The IP Chapter in the US-Singapore Free Trade Agreement” (2004) 16 Sing Ac LJ 42 at 50.

confusion between the two).<sup>34</sup> Notwithstanding that the absence of intent is inconclusive, it increasingly appears that the presence of intent is persuasive.<sup>35</sup> This is all the more reason why the second trader must exercise due diligence to avoid confusion with other trademarks by searching the trademarks database. The chapter below explains why this problem is best addressed with the solution of transcribing foreign-language marks that are not Romanized.

## **1.2 The Problem is Widespread in Canada**

Although this chapter compares the trademark registrations for COCA-COLA and its Chinese equivalent, it is important to remember that this is only one example to illustrate the administrative challenge of classifying foreign-language marks that are not Romanized. The chart below illustrates how the problem is widespread in Canada, as Chinese is only one of many non-Romanized languages.

<b>Non-Romanized Languages</b>	<b>Number of Trademark Filings in the Canadian Trademarks Database</b>
Arabic <sup>36</sup>	549
Chinese <sup>37</sup>	6,449

<sup>34</sup> *Ciba-Geigy Canada Ltd v Apotex Inc*, [1992] 3 SCR 120, 1992 CanLII 33 (“... attention should be drawn to the fact that the passing off rule is founded upon the tort of deceit, and while the original requirement of an intent to deceive died out in the mid-1800’s, there remains the requirement, at the very least, that confusion in the minds of the public be a likely consequence by reason of the sale, or proffering for sale, by the defendant of a product not that of the plaintiff’s making, under the guise or implication that it was the plaintiff’s product or the equivalent.”). And see *Mattel Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 at para 90 (“Mens rea is of little relevance to the issue of confusion.”) [*Mattel*].

<sup>35</sup> *Mattel*, *supra* note 34 at para 90 (“If, as the appellant says, the respondent’s activities have trespassed on the marketing territory fenced off by its BARBIE trade-marks, it would be no defence for the respondent that it did not intend to trespass. Equally, however, if the respondent’s activities did not in fact trespass, evidence that it may have wished to do so does not constitute confusion: *Fox*, at p. 403. Historically, courts have been slow to conclude that a demonstrated piratical intent has failed to achieve its purpose ...”). And see *United Airlines, Inc v Cooperstock*, 2017 FC 616 at para 68 (“While intent is not determinative in that its absence is not a defence to trademark infringement, its presence can be a relevant factor ...”).

<sup>36</sup> “Search Criteria ‘Arabic’ in Foreign Character Translation”, Canadian Trademarks Database (last modified 22 June 2017), online: <<http://www.ic.gc.ca/app/opic-cipo/trdmrks/srch/home?lang=eng>>.

Greek <sup>38</sup>	230
Hebrew <sup>39</sup>	107
Inuktitut <sup>40</sup> (as an example of an Aboriginal language)	26
Japanese <sup>41</sup>	1,204
Korean <sup>42</sup>	344
Russian <sup>43</sup>	126
Sanskrit <sup>44</sup>	114

Historically, Canada may not have felt the need to identify and resolve challenges arising from foreign-language marks since its economy was driven by auto and manufacturing with exports to the United States, its largest trading partner. Increasingly, however, Canada's economy is driven by energy and resources with exports to China and other non-American economies. Furthermore, Canada is doubling its visa offices in China in order to boost its economy by increasing Chinese tourists, students, and immigrants.<sup>45</sup> With China as the world's largest spender in international tourism and the fastest-growing source of international students,

<sup>37</sup> "Search Criteria 'Chinese' in Foreign Character Translation", Canadian Trademarks Database (last modified 22 June 2017), online: <<http://www.ic.gc.ca/app/opic-cipo/trdmrks/srch/home?lang=eng>>.

<sup>38</sup> "Search Criteria 'Greek' in Foreign Character Translation", Canadian Trademarks Database (last modified 22 June 2017), online: <<http://www.ic.gc.ca/app/opic-cipo/trdmrks/srch/home?lang=eng>>.

<sup>39</sup> "Search Criteria 'Hebrew' in Foreign Character Translation", Canadian Trademarks Database (last modified 22 June 2017), online: <<http://www.ic.gc.ca/app/opic-cipo/trdmrks/srch/home?lang=eng>>.

<sup>40</sup> "Search Criteria 'Inuktitut' in Foreign Character Translation", Canadian Trademarks Database (last modified 22 June 2017), online: <<http://www.ic.gc.ca/app/opic-cipo/trdmrks/srch/home?lang=eng>>.

<sup>41</sup> "Search Criteria 'Japanese' in Foreign Character Translation", Canadian Trademarks Database (last modified 22 June 2017), online: <<http://www.ic.gc.ca/app/opic-cipo/trdmrks/srch/home?lang=eng>>.

<sup>42</sup> "Search Criteria 'Korean' in Foreign Character Translation", Canadian Trademarks Database (last modified 22 June 2017), online: <<http://www.ic.gc.ca/app/opic-cipo/trdmrks/srch/home?lang=eng>>.

<sup>43</sup> "Search Criteria 'Russian' in Foreign Character Translation", Canadian Trademarks Database (last modified 22 June 2017), online: <<http://www.ic.gc.ca/app/opic-cipo/trdmrks/srch/home?lang=eng>>.

<sup>44</sup> "Search Criteria 'Sanskrit' in Foreign Character Translation", Canadian Trademarks Database (last modified 22 June 2017), online: <<http://www.ic.gc.ca/app/opic-cipo/trdmrks/srch/home?lang=eng>>.

<sup>45</sup> Susana Mas, "Canada seeks to double visa offices in China to attract more high-skilled workers", CBC News (10 August 2016), online: <<http://www.cbc.ca/news/politics/canada-china-visa-offices-foreign-workers-1.3714991>>.

Canada is looking to attract a larger share of the \$102 billion that 83 million Chinese tourists spent in 2012 and to double the \$8 billion that international students spent in 2010 by 2022.<sup>46</sup> And just as China was convinced in 1978 that it needed to offer COCA-COLA if it wanted to attract Western tourists,<sup>47</sup> the West realizes now that it needs Chinese brands to attract Chinese consumers. Although brand extension<sup>48</sup> or cross-branding<sup>49</sup> in order to access new untapped markets is nothing new, what is new in the 21<sup>st</sup> Century is for Western businesses to try the same with Chinese brands:<sup>50</sup>

- In 1998, Torstar Corporation acquired an interest in Sing Tao. Canada's largest daily newspaper targeted the advertising dollars to be made from the Chinese readers.
- In 2008, The Coca-Cola Company bid unsuccessfully to buy HuiYuan for \$2.4 billion American. The world's most valuable brand coveted China's leading pure juice brand.
- In 2008, Hermès created Shang Xia. The French luxury brand hoped to pursue the fastest-growing group of billionaires and millionaires in the world.
- In 2009, Loblaws bought T&T Supermarket for \$225 million Canadian. Canada's largest grocery chain looked to expand into the country's fastest-growing market.

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<sup>46</sup> Canada, Minister of International Trade, *International Education: A Key Driver of Canada's Future Prosperity* (Ottawa: Foreign Affairs, Trade and Development Canada, 2012) at 4, online: <<http://www.international.gc.ca/education/report-rapport/strategy-strategie/index.aspx?lang=eng&view=d>>.

<sup>47</sup> "Celebrating 35 Years", *supra* note 26. The historic agreement signed with the Chinese government on December 13, 1978 permitted The Coca-Cola Company to sell its products only to tourists in international hotels and foreign stores, but not to the local Chinese.

<sup>48</sup> Brand extension is using the same trademark with new goods or services: The Coca-Cola Company decided to add health drinks to its carbonated sodas, Ikea expanded from selling home decorations to making prefabricated houses, and Oprah went from hosting a television talk show to publishing a lifestyle magazine.

<sup>49</sup> Cross-branding is combining two trademarks: Dell uses INTEL chips in its computers, McDonald's includes DISNEY toys with its meals, and KFC sells PEPSI drinks in its combos.

<sup>50</sup> It is possible that there was brand extension and cross-branding in Asia before the 21<sup>st</sup> Century, and that the trend is spreading to the West only now. After all, cosmopolitan cities such as Singapore and Hong Kong have long had Chinese speakers mingling alongside English speakers.



- In 2010, AT&T collaborated on film projects with Wong Fu Productions. The American telecommunications giant aimed for the film company's then 2 million YouTube subscribers.
- In 2011, the New York Knicks acquired Jeremy Lin. The move later led to sold-out game tickets, increased merchandise sales, and higher stock prices due to the "Linsanity" effect. Since then, Jeremy Lin has gone on to file trademark applications for JLIN, JEREMY LIN, and LINSANITY in English and their Chinese equivalents.
- In 2012, Heineken bought the Tiger beer brand for €4.7 billion. The Dutch brewing company paid top dollar for the Singaporean local beer because it believed there would be high returns on a premium Chinese market expected to grow by 12% annually through 2020.
- In 2013, L'Oréal bought Magic Holdings for \$6.54 billion Hong Kong. The world's largest cosmetic company also paid handsomely for the Chinese beauty brand with double-digit annual growth.
- In 2014, Canada Post partnered with China Post. The Canadian government learnt from the Royal Canadian Mint's success in marketing coins and stamps with auspicious Chinese words and zodiacs.
- In 2015, Dentons merged with Dacheng. The merger established the world's largest law firm, with more than 6,500 lawyers in more than 50 countries.

### **1.3 The Problem is Widespread Internationally**

Although this chapter compares trademark registrations in Canada, it is important to remember that this is only one example to illustrate the administrative challenge of classifying foreign-language marks that are not Romanized. The problem is just as widespread internationally, as illustrated by both Western and Asian countries with official languages that are only Romanized (the United States), both Romanized and not Romanized (the European Union and Singapore), and only not Romanized (China).

The United States has only one official language: English. Similar to Canada, it also restricts word marks to the standard characters of letters, numerals, punctuation or diacritical marks.<sup>51</sup> And just like Canada, the American database also requires translation and transliteration<sup>52</sup> for foreign-language marks that are not Romanized, but neither specifies that the transliteration be based on international standards for consistency nor uses the transliteration as index headings for filing/searching.<sup>53</sup>

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<sup>51</sup> *Rules of Practice in Trademark Cases*, 37 CFR §2.52 ((a) **Standard character (typed) drawing** –“Applicants who seek to register words, letters, numbers, or any combination thereof without claim to any particular font style, size, or color must submit a standard character drawing that shows the mark in black on a white background. An applicant may submit a standard character drawing if:

- (1) The applicant includes a statement that the mark is in standard characters and no claim is made to any particular font style, size, or color;
- (2) The mark does not include a design element;
- (3) All letters and words in the mark are depicted in Latin characters;
- (4) All numbers in the mark are depicted in Roman or Arabic numerals; and
- (5) The marks includes only common punctuation or diacritical marks.”).

<sup>52</sup> *The Oxford English Dictionary*, 3rd ed, *sub verbo* “Translation: The process of translating words or text from one language into another.” Transliteration is a specific type of translation, in that a transliteration is a phonetic translation based on sounds (instead of based on meaning). This dissertation will use the general term “translation” unless referring specifically to transliterations.

<sup>53</sup> *Rules of Practice in Trademark Cases*, 37 CFR §2.32 (**Requirements for a complete trademark or service mark application** – (a) The application must be in English and include the following: ...

- (8) If the mark is not in standard characters, a description of the mark;
- (9) If the mark includes non-English wording, an English translation of that wording; and
- (10) If the mark includes non-Latin characters, a transliteration of those characters; and either a translation of the transliterated term in English, or a statement that the transliterated term has no meaning in English.”).

The European Union currently represents 28 member countries<sup>54</sup> and has 24 official languages.<sup>55</sup> There are fewer languages because some member countries share the same official languages. Similar to Canada and the United States, the European Union also restricts word marks to trademarks consisting of letters, numerals, keyboard signs and punctuation marks in any official European Union language.<sup>56</sup> And just like Canada and the United States, the European database also differentiates between words and designs in their protection.<sup>57</sup> However, its ability to classify word marks in its official languages of Bulgarian and Greek (which are not Romanized) has not stopped it from classifying foreign-language marks that are not Romanized as design marks. This inequality has a simple explanation: the European Union can classify trademarks in non-Romanized languages properly as word marks only if the non-Romanized language is an official language, as only then would it already have examiners who can read and write the language.

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<sup>54</sup> “Member countries of the EU”, European Union (7 June 2016), online: <[https://europa.eu/european-union/about-eu/countries\\_en](https://europa.eu/european-union/about-eu/countries_en)>. The 28 member countries are Austria 1995, Belgium 1958, Bulgaria 2007, Croatia 2013, Cyprus 2004, Czech Republic 2004, Denmark 1973, Estonia 2004, Finland 1995, France 1958, Germany 1958, Greece 1981, Hungary 2004, Ireland 1973, Italy 1958, Latvia 2004, Lithuania 2004, Luxembourg 1958, Malta 2004, Netherlands 1958, Poland 2004, Portugal 1986, Romania 2007, Slovakia 2004, Slovenia 2004, Spain 1986, Sweden 1995, and the United Kingdom 1973.

<sup>55</sup> “Official EU Languages”, European Commission (7 June 2016), online: <[http://ec.europa.eu/dgs/translation/translating/officiallanguages/index\\_en.htm](http://ec.europa.eu/dgs/translation/translating/officiallanguages/index_en.htm)>. The 24 official languages are Bulgarian 2007, Croatian 2013, Czech 2004, Danish 1973, Dutch 1958, English 1973, Estonian 2004, Finnish 1995, French 1958, German 1958, Greek 1981, Hungarian 2004, Irish 2007, Italian 1958, Latvian 2004, Lithuanian 2004, Maltese 2004, Polish 2004, Portuguese 1986, Romanian 2007, Slovak 2004, Slovenian 2004, Spanish 1986, and Swedish 1995.

<sup>56</sup> *Decision No EX-13-5 of the President of the Office of 4 December 2013 adopting the Guidelines for Examination in the Office for Harmonization in the Internal Market (Trade Marks and Designs) on Community Trade Marks and on Registered Community Designs* at para 9.1 (“A word mark is a typewritten mark with elements including letters (either lowercase or uppercase), words (either in lowercase or uppercase letters), numerals, keyboard signs or punctuation marks written across a single line. The Office accepts the alphabet from any official EU language as a word mark.”).

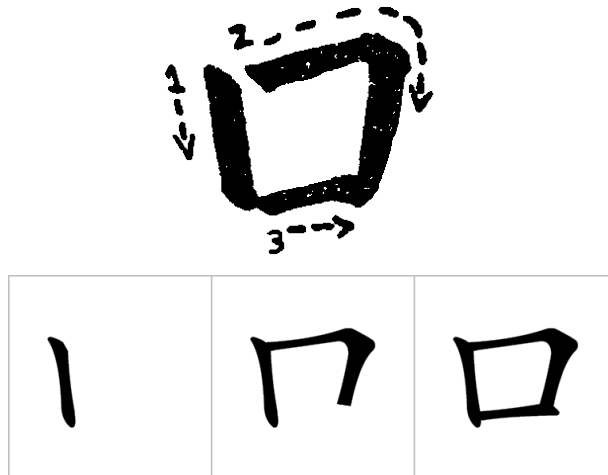
<sup>57</sup> *Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark*, Article 1, Rule 3(1) (“If the applicant does not wish to claim any special graphic feature or colour, the mark shall be reproduced in normal script, as for example, by typing the letters, numerals and signs in the application. The use of small letters and capital letters shall be permitted and shall be followed accordingly in publications of the mark and in the registration by the Office.”).

Singapore is similar to the European Union in that it has 4 official languages: Chinese, English, Malay and Tamil. The reason why Singapore can classify trademarks in Chinese and Tamil properly is the same as why the European Union can classify trademarks in Bulgarian and Greek as word marks: they already have examiners who understand those official languages, and their trademark databases are designed to accept those linguistic inputs. However, the Singaporean database will not accept inputs in Bulgarian or Greek any more than the European database will accept inputs in Chinese or Tamil.

China is similar to the United States in that it has only one official language: Chinese. However, its special characteristic as a country with an official language that is *not* Romanized has not resulted in it classifying foreign-language marks that *are* Romanized as design marks. So why is it that China can classify English-language marks properly while the Western databases above cannot reciprocate by classifying Chinese-language marks in the same manner? This inequality has a simple explanation: a Chinese speaker who does not understand English only needs to learn the 26 letters of the alphabet in order to file/search for such marks. However, it is not as easy for Westerners who do not understand Chinese. The Chinese language breaks each Chinese character down into components made up of radicals and strokes. For example, a search for C-O-C-A C-O-L-A requires learning a simple alphabet system, but a search for a Chinese character requires learning a complicated radical and stroke system. The pictures<sup>58</sup> below illustrate the strokes for the second character (which only has one component, as the character itself is a radical) in 可 □ 可 樂:

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<sup>58</sup> Michael Hurwitz, “Top 9 Funniest Chinese Homophones”, YoYo Chinese Taught in Plain English (4 May, 2015), online: <<http://www.yoyochinese.com/blog/Top-9-Funniest-Chinese-Homophones-0>>.



Suffice it to say, China's ability to classify foreign-language marks that *are* Romanized does not help it with respect to foreign-language marks that are *not* Romanized. This means that China has the same administrative challenges as the Singaporean database has with Bulgarian or Greek, and as the European database has with Tamil.

It is clear from this chapter that the trademark registrations in Canada for COCA-COLA and its Chinese equivalent illustrate an administrative challenge of classifying foreign-language marks that affect all countries with respect to all non-Romanized languages.

# 2 ADMINISTRATIVE SOLUTION

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This chapter explains why the problem of classifying foreign-language marks that are not Romanized is best addressed with the solution of transcribing such marks. Although the solution is illustrated through the specific example of trademark registrations in Canada for COCA-COLA and its Chinese equivalent, the general principle can be applied in other countries and to other non-Romanized languages.

## **2.1 The Solution of Transcribing Foreign-Language Marks that are not Romanized**

The Canadian Trademarks Database can easily classify foreign-language marks as word marks where appropriate. All it has to do is transcribe foreign-language marks that are not Romanized, and use what is transcribed to file/search for them in the same manner as English-language marks. Transcribing foreign-language marks that are not Romanized can be done by using the official phonetic system provided by the International Organization for Standardization.<sup>59</sup> For example, the official phonetic system adopted in 1982 for transcribing Chinese would Romanize 可口可樂 as KE3 KOU3 KE3 LE4. Even though an English speaker still cannot understand or pronounce the word mark, at least the person can now read and write the letters and numerals in order to file/search for the word mark.

The section below will replicate three selected portions of the trademark registrations in order to illustrate how this is all that the public needs in order to find out whether or not a trademark is claimed already, by whom, since when, in association with what goods and services,

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<sup>59</sup> “Standards Catalogue, 01.140.10: Writing and Transliteration”, International Organization for Standardization (undated), online:  
<[http://www.iso.org/iso/home/store/catalogue\\_ics/catalogue\\_ics\\_browse.htm?ICS1=1&ICS2=140&ICS3=10](http://www.iso.org/iso/home/store/catalogue_ics/catalogue_ics_browse.htm?ICS1=1&ICS2=140&ICS3=10)>.

*etc.*, in order to assess whether what they plan to do may be legally objectionable and, if so, what alternative trademarks can be claimed instead.

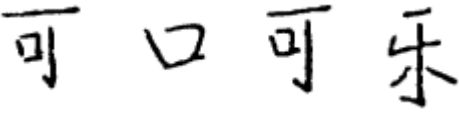
## **2.2 The Solution as Illustrated by the Foreign-Language Marks for COCA-COLA**

The first thing someone will notice when comparing trademarks is their degree of resemblance in appearance. The chart below shows how the trademark application in 1932 for COCA-COLA already had the standard font, whereas the trademark application in 1975 for its Chinese equivalent still failed to exemplify any such requirement. While this does not matter when comparing COCA-COLA to its Chinese equivalent, it makes an important difference when comparing two Chinese-language marks. Someone who does not understand Chinese can still compare two Chinese-language marks for appearance in the same way he would have compared two drawings of Disney's signature, but only if the comparisons were based on the same script and font.

It is understandable that lawyers with little exposure to foreign languages might be unaware that cellphones and computers can provide a standard font for the foreign characters. The technology to do so already exists even with cellphones and computers that only have English-language keyboards with QWERTY layouts. It is also reasonable for traders with little understanding of the law to fail to realize the negative ramifications of registering a hand scribble on a paper scrap. The Canadian database, however, can resolve this solicitor-client miscommunication by requiring that foreign-language marks that are not Romanized be provided in a standard font.

In this regard, The Coca-Cola Company is becoming savvier, as its two latest trademark applications in 2013 for additional Chinese-language marks have evolved from hand scribbles to

standard fonts. The Canadian database, however, continues to classify them automatically as design marks.

<p><b><u>TRADE MARK (Word):</u></b> <b>COCA-COLA</b></p>	<p><b><u>TRADE MARK (Design):</u></b> </p> <p>The above is replicated and amended below in order to match the standard font used for English-language marks, such COCA-COLA on the left. This amendment will make it easier to compare for any resemblance in appearance.</p> <p><b><u>TRADE MARK (Word):</u></b> 可口可樂</p>
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The second thing someone will notice when comparing trademarks is their degree of resemblance in sound. The chart below shows how the trademark application for COCA-COLA already had index headings to “identify all word components of the trademark”,<sup>60</sup> which enabled English-language marks to be filed/searched for alphabetically; whereas, the trademark application for its Chinese equivalent only had the descriptive reference of “CHINESE CHARACTER DESIGN”, which was how Chinese-language marks were filed and why searching for them were difficult.

Kaley Cuoco is an American actress who is popular with Asian fans. She had the Chinese word for “faith” tattooed on her lower back. Imagine that she also decides to adopt a Chinese name and to register it as a trademark for merchandise licensing. If she were to follow the Chinese tradition of having the surname precede the given name, she would look for the Chinese

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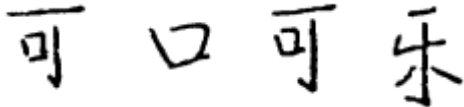
<sup>60</sup> Canadian Intellectual Property Office, “Searchable Fields – Index Headings” (Ottawa: Innovation, Science and Economic Development Canada, 16 December 2015), online: <<http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr03106.html#ind>>.



equivalent of CUOCO KALEY. One possibility is 可口樂, which sounds similar to the English given its pronunciation of KOU3 KOU3 KE3 LE4. But how can this actress and her lawyer exercise due diligence to avoid confusion with other trademarks when all Chinese-language marks are given the unhelpful descriptive reference of “CHINESE CHARACTER DESIGN”? It would be better if Chinese-language marks were indexed based on the official phonetic system. Then a search for KOU3 KOU3 KE3 LE4 would bring up the similar-sounding KE3 KOU3 KE3 LE4, which would alert this actress to the existence of the Chinese-language marks for COCA-COLA.

The reason for the numerals is that the Chinese language is spoken usually with four standard tones: flat –, rising /, dipping \/, and falling \ (and there could be additional tones for some dialects). Since the Canadian database is not set up to depict this, the four standard tones can also be transcribed into numerals: 1, 2, 3, and 4. While non-Chinese speakers cannot differentiate the tones, just as non-English speakers cannot hear the nuances between the names JON, JONE/JOAN, or JOANNE, the multiple tones are significant because they result in giving one sound multiple meanings. For example, KOU1 means “to dig”, KOU2 does not refer to any character and has no meaning, KOU3 refers to the second character in 可口樂 and means “mouth”, and KOU4 means “to knock”. It is recommended to transcribe both the sounds and the tones in order to provide as much information as possible in order to compare trademarks for their resemblance in sound. And it is recommended to require audio files for all foreign-language marks in order to make the database as useful as possible. On the other hand, Canada might decide that there is no need for too many details at the administrative level, as there will always be an opportunity for opposing counsel and linguistic experts to provide detailed evidence if and when there are opposition, expungement, or infringement proceedings.

In this regard, The Coca-Cola Company’s two latest trademark applications in 2013 have evolved to the more helpful descriptive references of “PULPY ORANGE in Chinese” and “MINUTE MAID in Chinese”. The good news is that the applications provided the transcribed sounds, but the bad news is that the Canadian database still filed them under their translations instead. Although it is understandable for the Canadian database to rely on the English translations because they are more meaningful to an English speaker, such reliance is unwise given that the English translations can be arbitrary and manipulated in order to avoid detection of confusion. It would be more helpful to file/search for Chinese-language marks based on their unique and immutable sounds instead of their multiple and variable translations. This is because using the official phonetic system will result in consistent searches to catch confusing trademarks. However, it is important to remember that the transcribed sounds are only being used as index headings and that they are not being registered. Therefore, a trademark registration for 可口可樂 is not the same thing as a trademark registration for KE3 KOU3 KE3 LE4, even if a trademark application for the former includes the latter for informational purposes.

<p><b><u>TRADE MARK (Word):</u></b> <b>COCA-COLA</b></p>	<p><b><u>TRADE MARK (Design):</u></b>  </p>
<p><b><u>INDEX HEADINGS:</u></b> COCA-COLA</p>	<p><b><u>MARK DESCRIPTIVE REFERENCE:</u></b> CHINESE CHARACTER DESIGN</p> <p>The above is replicated and amended below in order to match the alphabetization used for English-language marks, such as COCA-COLA on the left. This amendment will make it easier to compare for any resemblance in sound.</p> <p><b><u>INDEX HEADINGS:</u></b> KE3 KOU3 KE3 LE4</p>

The third thing someone will notice when comparing trademarks is their degree of resemblance in the ideas suggested by them. The chart below shows how the meaning of COCA-COLA is understood inherently, whereas its Chinese equivalent needs to be translated. The problem is that translations can vary, which means the resulting comparisons can differ.

If Kaley Cuoco were to translate her Chinese name 可口可樂 literally as “mouth mouth possible happy”, then it would obviously resemble Coca-Cola’s literal translation for 可口可樂 as “possible mouth possible happy”. This would be like finding a resemblance between JON and JOHN as male names. Alternatively, if she were to translate it instead colloquially as “happiness with every word” in reference to her bubbly personality as a comedian, then it would have less resemblance to the soda’s meaning of “delicious happiness”. This would be akin to differentiating between JONATHAN and JACK, which a non-English speaker would not know culturally refers to JON and JOHN respectively. Finally, she could argue there is no resemblance in the meanings whatsoever by pointing out that her Chinese-language mark translates as CUOCO KALEY while the other is the standard translation for COCA-COLA. The same argument can be made that there is no resemblance between JON and JOHN, as the former has the standard meaning of “God has given or a gift from God”, whereas the latter means “God is gracious” or is slang for “a toilet or a prostitute’s client”.<sup>61</sup>

It is recommended to provide both the literal translation of each character and the adopted translation of the combined characters in order to provide as much information as possible in order to compare trademarks for their resemblance in the ideas suggested by them. And it is

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<sup>61</sup> Although this argument seems unlikely in the abstract – but may be more likely depending on the nature of goods or services with which the marks are associated – the point is that Chinese names can give rise to various literal, colloquial, or cultural meanings in the same manner as English names can.

recommended to require the simplified script if the trademark uses traditional script (or vice versa) in order to make the database as useful as possible. On the other hand, Canada might decide that there is no need to detail the adopted translation at the administrative level if translations can be arbitrary and manipulated in order to avoid detection of confusion.<sup>62</sup> This would be a mistake because the trademark application stage provides a better opportunity to obtain direct and honest translations than during the opposition, expungement, or infringement proceedings.

In this regard, The Coca-Cola Company's applications for "PULPY ORANGE in Chinese" and "MINUTE MAID in Chinese" have improved by providing both literal and adopted translations. These translations are relied upon to decide issues such as distinctiveness<sup>63</sup> and confusion<sup>64</sup> when assessing trademark registrability. However, such reliance is useless if the Chinese font and the English translations can be arbitrary and manipulated. Requiring trademark applicants to provide the literal translation of each character, the adopted translation of the combined characters, as well as the simplified script if the trademark uses traditional script (or vice versa) will help when it comes to considering the degree of resemblance between the trademarks in the ideas suggested by them.

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<sup>62</sup> Vaver, *supra* note 21 at 678 ("The courts have meanwhile told the TMO not to waste time initially by examining applications too closely anyway.") And see *Canadian Parking Equipment Ltd v Canada (Registrar of Trade Marks)* (1990), 34 CPR (3d) 154 at 160-161 (FCTD).

<sup>63</sup> *Trademarks Act*, *supra* note 19, s 2 (**Interpretation** – "**distinctive**, in relation to a trade-mark, means a trade-mark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or is adapted so to distinguish them; ... **trade-mark** means (a) a mark that is used by a person for the purpose of distinguishing or so as to distinguish goods or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others, ..."). Readers who are unimpressed with this definition of "distinctive" can rest assured that Chapters 5 and 7 will shed more light through their respective discussions on "Assessing for Distinctiveness" and the "Distinctiveness of Trademarks".

<sup>64</sup> *Trademarks Act*, *supra* note 19, s 6(1) (**When mark or name confusing** – "(1) For the purposes of this Act, a trade-mark or trade-name is confusing with another trade-mark or trade-name if the use of the first mentioned trade-mark or trade-name would cause confusion with the last mentioned trade-mark or trade-name in the manner and circumstances described in this section.").

<p><b><u>TRADE MARK (Word):</u></b> <b>COCA-COLA</b></p>	<p><b><u>TRADE MARK (Design):</u></b> 可 口 可 乐</p>
<p><b><u>INDEX HEADINGS:</u></b> COCA-COLA</p>	<p><b><u>MARK DESCRIPTIVE REFERENCE:</u></b> CHINESE CHARACTER DESIGN</p>
<p>N/A</p>	<p><b><u>FOREIGN CHARACTER TRANSLATION:</u></b> The translation of the Chinese characters is the English words Possible Mouth Possible Happy.</p> <p>The above is replicated and amended below in order to match the meanings inherently understood for English-language marks, such as COCA-COLA on the left. This amendment will make it easier to compare for any resemblance in the ideas suggested by them.</p> <p><b><u>FOREIGN CHARACTER TRANSLATION:</u></b> The literal translation of the first Chinese character 可 is "possible". The literal translation of the second Chinese character 口 is "mouth". The literal translation of the third Chinese character 可 is "possible". The literal translation of the fourth Chinese character 乐 is "happy".</p> <p>The adopted translation of the combined Chinese characters is "COCA-COLA".</p> <p>The trademark uses simplified script, which can also be written in traditional script: 可口可樂.</p>

It is clear from this chapter that the Canadian database can be improved in order to assist in comparing trademarks for the degree of resemblance in their appearance, sound, or in the ideas suggested by them. This improvement is essential to any database's searchability "by the public and, in particular traders, for the purpose of obtaining relevant information about the rights of the trade mark registered proprietors, as well as by the competent authority (the Registrar of trade marks) for the purpose of fulfilling its

duty of examining trade mark applications. It is very important that an inspection of the register, without more, will reveal to the public and to the competent authority immediately the precise subject-matter of protection afforded by the registered mark to its proprietor.”<sup>65</sup>

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<sup>65</sup> NG-LOY Wee Loon, *Law of Intellectual Property of Singapore* (Singapore: Sweet & Maxwell Asia, 2008) at para [21.1.9] [NG-LOY].

# 3 ADMINISTRATIVE ALTERNATIVES

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This chapter explains several alternatives to the problem of classifying foreign-language marks that are not Romanized. Each alternative is explored and its challenges are explained in order to reinforce why the problem is best addressed with the solution of transcribing such marks.

## **3.1 Classify as Design Marks Because not in an Official Language**

The first alternative is to differentiate between official languages and foreign languages. This will enable the Canadian database to classify COCA-COLA as a word mark while classifying its Chinese equivalent 可口可樂 as a design mark.

One challenge with this alternative is that the Canadian database contradicts itself by first classifying foreign-language marks that are not Romanized as design marks, and then requiring translations and transliterations for them as if they were word marks with meanings and to be pronounced.<sup>66</sup> The Canadian database needs to make up its mind whether foreign-language marks that are not Romanized are inarticulate designs, or whether such marks are meaningful words to be read and sounded out. Resolving this contradiction is important because the Canadian database should benefit all members of the public, and not just those with the means to use it. The current contradiction adversely affects ordinary individuals, small businesses, as well

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<sup>66</sup> *Trade-marks Regulations*, SOR/96-195, s 29 (“The Registrar may require an applicant for the registration of a trade-mark to furnish to the Registrar, as applicable (a) a translation into English or French of any words in any other language contained in the trademark, (b) where the trademark contains matter expressed in characters other than Latin characters or in numerals other than Arabic or Roman numerals, a transliteration of the matter in Latin characters and Arabic numerals, and (c) a specimen of the trademark as used.”).

as more than 170,000 charities and non-profit organizations currently operating in Canada.<sup>67</sup> This voluntary sector is such a major contributor to Canada's economic activity that it employs almost as many full-time workers as Canada's entire manufacturing industry and, when measured as a share of the economically active population, it is the second largest in the world after the Netherlands.<sup>68</sup> These organizations are traders just as much as for-profit businesses. Gone are the days of \$1 bake sales or \$20 donation requests. Instead, these organizations fund their activities nowadays by licensing their trademarks. Unfortunately, many of these organizations cannot afford the additional costs of protecting their trademarks in a foreign language. Even organizations that are generously funded have difficulty justifying such legal expenses to their donors because it means fewer dollars for their core activities. It is more palatable to the donors if an organization can show that it minimized the costs by conducting free searches for direct hits to eliminate as many trademark variations as possible before ordering paid searches for trademarks that are likely available for registration. Donors are more accepting of paid searches for trademarks that are filed because it is the industry standard to use searches to prove due diligence in the future event of trademark oppositions. In this regard, resolving this contradiction

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<sup>67</sup> "Pre-Budget Submission to the Standing Committee on Finance – Budget 2015", The Calgary Chamber of Voluntary Organizations (6 August 2014) at 1, online: <[http://www.parl.gc.ca/Content/HOC/Committee/412/FINA/WebDoc/WD6615327/412\\_FINA\\_PBC2014\\_Briefs/CalgaryChamberOfVoluntaryOrganizations-e.pdf](http://www.parl.gc.ca/Content/HOC/Committee/412/FINA/WebDoc/WD6615327/412_FINA_PBC2014_Briefs/CalgaryChamberOfVoluntaryOrganizations-e.pdf)>. These include organizations that raise funds and awareness for culture and recreation (media and communications, art and architecture, historical and literary societies, museums, zoos and aquariums, sports, recreation and social clubs, *etc.*); education and research (vocational/technical schools, adult/continuing education, *etc.*); health (hospitals, nursing homes, mental health treatment, *etc.*); social services (income support and emergency relief for the handicapped, children, seniors, *etc.*); environment (pollution abatement, natural resources conservation, animal protection, *etc.*); development and housing (community and neighbourhood organizations, job training programs, *etc.*); law, advocacy and politics (civil rights associations, victim support, consumer protection associations, *etc.*); philanthropic intermediaries and voluntarism promotion (corporate foundations, lotteries, *etc.*); international (cultural programs, disaster relief, human rights, *etc.*); religion (churches, monasteries, mosques, seminaries, shrines, synagogues, temples, *etc.*); as well as business and professional associations such as unions, according to Statistics Canada, "The International Classification of Non-profit Organizations" (Ottawa: Statistics Canada, 27 November 2015), online: <<http://www.statcan.gc.ca/pub/13-015-x/2009000/sect13-eng.htm>>.

<sup>68</sup> Michael Hall et al, *The Canadian Nonprofit and Voluntary Sector in Comparative Perspective* (Toronto: Imagine Canada, 2005) at 7-9.



matters to charities and non-profit organizations trying to meet the “heavy burden upon [their] directors to ensure that all assets of the organization are properly identified, protected and applied in fulfilment of the organization’s objects, particularly if it is a charity. The assets of an organization in this regard include the organization’s intellectual property.”<sup>69</sup> Examples include the registrations of Chinese-language marks in Canada by an American charity responsible for Chinese orphanages (Half The Sky Foundation) and by the largest Taiwanese humanitarian organization (Buddhist Compassion Relief Tzu Chi Foundation). Canada’s own Yee Hong Centre for Geriatric Care must protect its marks from those trying to profit unfairly from the stellar government review it receives annually for its nursing homes, the long list of seniors waiting for its residences, and the large Dragon Ball fundraiser it hosts annually in Toronto.<sup>70</sup>

Another challenge with this alternative is that the Canadian database contradicts the recent development in the case law that recognizes foreign-language marks as meaningful words instead of as inarticulate designs. Can a database classify a foreign-language mark as a design mark when assessing for registrability, only to have a court later treat the foreign-language mark as word mark when assessing for infringement (to be discussed in Part B)? Since both the administrative and judicial findings are based on common issues such as distinctiveness and confusion, how can they treat the same foreign-language mark inconsistently? Surely it would not do to have an administrative assessment of distinctiveness for a “design mark” contradicted by a judicial assessment of non-distinctiveness for a “word mark”. This contradiction is even more serious in common law countries that usually have a first-to-use system for recognizing trademark rights. First, it will be harder for a registered foreign-language mark to establish confusion with, and freeze the geographical boundaries and association rights of, an unregistered

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<sup>69</sup> Terrance Carter & Shen Goh, *Branding and Copyright for Charities and Non-Profit Organizations*, 2nd ed (Markham: LexisNexis Canada Inc., 2014) at 5.

<sup>70</sup> *Yee Hong Centre for Geriatric Care v Grace Christian Chapel*, 2006 FC 650, 50 CPR (4th) 165 [*Yee Hong*].

foreign-language mark. The registered mark's classification as an inarticulate design means that a competitor may use a different design mark from the one registered and so not infringe the trader's rights – or at least have a better argument that he is not infringing those rights than in the comparable case of the use of a word mark. Conversely, it will be easier for an unregistered foreign-language mark to establish similarity to, and claim prior use over, a registered foreign-language mark. The registered mark will no longer have the certainty of national protection, as its risk of being limited by the prior use of the unregistered mark increases when the latter is recognized as meaningful words.

### **3.2 Classify as Design Marks Because not in a Romanized Language**

The second alternative is to differentiate between foreign languages that are Romanized versus those that are not. This will enable the Canadian database to classify COCA-COLA in Romanized languages such as German and Spanish as a word mark while classifying its Chinese equivalent 可口可樂 as a design mark.

The challenge with this alternative is that the Canadian database contradicts international trade principles. International trade law aims to remove protectionist practices (quotas, tariffs, subsidies, anti-dumping legislation, administrative barriers, *etc.*) in order to provide a level playing-field for both local and foreign goods and services. And this aim is accomplished also with international trade agreements that detail trademark registrability<sup>71</sup> and rights.<sup>72</sup> But this aim

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<sup>71</sup> *Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs)*, (1994) 25 IIC 209, art. 15 (**Protectable Subject Matter** – “1. Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.”) [*TRIPS*].

is frustrated when the Canadian database permits and promotes differential treatment between languages that are Romanized versus those that are not, as it affects the registrability and rights of foreign-language marks.

First, the most-favoured nation principle requires that “[w]ith regard to the protection of intellectual property, any advantage, favour, privilege or immunity granted by a Member to the nationals of any other country shall be accorded immediately and unconditionally to the nationals of all other Members.”<sup>73</sup> This principle prohibits a country from discriminating between its trading partners by requiring it to extend automatically whatever privilege it grants one trading party to all other parties without their having to negotiate for the privilege. The scenarios below seem to violate this principle by classifying intellectual property from China less favourably than intellectual property from the United States. This not only makes it difficult for international businesses to manage their trademark portfolio globally, but also makes it difficult for them to acquire foreign brands. Imagine that The Coca-Cola Company had succeeded in its attempt to buy China’s largest juice brand for \$2.4 billion in 2008. The differential treatment that COCA-COLA’s Chinese translation had suffered would have been repeated with the Chinese brand hypothetically acquired, since Chinese-language marks are classified automatically as design marks while English-language marks are recognized as word marks, with the improved legal protection that registration as a word mark brings over a design mark registration.

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<sup>72</sup> *TRIPS*, *supra* note 71 at art. 16 (**Rights Conferred** – “1. The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner’s consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use.”).

<sup>73</sup> *TRIPS*, *supra* note 71, art. 4. This principle has similar wording in Article 1 of the General Agreement on Tariffs and Trade, as well as Article 2 of the General Agreement on Trade in Services.

Second, the national treatment principle requires that “[e]ach Member shall accord to the national of other Members treatment no less favourable than that it accords to its own nationals with regard to the protection of intellectual property, ...”<sup>74</sup> This principle prohibits a country from discriminating against its trading partners by requiring it to extend automatically whatever privilege it grants domestic goods and services to those of its trading partners without their having to negotiate for the privilege. The scenarios below also seem to violate this principle by classifying intellectual property from China less favourably than intellectual property in the Canada. This creates a strange situation where an international business will find the same brand receiving different protection depending on its language. For example, there is a strange phenomenon in China where identical COCA-COLA products are sold side-by-side; one in Chinese and the other in English. The juxtaposition does not cannibalize sales, but actually creates a higher-paying clientele for “foreign” products in China. Although COCA-COLA products by their nature are foreign since they are American, they can be made even more foreign by being in English. The bizarre reason is that consumers are willing to pay a premium for a “foreign” experience in China, which has resulted in everything from a “rent-a-foreigner” business for birthday parties and commercial advertisements to a real estate bubble hyped by promises of being the next international city where one can live next to “foreigners”.<sup>75</sup> This is fine in China, which classifies trademarks in Chinese and English equally, but the same phenomenon would be problematic in Canada. Imagine if The Coca-Cola Company were to label its drinks in different languages in Canada in order to promote its global image of community, for the same reason that its 1971 television commercial featured a multi-racial group singing “I’d

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<sup>74</sup> *TRIPS*, *supra* note 71, art. 3. This principle has similar wording in Article 3 of the General Agreement on Tariffs and Trade, as well as Article 17 of the General Agreement on Trade in Services.

<sup>75</sup> David Borenstein, “Chinese Dreamland”, CBC The Passionate Eye (16 July 2016), online: <<http://www.cbc.ca/passionateeye/episodes/chinese-dreamland>>.

Like To Teach The World To Sing” and its 2014 Super Bowl advertisement had a multi-lingual rendition of “America The Beautiful”. The Canadian database would classify COCA-COLA in Romanized languages such as German and Spanish as a word mark while classifying its Chinese equivalent 可口可樂 as a design mark.

And although Canada is still in the process of becoming a member,<sup>76</sup> the United States, the European Union, Singapore, and China are already members of The Madrid Protocol: an international trademark system which allows a trademark registered in one member country to extend that registration to any or all of the other member countries. So imagine a trader’s surprise when a trademark classified as a word mark in one member country is re-classified as a design mark in other member countries. For example, if The Coca-Cola Company were to register the English letters COCA-COLA in the United States and extend the registration to Canada, the same trademark is classified as a word mark in all countries. However, if The Coca-Cola Company were to register the equivalent Chinese characters 可口可樂 in China and extend that to Canada, the same trademark would be classified as a word mark by the Chinese database and re-classified as a design mark by the Canadian database. And if The Coca-Cola Company were to try to avoid this inconsistency by registering first with Canada and extending the registration to China, the trademark could end up equally limited by being classified as a design mark in all countries. This is because, even though the Chinese database can classify the Chinese translation properly as a word mark, it would not do to provide the Chinese registration with more protection than the Canadian registration upon which it is based.

Some may argue that there are no inconsistencies with international trade principles because there is no differential treatment among countries, only languages; therefore, all

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<sup>76</sup> “Members of the Madrid Union”, World Intellectual Property Organization (30 August 2016), online: <<http://www.wipo.int/madrid/en/members/>>. There are 97 members, covering 113 countries.

countries are treated equally with respect to those languages. This argument is overly simplistic in light of the fact that some languages are known to have specific national or ethnic (and, therefore, geographical) origins,<sup>77</sup> and ignores the reality that indirect discrimination can have the same effect as direct discrimination.<sup>78</sup> Some may argue that the believability of a country suing for language-based discriminatory trade practices is unfathomable when there is neither authoritative writing nor precedential cases to support this possibility. But who would have fathomed, much less believed, that Canada would find two Chinese trademarks to be distinctive in a 1992 decision, only to contradict itself in a 2011 decision by finding the same two Chinese trademarks to be confusing (to be discussed in Part B)?

### **3.3 Classify as Word Marks by Transcribing Every Dialect**

The third alternative is to transcribe a Chinese-language mark into every dialect, instead of basing the transcribing only in Mandarin (which is what was done throughout this dissertation). This will promote equality by advocating cultural respect for and equal recognition of all classical and natural languages, including minority dialects. Although this alternative is illustrated through the specific example of Chinese dialects, the general principle can be applied to other foreign languages such as Punjabi, which is written usually in one script by Muslims and another script by Sikhs and Hindus.

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<sup>77</sup> Both the highest courts of the United States and of Canada have linked language to prohibited grounds of discrimination in *Lau v Nichols*, 414 US 563 (1974) and *Forget v AG Quebec*, [1988] 2 SCR 90 respectively. And see how language is linked to race, ancestry, place of origin, colour, ethnic origin in *Welen v Gladmer Developments Ltd*, 11 CHRR D/348 (Sask 1990); *Gajecki v Surrey School District*, 11 CHRR D/326 (BC 1990); *Cornejo v Opus Building Corp*, 14 CHRR D/167 (BC 1991); and *Grewal v Fletcher Challenge Canada Ltd*, 14 CHRR D/161 (BC 1991). And see Scassa, *supra* note 271.

<sup>78</sup> *Ontario Human Rights Commission (O'Malley) v Simpson Sears Ltd*, [1985] 2 SCR 536, 1985 CanLII 18.

The challenge with transcribing the Chinese language into every dialect is that it is unnecessary and impractical to do so. Unnecessary because none of the Chinese databases in China, Hong Kong, Singapore, and Taiwan currently distinguish between dialects, so why must the Canadian database? Impractical because the purpose of transcribing foreign-language marks that are not Romanized in the first place is to assist in filing/searching for them. Transcribing in different dialects makes it impossible to find the actual Chinese characters that are the subject matter of the registration. For example, searching the Canadian database for HO2 HAU2 HO2 LOK6 (based on the Cantonese dialect) will not produce the trademark registration for 可口可樂 that is filed under KE3 KOU3 KE3 LE4 (based on Mandarin). Once a search for KE3 KOU3 KE3 LE4 produces the trademark registration for 可口可樂, the interested parties can explain through evidence to the examiner that this trademark is actually being used in a different dialect, which results in a different pronunciation and meaning unique to that dialect. The reality is that *something* needs to be the standard and Mandarin is an official language in Singapore, as well as the sole official language of Taiwan and China (to which Hong Kong was repatriated).<sup>79</sup> All this makes it the most common language in the world, with twice the number of speakers of the second most common language (Spanish), and almost three times the number of speakers of the third most common language (English).<sup>80</sup> It naturally make sense for the Canadian database to use Mandarin, as Canadian diplomats are already learning Mandarin on account of its being one of the six official languages of the United Nations.

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<sup>79</sup> After Hong Kong was colonized by the United Kingdom in 1842, it had no official language laws and English was the sole language used in the colonial government. It was not until the 1974 *Official Languages Ordinance* that the colonial government recognized English and Chinese as official languages, which finally enabled the people of Hong Kong to access government communications and court proceedings in a language they understood. However, this recognition was not of a specific dialect, but of “the Chinese language” in general. This meant that Cantonese became a *de facto* official language because it was the most popular dialect in Hong Kong, but it also means that Cantonese may be replaced with Mandarin due to Hong Kong’s repatriation to China.

<sup>80</sup> “People and Society: WORLD”, Central Intelligence Agency (undated), online: <<https://www.cia.gov/library/publications/resources/the-world-factbook/geos/xx.html>>.

The third alternative can also be rephrased from the aspect of transcribing the Chinese language into every phonetic system, instead of basing the transcribing only in the PinYin phonetic system (which is what was done throughout this dissertation). So why did the International Organization for Standardization choose Mandarin and adopt PinYin as the official phonetic system in 1982 for transcribing Chinese?

The challenge with transcribing the Chinese language into every phonetic system can be illustrated with just one example. Taiwan uses a phonetic system called ZhuYin, which sounds out Chinese characters by using another set of 37 linguistic symbols. This phonetic system deciphers 可口可樂 as “ㄎㄛˇ ㄎㄛˇ ㄌㄛˊ ㄌㄛˊ”. This would be akin to sounding out English words by using another set of linguistic symbols. For example, the dictionary deciphers COCA-COLA as “kəʊkə'kəʊlə”.<sup>81</sup> Suffice it to say, this phonetic system is unhelpful to someone who is unfamiliar with the language. This is why PinYin is more helpful, as its phonetic system is Romanized. And although there were other phonetic systems that were Romanized, PinYin became the most popular one. But why didn't the International Organization for Standardization choose alternative phonetic systems that are even more helpful than PinYin?

Consider the alternative of designing a trademark database that recognizes most languages in the world by using The Unicode Standard.<sup>82</sup> Unicode is the official system for implementing the International Organization of Standardization's encoding of languages.<sup>83</sup> It assigns a specific number to every character, which can be used for all languages available in computer programs, operating systems, modern browsers, *etc.* This is why Microsoft's word processing software already has capabilities for reading and writing most languages in the world.

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<sup>81</sup> *The Oxford English Dictionary*, 3rd ed, *sub verbo* “Coca-Cola”.

<sup>82</sup> “About the Unicode® Standard: Characters for the World”, The Unicode Consortium (8 March, 2017), online: <<http://www.unicode.org/standard/standard.html>>.

<sup>83</sup> “Standards Catalogue, 35.040.10: Coding of character sets”, International Organization for Standardization (undated), online: <<https://www.iso.org/ics/35.040.10/x/>>.



Unicode would decipher 可口可樂 as a set of numbers, in the same manner that it deciphers COCA-COLA as “0043-004F-0043-0041 (the hyphen is 002D) 0043-004F-004C-0041”.<sup>84</sup> Although some might consider this the most comprehensive solution, which nears perfection when augmented by an audio filing system, this system is too technical for someone who is unfamiliar with “the language” of computer coding. In fact, this solution complicates matters by creating a two-step process that requires knowledge of the language used in the trademark and an understanding of computer coding. This would be as impractical as requiring someone to know not only the title of a book but also the numbers assigned to it under the Dewey Decimal Classification understood by librarians.<sup>85</sup> The less-than-perfect PinYin phonetic system is still a better solution because it requires only the first step.

### **3.4 Classify as Word Marks by Having Fluent Examiners**

The fourth alternative is to have a fluent examiner for every foreign language, instead of an English-speaking examiner who must rely on transcribing for non-Romanized languages. This will promote equality by advocating cultural respect for and equal recognition of all classical and natural languages.

One challenge with this alternative is that having fluent examiners does not help the illiterate lawyers or illiterate traders trying to search the Canadian database.

Another challenge with this alternative is that being fluent in a language is not the same thing as being qualified to translate the language. Instead of expecting examiners to be fluent or to act as translators, the burden should remain on trademark applicants to communicate the scope

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<sup>84</sup> “Unicode® character table”, The Unicode Consortium (undated), online: <<https://unicode-table.com/en/#control-character>>.

<sup>85</sup> “Organize your materials with the world’s most widely used library classification system”, Online Computer Library Centre (2017), online: <<http://www.oclc.org/en/dewey.html>>.

of their claims to the world. The reality is that we cannot assume what the translation for a foreign-language mark is supposed to be. In fact, we cannot even assume that a foreign-language mark is intended to be translated:

“... there is abundant evidence that American manufacturers are themselves unaware of the linguistic issues involved. Chevrolet’s South American fiasco with an automobile named NOVA (translated: “it will not go”) is a poignant example, as was Ford’s problem with its PINTO in Brazil (translated: “tiny male genitals”). And one can only imagine what English speakers thought when they saw advertisements for Japan’s KINKI Nippon Tourist Company, the Cypriot soft drink called ZIT, the Swedish toilet paper called KRAPP, the Finnish product for unfreezing car doors called SUPER PISS ...”<sup>86</sup>

The quote above illustrate that translations are independent of foreign-language marks. For example, COCA-COLA is a combination of two words with meanings. COCA referred to the leaf extracts which had the botanical term 古柯 (GU3 KE1), while COLA originally referred to the bean extracts which had the botanical term 可拉 (KE3 LA1) and later referred to any carbonated drink which had the equivalent term 汽水 (QI4 SHUI3 means “air water”). But neither lackluster translation was adopted for the trademark. One reason was because The Coca-Cola Company did not bother in 1927 to translate its trademark when it opened its first bottling plant in China.<sup>87</sup> Another reason was because Chinese locals did not understand English and were translating the trademark into Chinese based on the sound (instead of the meaning) of

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<sup>86</sup> Roger Shuy, *Linguistic Battles in Trademark Disputes* (New York: Palgrave MacMillan, 2002) at 35-36 [Shuy]. And see Graeme Dinwoodie et al, eds, *International Intellectual Property Law and Policy*, 2nd ed (Newark, NJ: LexisNexis Matthew Bender, 2008) at 115 [Dinwoodie, *International IP*].

<sup>87</sup> Philip Mooney, “Bite the Wax Tadpole?”, The Coca-Cola Company (6 March 2008), online: <<http://www.coca-colaconversations.com/2008/03/bite-the-wax-ta.html>> [“Bite the Wax Tadpole?”].

COCA-COLA, which resulted in random Chinese meanings such as “female horse stuffed with wax” or “bite the wax tadpole”.<sup>88</sup> Before such unflattering translations caught on or, even worse, before a desirable translation was claimed by a Chinese local, The Coca-Cola Company held an international competition in 1933 and awarded Professor Chiang Yee from the School of Oriental and African Studies, University of London, for the winning translation: 可口可樂 (KE3 KOU3 KE3 LE4).<sup>89</sup> The meaning of “possible mouth possible happy” is a branding dream because the specific combination of Chinese characters suggests that the product is “delicious happiness” or “happiness in the mouth”. Perhaps it was fortuitous that Chinese locals did not understand English, or they might have translated COCA-COLA literally, and the world would now be using the lacklustre translation of “coca – air water” instead of a creative translation. The catchy rhythm of this translation was an instant success that others would try to copy but never successfully duplicate. For example, the translation of PEPSI-COLA is 百事可樂 (BAI3 SHI3 KE3 LE4). The meaning “hundred things possible happy” suggests the consumer is “happy with everything”, but the translation lacks a reference to the taste and has no memorable sound repetition. The power of a catchy translation cannot be underestimated.

The reality that translations are independent of foreign-language marks becomes even more obvious when we consider the number of traders who continued to use the same translation even after changing their trademarks. PEPSI-COLA did not shorten its translation 百事可樂 (BAI3 SHI3 KE3 LE4) when shortening its name to PEPSI. KENTUCKY FRIED CHICKEN translated only the first word in its name as 肯德基 (KEN3 DE2 JI1), and did not change the

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<sup>88</sup>“Bite the Wax Tadpole?”, *supra* note 88.

<sup>89</sup> Amcham Shainghai, “Coca-Cola in Chinese – A Perfect Translation”, INSIGHT The Voice of the American Chamber of Commerce in Shanghai (20 April, 2015), online: <<http://insight.amcham-shanghai.org/coca-cola-in-chinese-a-perfect-translation/>>. And see “Chiang Yee, A Chinese Artist in the English Lake District”, English Lakes Hotels Ltd (undated), online: <<http://englishlakes.co.uk/chinese/chiang-yee/>>.

translation when abbreviating its name to KFC. The reverse can also happen: MCDONALD'S continued to use the same trademark even after changing its translations from 麥當勞 (MAI4 DANG1 LAO2) to 金供門 (JIN1 GONG1 MEN2). The former translation was based on the sound of MCDONALD'S, whereas the latter translation was based on the meaning of the "Golden Arches". This is confusing and leave consumers wondering what translation should refer to the "Golden Arches" when the latter translation is referring instead to MCDONALD'S.

Even though translations are independent of foreign-language marks, a translation that catches on is priceless and likely to fall victim to trademark squatters. For example, VIAGRA became known in China as 偉哥 (WEI3 GE1) after the public dubbed it so based on its sound (since VIAGRA has no meaning). The Chinese meaning of "great brother" is an ego boost. The fun-and-cheeky translation became widespread and was registered by a pharmaceutical company in China. Failing to cancel the registration in China, Pfizer had to settle for an alternative translation which nobody remembers. Canada's anticipated removal of use<sup>90</sup> as a requirement to apply for trademark registration will open the door for the same type of trademark squatting to happen in Canada. This will increase the frequency with which traders need to oppose applications or cancel registrations for translations of their trademarks in Canada. Canadian traders looking to protect themselves can thank a recent development in the case law that recognizes foreign-language marks as meaningful words instead of as inarticulate designs, which will help them to prove the association between a translation and their trademarks (to be discussed in Part B). Time will tell whether this solution to trademark squatting will result in a problem with trademark monopoly: will traders rush to register any and all translations of their

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<sup>90</sup> *Bill C-31, supra* note 28 (**Sections 30 to 33 of the Act are replaced by the following: Requirements for applications** – "30. (1) A person may file with the Registrar an application for the registration of a trademark in respect of goods or services if they are using or propose to use, and are entitled to use, the trademark in Canada in association with those goods or services."). Clause 339 of *Bill C-31* goes on to list the "Contents of application", which removes the current requirement for a date of use or an affidavit of use.

trademarks, resulting in their monopolizing trademarks in both official and foreign languages? Consider how The Coca-Cola Company has filed over 1,000 trademark applications in China, some of which are multiple translations based on the sound of the same trademark: 芬搭 (FEN1 DA2) and 芬达 (FEN1 DA2) and 发达 (FA1 DA2) for FANTA.

It is clear from this chapter that there are several alternatives to the problem of classifying foreign-language marks that are not Romanized. However, the challenges associated with each alternative means that the problem is best addressed with the solution of transcribing such marks.

# 4 JUDICIAL PROBLEM

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It was 1992. The Federal Court of Canada had specifically rejected the American doctrine of foreign equivalents. That meant refusing to affirm that a trader could use a trademark registration for an English word to exclude others from registering its translations. The four Chinese-language marks that were registered in Canada by The Coca-Cola Company were up for renewal.

Yet, 1992 was when The Coca-Cola Company abandoned the Chinese translations of its products. That was the year it failed to renew all four registrations for its Chinese-language marks in Canada. Why? Although the business world was ready to embrace the economic benefits of recognizing foreign languages, the administrative and judicial systems were sending it the message that trademark registrations were not necessary to do so.

This chapter reviews a set of trademark cases in Canada involving two Chinese bakeries in order to illustrate the judicial challenge of proving linguistic knowledge for foreign-language marks.

## **4.1 The Problem as Illustrated by Two Chinese Bakeries in Canada**

There are at least 16 Canadian court cases involving Chinese-language marks to date, 11 of which were decided in the 21<sup>st</sup> Century.<sup>91</sup> As cases involving Chinese-language marks are

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<sup>91</sup> *Pacific Produce Co Ltd v Metro Trading Co* (1986), 15 CPR (3d) 44, 1986 CanLII 1244 (BC SC) (TIENTSIN is an English-language mark used by the defendant's Chinese-language importer); *Coin Stars Ltd v KK Court Chili & Pepper Restaurant Ltd* (1990), 33 CPR 3(d) 186, 1990 CanLII 684 (BC SC); *Lookin Trading Co Ltd v Honey House Beddings & Housewares Ltd* (1997), 72 CPR (3d) 297, 1997 CanLII 2050 (BC SC); *Pagolac Restaurants Ltd v 404305 Alberta Ltd*, 1999 ABQB 423; *Cheung Kong*, *supra* note 9; *Ten Ren Tea Co v Van Cheong Tea Inc*, 2003 FC 819; *The House of Kwong Sang Hong International Ltd v Gervais*, 2004 FC 554; *Telus Corp v Orange Personal*

expected to increase in the future in Canada, it is important to develop a workable model now for assessing the notional consumer in cases of confusion involving foreign-language marks. This need is illustrated by a protracted trademark dispute between two Chinese bakeries in Canada.

As far back as 1974, Cheung’s Bakery had a bakery in the City of Vancouver. Although it used an English-Chinese trademark with the words ANNA’S CAKE HOUSE, it was most definitely a Chinese bakery where the owner spoke Chinese and sold coconut buns, egg tarts and moon cakes. It was nothing like the typical local bakery, where consumers expected to speak English and bought bread, cookies and muffins. Little thought was given to registering foreign-language marks in those days, so Cheung’s Bakery registered only its English-language marks (see the left side of the chart below) and did not register its Chinese-language mark (see the right side of the chart below).


<b>Trademarks registered by Cheung’s Bakery  (“English-language marks”)</b>	<b>Trademark used but not registered by Cheung’s Bakery  (“Chinese-language mark”)</b>
ANNA’S CAKE HOUSE <sup>92</sup>	安娜餅屋 <p style="text-align: right;">93</p>

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*Communications Services Ltd*, 2005 FC 590; *Brilliant Trading Inc v Wong*, 2005 FC 1214; *Yee Hong*, *supra* note 70; *Café do Brasil SPA v Walong Marketing Inc*, 2006 FC 1063; *College of Traditional Chinese Medicine Practitioners and Acupuncturists of British Columbia v Council of Natural Medicine College of Canada*, 2009 FC 1110; *Pioko International Imports Inc v BOT International Ltd*, 2009 CanLII 64819, [2009] CarswellOnt 7247 (QL) (ON SC) (COTTON GINNY is an English-language mark used by the defendant’s Chinese-language manufacturer); *Target Event Production Ltd v Paul Cheung and Lions Communications Inc*, 2010 FC 27, rev’d in part 2010 FCA 225; *JAG Flocomponents NA v Archmetal Industries Corporation*, 2010 FC 627; *Cheah v McDonald’s Corporation*, 2013 FC 774 (MACDIMSUM is an English-language mark reproduced by the defendant’s Chinese-language restaurant); *Saint Honore Cake Shop Limited v Cheung’s Bakery Products Ltd*, 2013 FC 935, aff’d 2015 FCA 12 [*Saint Honore*]; *Council of Natural Medicine College of Canada v College of Traditional Chinese Medicine Practitioners and Acupuncturists of British Columbia*, 2013 FC 287; *Source Media Group Corp v Black Press Group Ltd*, 2014 FC 2014 (NEW HOME LIVING is an English-language mark reproduced by the defendant’s Chinese-language magazine); and *Times Group Corporation v Time Development Group Inc*, 2016 FC 1075.

<sup>92</sup> [Trademarks: ANNA'S CAKE HOUSE, Registered, 0598133, TMA354194](#)

<sup>93</sup> [Trademarks: CHINESE CHARACTERS DESIGN, Registered, 0639045, TMA480506](#)

	N/A
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In 1988, Saint Anna Bakery applied to register a competing trademark on the basis of proposed use. Although it had not used the trademark, it was setting itself up as a competing bakery in the City of Toronto by incorporating the word ANNA and all four Chinese characters from the English-Chinese trademark of Cheung’s Bakery. This competition between a bakery in Toronto and the bakery in Vancouver may seem hypothetical until we realize how lucrative the Chinese pastry business can be:<sup>95</sup> pastries are consumed daily; specific pastries are required for important holidays such as Autumn Moon Festival and Chinese New Year; and specialized pastries are required for formal occasions such as wedding announcements. This is a community that has payment plans for moon cakes (the way Canada has mortgage plans for houses), and asks friends and relatives to bring wedding pastries back to Toronto from Vancouver (the way Canada orders products online from the United States). Saint Anna Bakery applied to register the Competing Mark (see the left side of the chart below), and Cheung’s Bakery responded by finally applying to register the Original Mark (see the right side of the chart below).

<p style="text-align: center;"><b>Trademark applied for by Saint Anna Bakery  (“Competing Mark”)</b></p>	<p style="text-align: center;"><b>Trademark applied for by Cheung’s Bakery  (“Original Mark”)</b></p>
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<sup>94</sup> [Trademarks: ANNA'S CAKE HOUSE & DESIGN, Registered, 0598131, TMA354193](#)

<sup>95</sup> This background information does not appear in the cases themselves but would be common knowledge within the Chinese community.



 <p style="text-align: right;">96</p>	<p style="text-align: center;">安 娜 餅 屋</p> <p style="text-align: right;">97</p>
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The result was that the two parties ended up opposing each other’s trademark applications. The Trademarks Opposition Board decided in both oppositions that the trademarks were not confusing and, therefore, were both registrable.<sup>98</sup> How could this be when the Competing Mark incorporated all four Chinese characters from the Original Mark? The answer lies in the fact that the test for confusion did not consider the linguistic knowledge of the consumer.

Canada’s *Trademarks Act* sets out the test for confusion by providing that consideration must be given to “all the surrounding circumstances including:

- (a) the inherent distinctiveness of the trademarks or trade names and the extent to which they have become known;
- (b) the length of time the trademarks or trade names have been in use;
- (c) the nature of the wares, services or business;
- (d) the nature of the trade; and
- (e) the degree of resemblance between the trademarks or trade names in appearance or sound or in the ideas suggested by them.”<sup>99</sup>

<sup>96</sup> [Trademarks: SAINT ANNA BAKERY LTD. & DESIGN, Expunged, 0614373, TMA493100](#)

<sup>97</sup> [Trademarks: CHINESE CHARACTERS DESIGN, Registered, 0639045, TMA480506](#)

<sup>98</sup> *Cheung’s Bakery Products Ltd v Saint Anna Bakery Ltd* (1992), 46 CPR (3d) 261 (TMOB) [*Saint Anna* TMOB] and *Saint Anna Bakery Ltd v Cheung’s Bakery Products Ltd* 1996 CanLII 11366 (TMOB).

<sup>99</sup> *Trademarks Act*, *supra* note 19, s 6(5). This test applies to both opposition proceedings and trademark infringements, and the onus remains on whoever is *in petitorio*. Opposition proceedings require applicants to prove there is no likelihood of confusion, according to *Mattel*, *supra* note 34 at para 6 (“In opposition proceedings, trademark law will afford protection that transcends the traditional product lines unless the applicant shows the likelihood that registration of its mark will not create confusion in the marketplace within the meaning of s. 6 of the *Trademarks Act*.”). Infringement claims require plaintiffs to prove that there is likelihood of confusion, according to *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, [2006] 1 SCR 824 at para 14 (“Whether or not

The Supreme Court of Canada applies the test for confusion as a matter of first impression and imperfect recollection:

“The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the [mark], at a time when he or she has no more than an imperfect recollection of the [previous] trademarks, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.”<sup>100</sup>

The Trademarks Opposition Board interpreted the quote above – and applied the test for confusion accordingly in 1992 – by imagining *the illiterate consumer* when considering all the surrounding circumstances. I use the term “illiterate” not to mean that the consumer cannot read or write in any language, but rather that the consumer does not understand the foreign language used in the trademark in question. While the term “illiterate” may be a pejorative adjective, it sums up how consumers feel when their linguistic knowledge is not considered to be relevant:

“In my view, the average Canadian would not, as a matter of first impression and imperfect recollection, recognize that the [Original Mark] appears in the [Competing Mark], *especially when the Chinese characters in the [Competing*

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there exists a likelihood of confusion is largely a question of fact. As this is an infringement claim (rather than an opposition proceeding before the Trademarks Opposition Board), the onus is on the appellant to prove such likelihood on a balance of probabilities.”) [*Veuve Clicquot*]. The fact that the test for confusion was identical for both registration and infringement was confirmed in an expungement case in *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, [2011] 2 SCR 387 at para 33 (“Whether in assessing trademark infringement under s. 19 or entitlement under s. 16, the test for likelihood of confusion is the same.”) [*Masterpiece*]. The fact that there is a pragmatic element for placing the onus on whoever is *in petitorio* was explained in a copyright case in *Harmony Consulting Ltd v GA Foss Transport Ltd*, 2012 FCA 226 at para 32 (“Burden of proof rules allocate the costs and risks of gathering and presenting evidence, and help filter good cases from the bad. They should not be “impractical and unduly burdensome” on plaintiffs and should advance the purposes of the law involved. ... [See] David Vaver, “Consent or No Consent: The Burden of Proof in Intellectual Property Infringement Suits”, (2001) 23 IPJ 147 at 148-149.”).

<sup>100</sup> *Masterpiece*, *supra* note 99 at para 40.

*Mark] run together and appear in a stylized form.* The average Canadian would focus on the English language components of the [Competing Mark], but might guess from the Chinese script that the baked goods sold under the mark were in some type of Chinese style. I can take judicial notice that there are some Canadians who would be fluent in Chinese, and who would immediately recognize the [Original Mark] as a component of the [Competing Mark]. However, in the absence of any evidence on point, I cannot conclude that the number of Canadians fluent in Chinese would be significant ... ”<sup>101</sup> [*emphasis added*]

The Trademarks Opposition Board decided that there was no confusion, “especially when the Chinese characters in the [Competing Mark] run together and appear in a stylized form.” This would not have been an acceptable argument if the trademark in question had been COCA-COLA. Since the Original Mark is filed in standard font, just as COCA-COLA was registered in standard font, it should have been designated as a word mark that bars competitors from using it in a different font, size, and colour. Instead, its designation as a design mark enabled a competitor to avoid infringement simply by changing its “stylized form”, which was the very argument made when assessing COCA-COLA as a design mark.<sup>102</sup>

However, the Trademarks Opposition Board’s focus on the Supreme Court of Canada’s explanation of *how* a consumer perceives a trademark (as a matter of first impression and imperfect recollection) seems to ignore the Federal Court of Canada’s explanation below as to

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<sup>101</sup> *Saint Anna TMOB*, *supra* note 98 at 268.

<sup>102</sup> *Coca-Cola Company of Canada Limited v Pepsi-Cola Company of Canada Limited*, [1942] 1 All ER 615 at 618 (“If it be viewed as a design mark, the same result follows. The only resemblance lies in the fact that both contain the word “Cola”, and neither is written in block letters, but in script with flourishes. *The letters and flourishes in fact differ very considerably*, notwithstanding the tendency of words written in script with flourishes to bear a general resemblance to each other.”) [*emphasis added*] [*Pepsi-Cola*].

who the consumer is (the target consumer of the product, instead of the general public), even though the two explanations do not contradict each other and both are relevant to the test for confusion:

“To determine whether two trademarks are confusing one with the other it is the persons who are likely to buy the wares who are to be considered, that is those persons who normally comprise the market, the ultimate consumer.”<sup>103</sup>

Perhaps it was a coincidence, but the year that the Trademarks Opposition Board issued its decision was the same year that The Coca-Cola Company decided to abandon the Chinese translations of its products. All four Chinese-language marks that had been applied for in 1975 were not renewed in 1992. The business world got the message that trademark registrations were not necessary in order to embrace the economic benefits of recognizing foreign languages.

#### **4.2 The Problem of Proving Linguistic Knowledge**

The Trademarks Opposition Board’s decision resulted in both trademarks being registered in 1997-1998. To avoid what it still considered confusion nonetheless, Cheung’s Bakery purchased the Competing Mark from Saint Anna Bakery so that there would only be one source of the Competing and Original Marks.<sup>104</sup> Then to avoid having its Original Mark diluted, Cheung’s Bakery ignored the Competing Mark it had purchased and continued to use its Original

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<sup>103</sup> *Canadian Schenley Distilleries Ltd v Canada’s Manitoba Distillery Ltd* (1975), 25 CPR (2d) 1 at 5 (FCTD).



<sup>104</sup> Instead of purchasing the Competing Mark, Cheung’s Bakery could have appealed and brought further evidence of the widespread use of the Chinese language on the theory that the test for confusion requires “all” circumstances to be considered. This means that linguistic knowledge or anything else that creates likely confusion is a relevant circumstance to consider. Perhaps Cheung’s Bakery did not do so because the Trademarks Opposition Board’s decision on November 30, 1992 was rendered after and consistent with the earlier Federal Court of Canada’s decision on October 27, 1992 in *Krazy Glue, Inc v Grupo Cyanomex, SA de CV* (1992), (*sub nom B Jadow and Sons, Inc v Grupo Cyanomex, SA de CV*) 45 CPR (3d) 161, [1992] FCJ No 957 (QL) (FCTD) [*Krazy Glue*].

Mark only. Finally, it seemed that the pastry world was restored to its original position with the Original Mark in use and the Competing Mark hidden away.

Unfortunately, peace was not to last in the pastry world. Upon realizing that Cheung's Bakery had abandoned the Competing Mark it had purchased, Saint Anna Bakery had the Competing Mark expunged for lack of use in 2004.<sup>105</sup> This did not concern Cheung's Bakery. But it did become concerned when Saint Anna Bakery re-named itself Saint Honore Cake Shop and, once again, applied to register competing trademarks on the basis of proposed use in 2006. Why didn't the solicitor for Cheung's Bakery insert a non-competition clause into the purchase agreement to prevent the expungement and the re-naming? It is understandable that lawyers with little exposure to foreign languages might be unaware of the linguistic issues discussed in Part A and, as a result, might assume erroneously that there is only one translation for the Original Marks. It is also reasonable for a trader with little understanding of the law to fail to draw such linguistic facts to the lawyer's attention. Why didn't Saint Honore also change its Chinese name when it changed its English name? This persistence in retaining the same Chinese name may seem strange, especially to a non-Chinese speaker, until we realize that the Chinese name is as well-known in the Chinese community as TIM HORTONS is in Canada or STARBUCKS is in the United States. Saint Honore applied to register the SAINT HONORE marks (see the left side of the chart below), which Cheung's Bakery opposed on the basis of its two registrations for the ANNA marks (see the right side of the chart below).

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<sup>105</sup> Since it purchased the Competing Mark from Saint Anna Bakery, Cheung's Bakery could have argued that "[Saint Anna Bakery], having assigned the trade marks to [Cheung's Bakery], cannot derogate from its own grants and is, therefore, estopped as between itself and [Cheung's Bakery] from disputing the validity of the trade marks;" based on *Cheerio Toys & Games Ltd v Dubiner*, [1966] SCR 206, 48 CPR 266 at para 33. The rationale for an invalidation by the court under section 18(1) of the *Trademarks Act* could have worked for an expungement by the Registrar under section 45(3) of the *Trademarks Act*.

Trademarks applied for by Saint Honore Cake Shop ("SAINT HONORE marks")	Trademarks registered already by Cheung's Bakery ("ANNA marks")
	<p data-bbox="868 373 1105 415">安 娜 餅 屋</p> <p data-bbox="1128 436 1166 464">107</p>
	<p data-bbox="820 520 1317 577">安 Anna's 娜 Cake 餅 House 屋 109</p>

This time, however, the Trademarks Opposition Board decided in both oppositions to the SAINT HONORE marks that they were confusing and, therefore, were not registrable.<sup>110</sup> What led to this inconsistency from the previous decisions? The answer lies in the fact that, by then, the Trademarks Opposition Board interpreted the case law – and applied the test for confusion differently as a result in 2011 – by imagining *the fluent consumer* when considering all the surrounding circumstances. Although there is a spectrum from illiteracy to fluency in a language, I use the term “fluent” to mean a complete understanding of the foreign language in the same way that it is assumed for English or French:

“The Opponent submits, and I agree for the reasons that follow, that this is a situation in which it would be appropriate to consider the impression of the

<sup>106</sup> [Trademarks: CHINESE CHARACTER DESIGN, Opposed, 1329118](#)

<sup>107</sup> [Trademarks: CHINESE CHARACTERS DESIGN, Registered, 0639045, TMA480506](#)

<sup>108</sup> [Trademarks: SAINT HONORE CAKE SHOP LIMITED & CHINESE CHARACTERS DESIGN, Opposed, 1329117](#)

<sup>109</sup> [Trademarks: ANNA'S CAKE HOUSE & Chinese Characters Design, Registered, 1235030, TMA667403](#)

<sup>110</sup> *Cheung's Bakery Products Ltd v Saint Honore Cake Shop Ltd*, 2011 TMOB 94 (with minor correction in *Cheung's Bakery Products Ltd v Saint Honore Cake Shop Ltd*, 2011 TMOB 152) and *Cheung's Bakery Products Ltd v Saint Honore Cake Shop Ltd*, 2011 TMOB 95 (with minor correction in *Cheung's Bakery Products Ltd v Saint Honore Cake Shop Ltd*, 2011 TMOB 153), aff'd 2013 FC 935, aff'd 2015 FCA 12 [*Saint Honore TMOB*].

average Canadian consumer who can read and understand Chinese characters when determining the likelihood of confusion between the parties' marks.”<sup>111</sup>

Perhaps the Trademarks Opposition Board could have – and should have – imagined *the fluent consumer* when the parties first appeared before it in its 1992 decision, instead of waiting until its 2011 decision to do so. Although this time period coincided with the 1997 handover of Hong Kong from Britain to China, which resulted in a huge influx of Chinese immigrants to Canada, there is no evidence that the bakeries were marketing to the general public in 1992 and had restricted their marketing to Chinese-Canadians by 2011. Nor is there evidence that the average Canadian consumer of these bakeries were mostly non-Chinese in 1992 and mostly Chinese in 2011. Thus, it is unclear what change in circumstances led to the statement above that this is an appropriate situation to consider the average Canadian consumer who understands Chinese. It would appear that this inconsistency from the previous decisions was due not to any change in facts, but due to the Federal Court of Canada's decision in 2000 in the *Cheung Kong* case.<sup>112</sup>

In the *Cheung Kong* case, the court valiantly tries to reconcile past administrative and judicial cases that had ignored prior judicial explanation of *who* the consumer is – the target consumer of the product, instead of the general public – in their application of the test for confusion to foreign-language marks. First, a past decision had held that the Spanish language mark KOLA LOKA was not confusing with the English-language mark KRAZY GLUE, even though “kola loka” in Spanish means “crazy glue” in English, because less than 1% of the

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<sup>111</sup> *Saint Honore* TMOB, *supra* note 110 at para 85.

<sup>112</sup> *Cheung Kong*, *supra* note 9.

Canadian population understood Spanish.<sup>113</sup> *Cheung Kong* explained that this was referring to the fact that the product seemed to be marketed on a national scale.<sup>114</sup> Second, another past decision had held that the German language mark BLAUPUNKT was not confusing with the English-language mark BLUE POINT, even though “blaupunkt” in German means “blue point” in English, because there was no evidence that any Canadians understood German.<sup>115</sup> *Cheung Kong* explained that this was referring to the fact that the average consumer of the product did not understand German.<sup>116</sup> Third, the 1992 decision involving the two Chinese bakeries had held that the Competing Mark was not confusing with the Original Mark because there was no evidence to conclude that the number of consumers fluent in Chinese would be significant. This means that linguistic knowledge could be deemed to be irrelevant not just when comparing a foreign-language mark with an English-language mark, but even when comparing two trademarks in the same foreign language.<sup>117</sup> *Cheung Kong* explained that this was referring to the fact that the average consumer of the product would not recognize the similarity in the Chinese-

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<sup>113</sup> *Krazy Glue*, *supra* note 104 at 171 (“However, I have found as a fact that only a minimal proportion of the Canadian population speaks Spanish as a mother tongue or understands Spanish sufficiently to be capable of making the translation. I therefore conclude, on the basis of the facts established by the evidence, that the average consumer, having a vague or imperfect recollection of the registered trade mark KRAZY GLUE, would find no degree of resemblance whatsoever in the ideas suggested by KOLA LOKA and KRAZY GLUE.”).

<sup>114</sup> *Cheung Kong*, *supra* note 9 at para 55 (On closer examination of this passage, however, I do not think that McGillis J. is categorically ruling out the possibility that, on the appropriate evidence, the existence of a substantial number of Spanish speakers among the consumers of the ware could not displace the linguistic knowledge that can be attributed to the population as a whole. She had adopted the finding of the Registrar that less than 1% of the population understands Spanish, and there was no indication that the applicant’s product was not marketed on a national scale. Thus, the facts of the case did not justify departing from the normal rule about the linguistic knowledge of the ‘average consumer.’”).

<sup>115</sup> *Robert Bosch GmbH v Grupo Bler de Mexico, SA de CV* (1997), 76 CPR (3d) 397 (TMOB) at 403 (“The opponent argues that the average person would either know, or guess, that [BLUE POINT] is the translation of BLAUPUNKT. However, no evidence has been presented to show that any Canadians understand German and no evidence such as survey evidence has been presented to substantiate the claim that the average consumer would guess at the meaning.”) [*Blaupunkt*].

<sup>116</sup> *Cheung Kong*, *supra* note 9 at paras 60, 68 (“Like the Krazy Glue case, *supra*, the Blaupunkt decision also appears to turn on the absence of any evidence that the average consumer of the wares concerned had any knowledge of German. ... Both turned ultimately on the absence of evidence about the number of consumers able to translate the foreign language marks into English.”).

<sup>117</sup> *Saint Anna TMOB*, *supra* note 98 at 268 (“I can take judicial notice that there are some Canadian who would be fluent in Chinese, and who would immediately recognize the opponent’s CHINESE CHARACTERS mark as a component of the applied-for mark. However, in the absence of any evidence on point, I cannot conclude that the number of Canadians fluent in Chinese would be significant.”).



language marks. In doing so, it confirmed that the prior judicial explanation of *who* the consumer is – the target consumer of the product, instead of the general public – remains the same whether the court is applying the test for confusion generally or with respect to foreign-language marks specifically:

“I do not think that the Registrar is saying that, for the purpose of determining the likelihood of confusion, the “average Canadian” could never be a person who understood the relevant foreign language and that as a matter of law the language understood by the “average consumer” of particular wares or services is not capable of being one of the “surrounding circumstances” to which the Registrar must have regard. ... Thus, in *Canadian Schenley Distilleries Ltd. v. Canada’s Manitoba Distillery Ltd.* (1975), 25 C.P.R. (2d) 1 (F.C.T.D.) Cattnach J. said (at page 5): “To determine whether two trademarks are confusing one with the other it is the persons who are likely to buy the wares who are to be considered, that is those persons who normally comprise the market, the ultimate consumer.” A similar proposition can be found in *McDonald’s Corp. v. Coffee Hut Stores Ltd.* (1994), 55 C.P.R. (3d) 463 (F.C.T.D.), at page 475; *affd* by (1996), 68 C.P.R. (3d) 168 (F.C.A.), where it was said that the likelihood of confusion should be assessed, not from the perspective of the “average person, but from that of the “average person” who is likely to consume the wares or services in question”.”<sup>118</sup>

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<sup>118</sup> *Cheung Kong*, *supra* note 9 at paras 62, 64. The Federal Court of Appeal recently confirmed this in *MC Imports Inc v AFOD Ltd*, 2016 FCA 60 at paras 59, 61 (“Further, where such an inquiry is necessary, the relevant ordinary consumer from whose perspective this question ought to be considered is the ordinary consumer of the products or services with which the Mark is associated. ... I note that even authorities citing *Parma* have tended not to adopt the view that the “general public” is the relevant consumer perspective, referring instead to the ordinary consumer of the wares or services with which the trademark is used”). *MC Imports* also emphasized at para 76 that even evidence of secondary meaning must be “from the perspective of the relevant public – that is, people who actually use the product or service in question –”).

Therefore, linguistic knowledge is considered a relevant circumstance if there is evidence to prove that the target consumer of the product understands the foreign language used in the trademark.<sup>119</sup> The leading case of *Cheung Kong* found proof of linguistic knowledge because the business targeted the Chinese community in Toronto, where a substantial number of consumers understood the Chinese-language mark.<sup>120</sup> And the succeeding case of *Saint Honore* found proof of linguistic knowledge because the business targeted the Chinese community in Vancouver, where a substantial portion of the target consumers understood the Chinese language.<sup>121</sup> It is important to note that the last two cases do not mean that the test for confusion can be applied regionally. The Supreme Court of Canada has made it clear that the test for confusion needs to be

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<sup>119</sup> *Cheung Kong*, *supra* note 9 at para 65 (“An application of this principle to the particular issue in dispute in this case would indicate that, if it could be inferred from the evidence that a significant portion of the likely consumers of Living Realty’s clients were familiar with Chinese characters, the Registrar should take this into consideration as part of the “surrounding circumstances” when determining whether there is a likelihood of confusion with Cheung Kong’s mark.”).

<sup>120</sup> *Cheung Kong*, *supra* note 9 at paras 57-58 (“Indeed, the facts suggest that a substantial number of consumers of Living Realty’s service understand the meaning of the Chinese characters that comprise its proposed mark. First, Living Realty’s business has been centred on the sale of real estate in Toronto, although it has also included properties in the surrounding area. I am prepared to take judicial notice of the existence of a significant Chinese community in Greater Toronto. Second, Mr. Chan stated that Living Realty “targeted” the Chinese community, although not to the exclusion of non-Chinese clients. In the light of these facts, it would be hard to maintain that a substantial number of actual consumers were not reasonably likely to confuse Living Realty’s mark with Cheung Kong’s as a result of the identical and distinctive nature of the idea conveyed by the mark, particularly given the similarities of the services offered by the parties.”).

<sup>121</sup> *Saint Honore*, *supra* note 91 at paras 47-48 (“In the present case, the Court is of the opinion that it was open to the Board to find that a substantial portion of the respondent’s actual consumers would be able to read and understand Chinese characters. As noted by the Board, the Cheung Jr. and Sr. affidavits establish that the respondents target the Chinese community in the Greater Vancouver area. The respondent has prominently displayed the Chinese characters of its trademarks for decades in the Greater Vancouver area, including in the exterior signage of the bakeries of the respondent and its licensee, as well as in letterhead, envelopes, business cards, promotional wedding pastry cards, and an entry with a directory of businesses listed under their Chinese character names. The Cheung Jr. affidavit also demonstrates that the Chinese characters of the respondent’s trademarks are displayed prominently on its cake boxes, plastic bags and disposable paper pastry cup used to package the bakery products. The fact that the respondent uses Chinese characters consistently and in so many of its materials suggests that it believes many of its customers will be able to read and understand them (see *Cheung Kong*, above at para 77). Moreover, the 2012 Cheung Jr. affidavit mentions a 2010 survey conducted by the respondent in June and July 2010 in which the respondent distributed customer survey forms available either in English or in Chinese. The respondent received 2,259 survey forms in return, of which 1,905 were in Chinese and 354 were in English. The fact that 84% of the customers who filled out a survey could read and understand written Chinese lends further support to the Board’s finding that a substantial portion of the respondent’s actual customers would be able to read and understand Chinese characters.”).

applied nationally because trademark registration is nationwide.<sup>122</sup> The last two cases only took the linguistic demographics of specific geographic territories into account because such evidence proved the linguistic knowledge of the target market, which happened to be limited to Toronto and Vancouver.

The inclusion of linguistic knowledge as a relevant circumstance is a purposive interpretation that is valid statutorily. Canada's *Trademarks Act* sets out the test for confusion by requiring that "all" circumstances that are relevant to the issue of confusion be considered, not just those specified in the non-exhaustive list. More importantly, linguistic knowledge is not just relevant to the general issue of confusion but is also relevant to the specific factor of resemblance.<sup>123</sup> Not only was the Federal Court of Canada's interpretation correct in 2000 in the *Cheung Kong* case, the wisdom of such an interpretation became clear in 2011 in the *Saint Honore* case. Applying the test for confusion to foreign-language marks by imagining *the fluent consumer* resulted in the SAINT HONORE marks being declared to be confusing. Failing to do so would have allowed a competitor to continue copying the Original Mark *ad infinitum* by adding a different English translation each time. Once again, it seemed that the pastry world was

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<sup>122</sup> *Masterpiece*, *supra* note 99 at paras 30-31, 33 ("It is immediately apparent from these words, "if the use of both ... in the same area", that the test for confusion is based upon the hypothetical assumption that both trade-names and trademarks are used "in the same area", irrespective of whether this is actually the case. As a result, geographical separation of otherwise confusingly similar trade-names and trademarks does not play a role in this hypothetical test. This must be the case, because, pursuant to s. 19, subject to exceptions not relevant here, registration gives the owner the exclusive right to the use of the trademark throughout Canada. In order for the owner of a registered trademark to have exclusive use of the trademark throughout Canada, there cannot be a likelihood of confusion with another trademark anywhere in the country. ... Whether in assessing trademark infringement under s. 19 or entitlement under s. 16, the test for likelihood of confusion is the same. The application of the hypothetical test reflects the legislative intent to provide a national scope of protection for registered trademarks in Canada (see David Vaver, *Intellectual Property Law: Copyright, Patents, Trademarks* (2nd ed 2011) at 526.").

<sup>123</sup> *Masterpiece*, *supra* note 99 at para 49 ("As Professor Vaver points out, if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar (Vaver, at p. 532). As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start (Vaver, at p. 532).").

restored to its original position with the ANNA marks registered and the SAINT HONORE marks denied registration.

### **4.3 The Problem of Proving Linguistic Knowledge Creates Inequality in Canada**

Since the test for confusion originally ignored the linguistic knowledge of the consumer, all foreign-language marks were equally ignored with respect to their meanings. Now that the test for confusion considers linguistic knowledge as part of the surrounding circumstances, the result is a discrepancy in the treatment of different foreign-language marks. For example, the Spanish language mark KOLA LOKA was not confusing with the English-language mark because less than 1% of the Canadian population being targeted understood Spanish. It is not clear what percentage will be deemed to be significant, but 4.8% has been the lowest cited to date for a trademark confusion case.<sup>124</sup> Nor is it clear what the actual number is behind the phrase “less than 1%”. But an estimate of 30 million for the Canadian population back then might have meant a Spanish linguistic population of around 300,000, which is a significant number of people to ignore. Contrast that with the two cases involving Chinese-language marks where confusion was found because judicial notice was taken of the existence of significant Chinese communities in the Toronto and Vancouver cities being targeted. A discrepancy in the treatment of different foreign-language marks in Canada is undesirable for two reasons.

First, it is inconsistent with equality principles reflected in the *Canadian Charter of Rights and Freedoms* and other human rights legislation.<sup>125</sup> While the test for confusion is to be

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<sup>124</sup> *Diageo Canada Inc v Heaven Hill Distilleries, Inc*, 2017 FC 571 at para 94 (“Indeed, the rate of confusion Courts have previously found to be sufficient to establish a likelihood of confusion ranges from: 4.8% to 8.2% in *Walt Disney Productions v Triple Five Corp*, 1994 ABCA 120 ...; 11% in *New Balance Athletic Shoes Inc v Matthews*, [1992] TMOB No 358 ...; and 13.5% in *Kirkbi AG v Ritvik Holdings Inc*, 2002 FC 585 [affirmed by the FCA and the SCC without any discussion of the percentage issue].”) [*Diageo*].

<sup>125</sup> *Canadian Charter of Rights and Freedoms*, Part I of the *Constitution Act, 1982*, being Schedule B to the *Canada Act 1982* (UK), 1982, c 11, s 15 (**Equality Rights** – “Every individual is equal before and under the law without

applauded for recognizing the linguistic diversity of Canada, it should lead to equality for all and not favouritism for some (*e.g.*, the economic clout, political influence, or simple visibility of Chinese consumers). Canada has a multicultural population that uses many foreign languages, including all six official languages of the United Nations: English, French, Spanish, Chinese, Russian, and Arabic. It is incongruous that the first Romanized three languages receive more protection than the last three non-Romanized languages. In the same manner, the test for confusion must not take judicial notice of linguistic knowledge for Chinese-language marks while continuing to treat other foreign-language marks as inarticulate designs. This is because the decision to recognize the Chinese language is supported by the statistical evidence rather than the commitment to substantive equality, which would not require such evidence to assess the relative worth of a language. The emphasis on statistics and the “reality” of Chinese consumers vis-à-vis other foreign-language consumers does not adequately reflect the multicultural values of Canadian society. The resulting stratified system is unacceptable in light of the fact that reliance on these statistics is arbitrary: there is neither statutory authority nor a judicial basis for why the linguistic populations for the Spanish-language mark KOLA LOKA and the German-language mark BLAUPUNKT are insufficient, while the linguistic population for Chinese-language marks is worthy of recognition. Such a system gives the impression that some linguistic populations have more value than others. The courts should not be encouraging a two-tier system that could perpetuate an injustice,<sup>126</sup> as such a system is contrary to *Charter* values based on a

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discrimination and, in particular, without discrimination based on race, national or ethnic origin, colour, religion, sex, age or mental or physical disability.”). *Canadian Human Rights Act*, RSC 1985, c H-6, s 3(1) (**Prohibited grounds of discrimination** – “For all purposes of this Act, the prohibited grounds of discrimination are race, national or ethnic origin, colour, religion, age, sex, sexual orientation, marital status, family status, disability and conviction for an offence for which a pardon has been granted or in respect of which a record suspension has been ordered.”). There are similar legislation at the provincial level [*Charter*].

<sup>126</sup> *Little Sisters Book and Art Emporium v Canada (Commissioner of Customs and Revenue)*, 2007 SCC 2 at para 5 (“The Court did not seek to create a parallel system of legal aid or a court-managed comprehensive program to supplement any of the other programs designed to assist various groups in taking legal action, and its decision

speculative assessment of linguistic knowledge. Even if a perfect assessment were created, with accurate statistics and clear percentages as to when a linguistic population is deserving of protection, the courts should still question the equality of relying on such evidence and should also attempt to remedy the differential treatment. Failing to identify the existence and undesirability of the *status quo* casts doubt on the commitment to substantive equality and to ensuring that the common law reflects *Charter* values.<sup>127</sup>

Second, it ignores Aboriginal linguistic populations. With the certainty that less than 1% of the Canadian population is insignificant, and the uncertainty of knowing what percentage will be deemed to be significant, Canada's Aboriginal people may never be able to prove the significance of their linguistic populations in their home and native land. For example, Statistics Canada indicates that the entire Aboriginal population (1,400,685) makes up 4.3% of the total Canadian population. Even if all Aboriginals shared the same language, and even if every Aboriginal understood that common language, the entire Aboriginal percentage of the population is still lower than 4.8%, the lowest percentage cited to date for a trademark confusion case.<sup>128</sup> The entire Aboriginal population can be broken down into the following groups: the Inuit population (59,445) represents 0.2% of the Canadian population; the Métis population (451,795) represents 1.4% of the total Canadian population; and the First Nations population (851,560) represents 2.6% of the total Canadian population. Depending on how we define a language, these

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should not be used to do so. The decision did not introduce a new financing method for self-appointed representatives of the public interest. This Court's *ratio* in *Okanagan* applies only to those few situations where a court would be participating in an injustice – against the litigant personally and against the public generally – if it did not order advance costs to allow the litigant to proceed.”). Although this was about the SCC allowing alternatives in order to avoid an injustice, an argument can be made that the principle equally applies in that the SCC should not allow alternatives that perpetuate an injustice.

<sup>127</sup> Elizabeth Adjin-Tettey, “Replicating and Perpetuating Inequalities in Personal Injury Claims Through Female-Specific Contingencies” (2004) 49 McGill LJ 309 at 342 (“Whitmann J.A., speaking for a unanimous court, acknowledged the suggestion of the Supreme Court of Canada that the common law, and therefore tort law, must be interpreted in a manner consistent with Charter values.”).

<sup>128</sup> *Diageo*, *supra* note 124 at para 94.

groups can be broken down again into different linguistic populations, which will only further reduce their percentage and their significance according to the test for confusion.<sup>129</sup> Requiring evidence of linguistic knowledge of the target consumers may seem to support substantive equality; however, it shows that such judicial notice is based on statistics rather than a desire for substantive equality. Although the evidence required for judicial notice may appear to rely on statistics and reflect “reality”, this approach perpetuates racial and ethnic inequalities. The court’s discretionary acceptance of evidence not only maintains these disparities, but also carries them into the future. To ignore Aboriginal linguistic populations on the principle of *de minimis non curat lex* would be contrary to the frequency and intensity with which the law has meddled historically in their lives.<sup>130</sup> This is unacceptable in light of the fact that Aboriginal linguistic populations were reduced significantly due to a Canadian policy of forced assimilation for nearly 200 years<sup>131</sup> through cultural genocide and language prohibition,<sup>132</sup> whereby residential schools “regularly reported on their success in suppressing Aboriginal languages”<sup>133</sup> even though many of the students were originally “fluent in an Aboriginal language, with little or no understanding of French or English.”<sup>134</sup> Until Aboriginal language rights are acknowledged in the same manner

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<sup>129</sup> Statistics Canada, *Aboriginal Peoples in Canada: First Nations People, Metis and Inuit*, Catalogue No 99-011-X (Ottawa: Statistics Canada, 8 May 2013), online: <<http://www12.statcan.gc.ca/nhs-enm/2011/as-sa/99-011-x/99-011-x2011001-eng.cfm>>.

<sup>130</sup> In addition to at least 10 Acts for which it shares responsibility with a provincial government, Parliament has the sole responsibility for at least 78 Acts. The fact is that Parliament busies itself with governing Aboriginal peoples in areas including, but not limited to, condominium, water, family homes and matrimonial interests, commercial and industrial development, financial transparency, fiscal management, education, land management, minerals revenue sharing, gender equity, soldier settlement, and even elections and self-government! See Indigenous and Northern Affairs Canada, “List of Acts, 27 June 2017), online: <<http://www.aadnc-aandc.gc.ca/eng/1100100032317/1100100032318>>.

<sup>131</sup> Truth and Reconciliation Commission of Canada, *Honouring the Truth, Reconciling for the Future: Summary of the Final Report* (Ottawa: Public Works and Government Services of Canada, 23 July 2015) at 134, online: <[http://www.trc.ca/websites/trcinstitution/File/2015/Honouring\\_the\\_Truth\\_Reconciling\\_for\\_the\\_Future\\_July\\_23\\_2015.pdf](http://www.trc.ca/websites/trcinstitution/File/2015/Honouring_the_Truth_Reconciling_for_the_Future_July_23_2015.pdf)> [TRC Report].

<sup>132</sup> TRC Report, *supra* note 131 at 1.

<sup>133</sup> TRC Report, *supra* note 131 at 83.

<sup>134</sup> TRC Report, *supra* note 131 at 85.

that Aboriginal rights<sup>135</sup> are acknowledged in the *Charter of the French Language*,<sup>136</sup> or Aboriginal languages are recognized in an Aboriginal Languages Act<sup>137</sup> in the same way that the Inuit language is recognized in the *Consolidation of Inuit Language Protection Act*,<sup>138</sup> the current application of the test for confusion means that Aboriginal people will continue to receive less protection for their language in their own country than an American company has always received for its English-language marks – and a Chinese company now receives for its Chinese-language marks – in Canada. At a minimum, Aboriginal businesses should not be worse off than foreign businesses from the United States or China. Even though the two statutes above must receive judicial notice, they are still insufficient because their recognition of Aboriginal rights in Quebec or the Inuit language in the Nunavut does not guarantee recognition of an Aboriginal-language mark that targets a national or international market.

Perhaps it appears reasonable in theory that the case law should continue to require proof of linguistic knowledge for foreign-language marks, but it is not realistic in practice. One example is COCA-COLA commercials with Olympic greetings or Christmas wishes. These commercials display COCA-COLA in multiple languages and are advertised to the American-Canadian public at large during Olympic games or Christmas movies.<sup>139</sup> In such a situation, it would be difficult to prove that the ordinary purchaser understood the foreign-language marks since no average consumer would understand so many languages. While an easy solution would be to customize the commercials for specific linguistic groups and advertise only in specific

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<sup>135</sup> TRC Report, *supra* note 131 at 202.

<sup>136</sup> *Charter of the French Language*, CQLR c C-11.

<sup>137</sup> TRC Report, *supra* note 131 at 204.

<sup>138</sup> *Consolidation of Inuit Language Protection Act*, SNu 2008, c 17 [*Inuit Act*]. A territory's statute must receive judicial notice.

<sup>139</sup> Dinwoodie, *International IP*, *supra* note 86 at 113 (“By developing its ads for global consumption, Coca-Cola has acknowledged that it is targeting the world market, where it dominates Pepsi, rather than the United States, where it still heatedly competes with its rival. Over the past decade, Coke has made an aggressive push overseas ...”).



target markets, doing so would defeat the global spirit of community which the multilingual commercials sought to foster. Just as the common law is developed to accommodate new reasonable commercial practice, why should statutory interpretation not mirror such a development where the statute is capable of bearing such a construction (because of the canon of statutory interpretation that the law is always speaking)?<sup>140</sup> At the opposite end of the spectrum is the example of small start-ups like Aboriginal businesses that become successful enough to expand from a local market to a national or international market. Given their small linguistic populations, such businesses will lose the ability to prove that a significant number or percentage of their expanded market understand their Aboriginal-language marks.<sup>141</sup> In other words, any economic gains for Aboriginal businesses would mean linguistic losses for Aboriginal-language marks. Such examples will only increase as businesses continue to engage in brand extension or cross-branding with foreign-language marks in order to access new untapped markets.

It is important to note that this dissertation is advocating cultural respect for and equal recognition of classical and natural languages only, including obscure languages such as Aboriginal languages. We must remember the historical example of how Hebrew became an obscure language around the 2<sup>nd</sup> Century, only to be revived for regular usage around the 19<sup>th</sup> Century and to become a national language with the creation of Israel in 1948.<sup>142</sup> This dissertation is not advocating on behalf of constructed and invented languages such as Dothraki

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<sup>140</sup> *Interpretation Act*, RSC 1985, c I-21, s 10 (**Law always speaking** – “The law shall be considered as always speaking, and where a matter or thing is expressed in the present tense, it shall be applied to the circumstances as they arise, so that effect may be given to the enactment according to its true spirit, intent and meaning.”).

<sup>141</sup> Canada found that a 1986 census of Spanish-speaking population of 83,130 was insufficient evidence of linguistic knowledge in *Krazy Glue*, *supra* note 104 at 4. Australia found likewise with a 2001 census of Italian-speaking population of 350,000 in *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd*, [2014] HCA 48 at paras 75-76, 103 [*Cantarella*].

<sup>142</sup> Angel Saenz-Badillos, *A History of the Hebrew Language*, translated by John Elwolde (Cambridge: Cambridge University Press, 1993) at 170-171, 267-269. See Michael Mandel, *The Jewish Hour: The Golden Age of a Toronto Yiddish Radio Show and Newspaper* (Toronto: Now and Then Books, 2016) at 14, 211, and 265 for how Yiddish and Ladino (the Jewish languages spoken by the Polish and Spanish Jews respectively) declined after “the deliberate murder of two-thirds of the Jews of Europe, ninety per cent of the Jews of Poland and about one-third of the Jews of the whole world” during the Second World War.

from Games of Throne, Elvin from Lord of the Rings, Klingon from Star Trek, and Na'v from Avatar. This is notwithstanding the fact that the number of speakers and dollars for obscure languages are miniscule compared to those for languages popularized by television series and movies. For example, CBS and Paramount are currently suing a fan who raised one million dollars to film a documentary based on Star Trek.<sup>143</sup> The lawsuit claims copyright infringement on the basis that Klingon was created for the television series and, therefore, copyrightable in the same manner as computer programming.<sup>144</sup> Canada's world reputation historically has been one of peaceful pluralism, ranging from Prime Minister Lester Pearson's creation of peacekeepers (awarded the Nobel Peace Prize in 1957) to Prime Minister Pierre Trudeau's creation of the Multiculturalism Act (passed in 1988). Canada can promote this multicultural heritage by reforming its trademark law to recognize foreign- and aboriginal-language marks in a way that eliminates disparities by valuing all languages equally. While other countries seek to harmonize international trademark laws, expand protection for well-known marks, and create new rights for unconventional marks for the benefit of corporations, Canada ought first to recognize the languages and cultures of its people.

#### **4.4 The Problem of Proving Linguistic Knowledge Lacks Statutory Basis in Canada**

Canada's *Trademarks Act* sets out the test for confusion without making any reference to languages: it neither differentiates between official languages and foreign languages nor requires evidence as to the existence of a linguistic population in order to assess foreign-language marks. So how did these differentiation and requirement appear in the Canadian case law? They first

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<sup>143</sup> *Paramount*, *supra* note 23.

<sup>144</sup> *Oracle*, *supra* note 22.

appeared in 1992, when the court rejected and proposed its own alternative to the American doctrine of foreign equivalents:

“In relation to the enumerated circumstances in s. 6(5) of the Act, the main issue to be determined on this appeal is the degree of resemblance in the ideas suggested by the two trade-marks. Even accepting the evidence of the appellant that “kola loka” is the phonetic equivalent of “cola loca” which means “crazy glue” in Spanish, *it would be necessary for the average consumer, having a vague or imperfect recollection of the registered trade-mark KRAZY GLUE, to be capable of making this translation from Spanish to English in order to be confused by the ideas suggested by KRAZY GLUE and KOLA LOKA.* However, I have found as a fact that *only a minimal proportion of the Canadian population speaks Spanish as a mother tongue or understands Spanish sufficiently to be capable of making the translation.* I therefore conclude, on the basis of the facts, as established by the evidence, that the average consumer, having a vague or imperfect recollection of the registered trade-mark KRAZY GLUE, would find no degree of resemblance whatsoever in the ideas suggested by KOLA LOKA and KRAZY GLUE.”<sup>145</sup> [*emphasis added*]

These differentiation and requirement were repeated in the succeeding Trademarks Opposition Board decisions involving the BLAUPUNKT and SAINT ANNA marks, which found respectively that “no evidence has been presented to show that any Canadians understand German”<sup>146</sup> and “I cannot conclude that the number of Canadians fluent in Chinese would be

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<sup>145</sup> *Krazy Glue*, *supra* note 104 at 171.

<sup>146</sup> *Blaupunkt*, *supra* note 115 at 403.

significant”.<sup>147</sup> Although the later court decisions on the CHEUNG KONG and SAINT HONORE marks clarified that the test for confusion focuses on the target consumer of the product, and not the general public, they still continued to perpetuate these differentiation and requirement:

“If [the examiner] based his conclusion on the fact that the “average Canadian” cannot read Chinese characters, without regard to whether the *evidence in this case indicated that a significant number of the actual consumers of Living Realty’s services were likely to transliterate the first two characters of the proposed mark into CHEUNG KONG, or translate it into “long river”, then with respect I think he erred in law. Neither KRAZY GLUE, supra, nor the BLAUPUNKT case, supra, goes this far. Both turned ultimately on the absence of evidence about the number of consumers able to translate the foreign language marks into English.*”<sup>148</sup> [*emphasis added*]

More important than the question of origin is the question of correctness. Just because these differentiation and requirement appear in the Canadian case law do not mean that they should be there. On the contrary, they incorrectly read into and improperly add a layer of complexity that was never in Canada’s *Trademarks Act*. The statutory permission to prove *the confusion arising from* linguistic knowledge cannot necessarily be interpreted as a statutory requirement to prove *the existence of* linguistic knowledge. There is a difference between simply considering linguistic knowledge *while* assessing how a consumer perceives a trademark and

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<sup>147</sup> *Saint Anna TMOB, supra* note 98 at 268.

<sup>148</sup> *Cheung Kong, supra* note 9 at paras 67-68. And see *Saint Honore, supra* note 91 at para 47 (“In the present case, the Court is of the opinion that it is open to the Board to find that a substantial portion of the respondent’s actual consumers would be able to read and understand Chinese characters.”).

actually requiring evidence of linguistic knowledge *before* assessing a consumer's perception of a trademark.

It is clear from this chapter that the trademark litigation involving two Chinese bakeries in Canada illustrate a judicial challenge of proving linguistic knowledge for foreign-language marks affect traders and consumers from all countries with respect to all foreign languages.

# 5 JUDICIAL SOLUTION

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This chapter explains why the problem of proving linguistic knowledge is best addressed with the solution of assuming such knowledge, as the evidence required to prove linguistic knowledge changes constantly depending on international trade, multicultural consumers, brand extension and cross-branding in order to access untapped markets. Although the solution is illustrated through the specific example of a set of trademark cases in Canada involving two Chinese bakeries, the general issue is also relevant in other countries and to other foreign languages.

## **5.1 The Solution of Assuming Linguistic Knowledge**

It is questionable whether the case law should continue to require proof of linguistic knowledge for foreign-language marks, instead of assuming it so that their distinctiveness and confusion can be assessed in the same manner as trademarks in English or French.<sup>149</sup>

Even with English-language marks containing antique or rare words, or with French-language marks in areas of Canada where no French is spoken, it is never considered that the Canadian consumer might have little cultural exposure, limited vocabulary, no French skills, *etc.* For example, linguistic knowledge is assumed even with novel use of French words such as MAISON. The word was found to be descriptive of orange juice since MAISON had acquired a new meaning in France of “that which is made at home” or “of good quality”. The fact that the average French Canadian had not caught on to this new meaning did not change the court’s

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<sup>149</sup> Gredley, *supra* note 17 at 85 (“No English trade marks statute has ever made specific provision for marks in languages other than English, which have always been subject to the same legal principles as any others.”).

assumption of linguistic knowledge.<sup>150</sup> Likewise, an Australian court assumed linguistic knowledge even with uncommon English words such as EUTECTIC. The word was found to be descriptive of goods for welding, soldering and brazing because EUTECTIC meant “melting at low temperature” or “melting readily”. The fact that “most users of the applicant’s goods did not know, or had forgotten its meaning” did not change the court’s opinion that the technical term should remain in the public domain.<sup>151</sup>

Of course, the difference between foreign-language marks and those trademarks lies in the fact that English and French have official language status in Canada. There is no reason why this difference should matter. Canada’s *Trademarks Act* sets out the test for confusion without making any reference to languages: it does not differentiate between official languages and foreign languages. This means that there is no statutory authority for why linguistic knowledge needs to be proven instead of being assumed for foreign languages, just as there is no judicial

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<sup>150</sup> *Home Juice Co v Orange Maison Ltée*, [1970] SCR 942 at 944-945 (“Respondent has contended that the current meaning in France is not to be considered, that regard must be had only to the meaning current in Canada . . . . This contention would have serious consequences if it was accepted. One result would be that a shrewd trader could monopolize a new French expression by registering it as a trade mark as soon as it started being used in France or in another French-speaking country and before it could be shown to have begun being used in Canada. In my opinion, the wording of s. 12 does not authorize such a distinction.”) [*Home Juice*]. And see *Re an Application by La Marquise Footwear Inc’s Application* (1947) 64 RPC 27 at 31 (“I think it would be an affectation to say that a word which has gained any currency as an American slang word ought to be treated in these islands, in the absence of any evidence one way or the other, as a foreign word.”) [*Re La Marquise*]. Contrast that with *Re Application No 81899, (sub nom Milk Link Ltd v Almighty Marketing Ltd)* (2005), O/149/05, aff’d O/341/06 at para 5 (“He summarised his findings with reference to the evidence in the following terms: . . . Most of the evidence has dealt with American usage. American and British English do diverge; they may use the same words meaning different things. In such cases it may be necessary to view the languages as being different languages. Such is the case here. There is no indication that the British public has been exposed to the phrase MOO JUICE in such a manner that it will have seen it as a synonym for milk. The best that Link can muster to support its case is one incidence in one television programme.”).

<sup>151</sup> *Cantarella*, *supra* note 141 at para 91, discussing *Eutectic Corporation v Registrar of Trade Marks*, (1980) 32 ALR 211 (“It was not in ordinary use by members of the community; most users of the applicant’s goods did not know, or had forgotten its meaning; and there was no evidence of its use by other traders. It was, however, “a basic term used in metallurgy”, peculiarly appropriate to convey readiness to melt as a basic property of alloy. Refusing to conclude that EUTECTIC was inherently adapted to distinguish the applicant’s goods, and citing *Clark Equipment*, Rogers J said that “[w]hilstsoever there remains a need and use for the word by other traders in an honest description of their goods and the word retains its primary and technical meaning, it should remain free in the public domain’.”).

basis for why official-language marks are more deserving of protection than foreign-language marks.

The subsections below illustrate how the test for confusion can be applied consistently to all trademarks, regardless of the languages in which they are expressed, if linguistic knowledge were assumed for foreign-language marks.

### **5.1.1 Assessing for Distinctiveness**

Since an English-language mark is registrable only if it is distinctive or capable of becoming so, it follows that foreign-language marks that are generic or clearly descriptive should not be registrable.<sup>152</sup>

Generic marks are prohibited without any differentiation between official languages and foreign languages because their unregistrability applies to “the name in any language of any of the goods or services”.<sup>153</sup> In this regard, Chapter 6 discusses how the American doctrine of foreign equivalents protests the registration in foreign countries of product names in English, as well as prohibits the registration in the United States of generic words in a foreign language.<sup>154</sup>

Descriptive marks, however, are prohibited differently because their unregistrability is restricted to those which are “clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the goods or services”.<sup>155</sup> The restriction to the

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<sup>152</sup> Genericism is an absolute bar to registration, whereas descriptiveness is a relative bar to registration that can be overcome by acquiring distinctiveness, according to Vaver, *supra* note 21 at 479, 486. Contrast that with the European Union, which treats both genericness and descriptiveness as absolute grounds for refusal, according to *Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark*, [2009] OJ, L 78/1 at 7 (**Absolute grounds for refusal** – “1. The following shall not be registered: (b) trade marks which are devoid of any distinctive character; (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;”) [(*EC*) No 207/2009].

<sup>153</sup> *Trademarks Act*, *supra* note 19, s 12(1)(c).

<sup>154</sup> *Re Le Sorbet, Inc*, 1985 TTAB LEXIS 27 at \*9 (TTAB 1985) [*Re Le Sorbet*].

<sup>155</sup> *Trademarks Act*, *supra* note 19, s 12(1)(b).



English or French language is so specific that language combinations that are not translations may be clearly descriptive and still registrable:<sup>156</sup> LE JUICE for fruit juices is permitted even though the individual words are descriptive,<sup>157</sup> and WOLAINE for textile and fabric is permitted because the combination as a whole is not the name of anything in either language.<sup>158</sup> This restriction to the English or French language also means that a foreign-language mark may also be clearly descriptive: TAM TAM for crackers and biscuits is permitted even though the Hebrew-language mark means “tasty”,<sup>159</sup> both MORINDA and TAHITIAN NONI are permitted for skin products and dietary supplements derived from trees with the Polynesian names “morinda” and “noni”.<sup>160</sup> Canada’s *Trademarks Act* should remove the restriction to the English or French language, and apply the prohibition to any language, for two reasons.

First, *Home Juice* suggests that the purpose of prohibiting clearly descriptive marks is to ensure that “a shrewd trader [does not] monopolize a new French expression by registering it as a trade mark as soon as it started being used in France or in another French-speaking country and

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<sup>156</sup> *Canadian Dental Hygienists’ Association/L’Association canadienne des hygienists dentaires v Canadian Dental Association/L’Associaton Dentaire Canadienne*, 2011 TMOB 7 at paras 40, 48 and 2011 TMOB 8 at paras 41, 49 (“However, the present case is not a situation where the Applicant has telescoped two descriptive terms to create an invented word. Neither is it a situation where the combination of two languages has been taken together to formulate the trademark. Instead, in the present case, the Applicant has joined a clearly descriptive English mark with its equivalent clearly descriptive French mark in order to produce a mark which would be clearly descriptive in both languages to the bilingual consumer; the English and French portions are merely translations of each other. ... In my view, Parliament could not have intended that a mark which is clearly descriptive or deceptively misdescriptive in one of Canada’s official languages could be registrable as long as its equivalent translations in Canada’s other official language was also part of the mark.”).

<sup>157</sup> *Coca-Cola Co v Cliffstar Corp* (1993), 49 CPR (3d) 358 (TMOB) at 361 (“The applicant’s proposed mark is comprised of the French word “le” and the ordinary English word “juice”. The former word is a definite article in the French language. The latter word is clearly descriptive in the English language of the character of the wares “fruit juices” and the applicant has conceded this by including a disclaimer in its application. The combination of the two words, however, does not offend the provisions of s. 12(1)(b) of the Act.”).

<sup>158</sup> *Wool Bureau of Canada Ltd v Bruck Mills Ltd* (1980), 61 CPR (2d) 108 (TMOB) at 113 (“In the case of the trade mark WOLAINE, I do not consider that the average person in Canada would attribute to the trade mark the meaning which one might arrive at by dissecting the mark into its component parts considering its derivation from the words ‘wool + laine’.”)

<sup>159</sup> *Gula v Manischewitz Co* (1947), 8 CPR 103. Contrast that with the American doctrine of foreign equivalents, which prohibited the registration of SAPORITO for sausages because the Italian-language mark means “tasty”, according to *Re Geo A Hormel & Co*, 227 USPQ 813 (TTAB 1985).

<sup>160</sup> *Primalda Industries Corp v Morinda, Inc*, 2004 CanLII 71775.

before it could be shown to have begun being used in Canada.”<sup>161</sup> This purpose is important enough for the courts to extend the prohibition even to clearly descriptive words used as a compound mark, as an ellipse, or with corrupted spelling.<sup>162</sup> Therefore, this rationale should also apply to foreign-language marks now that the courts include linguistic knowledge in the test for confusion. It is important that traders be prohibited from doing in a foreign language what they cannot do in the English or French language; namely, monopolize common words and prohibit others from their generic or clearly descriptive use.<sup>163</sup>

Second, Canada’s abandonment of the use requirement for trademark applications will open the door for trademark squatting in Canada. Trademark applicants may try to circumvent the prohibition against registering a mark which is clearly descriptive in English or French by adding a Chinese translation of the trademark, just as a Chinese bakery kept trying to circumvent its competitor’s Chinese-language mark by copying it and adding a different English translation each time.<sup>164</sup> This danger is real now that the courts have taken judicial notice of linguistic knowledge for Chinese-language marks, as China is suspected of being the largest nation of trademark squatters in the world.<sup>165</sup> Removing the restriction to the English or French language

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<sup>161</sup> *Home Juice*, *supra* note 150 at 944-945.

<sup>162</sup> English-language marks are unregistrable in Canada even if the clearly descriptive word is used in a compound mark (COCA-COLA for “soda drinks” in *Pepsi-Cola*, *supra* note 102; as an ellipse (OFF! for “insect repellent” in *SC Johnson & Son Ltd v Marketing Int’l Ltd*, [1980] 1 SCR 99; FRIGIDAIRE for “refrigerators” in *General Motors Corp v Bellows*, [1949] SCR 678; O CEDAR for “polishing oil” in *Channel Co v Rombough*, [1924] SCR 600); or with corrupted spelling (SHUR-ON and STAY-ZON for “eye-glass frames” in *Kirstein Sons & Co v Cohen Bros* (1907), 39 SCR 286).

<sup>163</sup> *Cantarella*, *supra* note 141 at para 44 (“The requirement that a proposed trade mark be examined from the point of view of the possible impairment of the rights of honest traders to do that which, apart from the grant of a monopoly, would be their natural mode of conducting business ..., and from the wider point of view of the public ..., has been applied to words proposed as trade marks for at least a century, irrespective of whether the words are English or foreign.”). The High Court of Australia, however, went on to find that ORO and CINQUE STELLE (Italian for “gold” and “five stars” respectively) were not descriptive of coffee products because at least 350,000 Italian speakers in Australia were insufficient to prove linguistic knowledge.

<sup>164</sup> *Saint Honore TMOB*, *supra* note 110.

<sup>165</sup> Daniel Chow, “Trademark Squatting and the Limits of the Famous Marks Doctrine in China” (2014) 47:1 *Geo Wash Intl L Rev* 57 at 60 (“The prevalence of trademark squatting in China has led to the accusation that China is among the largest, if not the largest, nation of squatters.”).

will enable Canada to follow other countries in prohibiting foreign-language marks that are clearly descriptive even if they are used in a varied form, as slang, or with phonetic spelling.<sup>166</sup>

The chart below shows that the prohibition against generic and descriptive marks should apply not just to foreign words but also to their English transliterations, which can become standardized and accepted English words. This is why it is necessary for trademark applications to require translations of foreign-language marks, in order to determine whether the equivalent English-language marks would be registrable, so as to avoid accidentally registering generic or clearly descriptive words in other languages. Therefore, foreign-language marks should be assessed for distinctiveness based on their translation(s) into the official language(s) of the country assessing the trademark (which would include French in Canada).

<b>Foreign Words</b>	<b>English Transliterations that became standardized and accepted English words</b>
الاجتماع Arabic for “reunion of broken parts”	ALGEBRA
豆腐 Chinese for “bean curd”	TOFU
Αγορά Greek for “gathering place”	AGORA
אמן Hebrew for “verily” or “so be it”	AMEN
Pronounced “ka-na-ta” Huron-Iroquois for “village” or “settlement”	CANADA

<sup>166</sup> Foreign-language marks are unregistrable in other countries even if used in a varied form (DIABOLO from the Italian DIAVOLO for a type of game called “the devil on two sticks” in *Philippart v William Whiteley Ltd*, [1908] 2 Ch 274); as a slang (CHUPA in Spanish for “lollipop” in *Enrique Bernat F SA v Guadalajara, Inc*, 210 F (3d) 439 (5th Cir 2000) [*Enrique Bernat*]; or with phonetic spelling (SHORINJI KEMPO from the Japanese characters for a type of “martial arts” such as Judo, Karate and TaeKwonDo in *British Shorinji Kempo Fed v Shorinji Kempo Unity*, [2014] EWHC 285 (Ch)).

カラオケ Japanese for “empty orchestra”	KARAOKE
김치 Korean for “soaked vegetable”	KIMCHI
Кремль Russian for “castle” or “fortress”	KREMLIN
योग Sanskrit for “to unite”	YOGA

### 5.1.2 Comparing for Confusion

Contrary to assessing for distinctiveness, foreign-language marks should not be compared for confusion based only on their translations. Since English-language marks are compared for confusion by considering the target consumers of the goods and services, it follows that the foreign-language marks should not be compared for confusion by considering only the general public.<sup>167</sup>

Confusing marks are prohibited without making any reference to languages.<sup>168</sup> This is consistent with how the test for confusion does not differentiate between official languages and foreign languages. In this regard, judicial application of the test for confusion initially errs in requiring evidence of linguistic knowledge instead of assuming it, and further errs (and

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<sup>167</sup> Confusion is an absolute bar to registration according to Vaver, *supra* note 21 at 479. Contrast that with the European Union, which treats confusion as a relative ground for refusal, according to (EC) No 207/2009, *supra* note 152 at 8 (**Relative grounds for refusal** – “1. Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered: (b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods and services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected, the likelihood of confusion includes the likelihood of association with the earlier trade mark;”).

<sup>168</sup> *Trademarks Act*, *supra* note 19, s 12(1)(d).

contradicts itself) in basing the comparison on the English translation instead of on the foreign-language mark for two reasons.

First, consumers who understand the foreign language used in the trademark have no need to translate it into English. The translation problems discussed in Chapter 3 – the unflattering translations for COLA-COLA; as well as the name changes for PEPSI, KFC, and MCDONALD’S without corresponding changes in the translations – all suggest that courts cannot assume that a foreign-language mark is intended to be translated or what the translation will be. It is only Canadian examiners and the judiciary who need to translate the trademarks in order to understand and discuss the ideas suggested by the trademarks, but it is misleading then to base the comparison on the translation instead of the foreign-language mark in question.<sup>169</sup> An example is how COLA lacked distinctiveness since it meant “carbonated drink, soft drink, soda, or pop”. If it had been translated based on its meaning, then its Chinese equivalent would have been 氣水 (QI4 SHUI3 means “air water”). However, it was translated based on its sound instead as 可樂 (KE3 LE4 was distinctive in Chinese when first coined in 1933). This meant that although PEPSI-COLA was found to be not confusing with COCA-COLA in English,<sup>170</sup> 百事可樂 would have been confusing with and should have been stopped by the previous use of 可口可樂 in Chinese. This was not done and, as a result, 可樂 became a generic word in the Chinese lexicon (just like COLA in English). Another example of how comparing for confusion in different languages could produce different results comes from the discussion earlier of how Canada found two Chinese trademarks to be distinctive in a 1992 decision, only to contradict itself in a 2011 decision by finding the same two Chinese trademarks to be confusing.

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<sup>169</sup> This becomes even more obvious when we remember that even if particular examiners or judges were to know the language, they may not be entitled to take judicial knowledge of this specialization because other examiners or judges cannot be assumed to have it.

<sup>170</sup> *Pepsi-Cola*, *supra* note 102 at 617-618.

Comparing only the English translations in the 1992 decision resulted in no confusion between ANNA’S CAKE HOUSE and SAINT ANNA BAKERY, but comparing the actual Chinese-language marks in the 2011 decision resulted in confusion even with the attached English translations of ANNA’S CAKE HOUSE and SAINT HONORE CAKE SHOP.<sup>171</sup> Failing to assume linguistic knowledge would have allowed competitors to copy the Chinese-language mark *ad infinitum* by adding a different English translation each time.

Second, consumers who do not understand the foreign language in the trademark would simply see it as a design and could still be confused (or not), just as with any other design. In this regard, Canadian examiner and the judiciary wrongly assume that a finding of linguistic knowledge (or lack thereof) results in a finding of confusion (or lack thereof) when the two issues are actually independent of each other. This is why the test for confusion should not require the additional evidence of linguistic knowledge but should remain focused on the original evidence of confusion, regardless of whether the said confusion arose from *fluent consumers* confused by the actual foreign “words” or from *illiterate consumers* confused by what they see as “designs”.

Therefore, a foreign-language mark should not be compared for confusion based only on its translation. This applies whether comparing with another trademark in the same foreign language, with another trademark in a different foreign language, or with another trademark in an official language of the country doing the assessment. The principles set out herein also apply to the subsections below, which are more specific illustrations of the same. The subsections below may seem counterintuitive at first, as they take the position that COCA-COLA should not bar competitors from registering the translation 可口可樂 or the pronunciation KE3 KOU3 KE3

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<sup>171</sup> *Saint Honore*, *supra* note 91.

LE4. Before we assume that the right to COCA-COLA also means a right to its foreign-language equivalents, we should remember that not even CLICQUOT had an automatic right to the 99% similar CLIQUOT for clothing, and not even BARBIE could stop the 100% similar BARBIE for restaurants.<sup>172</sup> If consumers can differentiate such similar English-language marks in order to associate them with different goods and services, then surely they can distinguish between an English-language mark and its foreign-language equivalents in order to correlate them with different traders.

### **5.1.2A Comparing for Confusion with Translations**

Since a claim in an English-language mark does not necessarily mean a monopoly on its synonyms,<sup>173</sup> subject to evidence of confusion,<sup>174</sup> it follows that a claim for a foreign-language mark should not encompass claims for its translations without similar evidence.

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<sup>172</sup> *Veuve Clicquot*, *supra* note 99. *Mattel*, *supra* note 99.

<sup>173</sup> Synonyms include everything ranging from slang and nicknames (COKE for COCA-COLA worldwide; MACCA'S for MCDONALD'S in Australia) to acronyms and abbreviations (KFC for KENTUCKY FRIED CHICKEN and IBM for INTERNATIONAL BUSINESS MACHINES; MAC for MCDONALD'S hamburger or MACTINOSH computers).

<sup>174</sup> No confusion was found between DAWN and DAYLIGHT for donuts in *Dawn Donut Co v Day*, 450 F (2d) 332 (10th Cir 1971); or HEAVEN and CELESTE for orbs and pendants in *Orb Factory, Ltd v Design Science Toys, Ltd*, 6 F Supp2d 203 (SDNY 1998). Confusion, however, was found between TORNADO and CYCLONE for wire fencing in *Hancock v American Steel & Wire Co of New Jersey*, 203 F (2d) 737 (CCPA 1953); PLEDGE and PROMISE for cleaning products in *SC Johnson & Son, Inc v Drop Dead Co*, 326 F (2d) 87 (9th Cir 1963); ALPINE and MOUNTAIN for artificial Christmas trees in *Masterpiece of Pennsylvania, Inc v Consolidated Novelty Co*, 368 F Supp 550 (SDNY 1973); ROACH MOTEL and ROACH INN for pest products in *Am Home Product Corp v Johnson Chemical Co*, 589 F (2d) 103 (2d Cir 1978); as well as SLICKCRAFT and SLEEKCRAFT for boats in *AMF Inc v Sleekcraft Boats*, 599 F (2d) 341 (9th Cir 1979). And see Mary LaFrance, "Initial Impressions: Trademark Protection for Abbreviations of Generic or Descriptive Terms" (2012) 45:201 Akron L Rev at 202, 239 (comparing the different approaches of the federal courts and discussing the inconsistency across the circuits in the United States). Contrast that with *Bayuk Cigars, Inc v Schwartz, DC*, 1 F Supp 283 (DNJ 1932) (finding no confusion between two cigar companies using PHILLIES because the public nickname did not enure to anyone) with *Coca-Cola Co v Busch*, 44 F Supp 405 (ED Pa 1942) (finding confusion between KOKE and COKE because the latter was a public nickname that enured to the plaintiff) [*Coca-Cola v Busch*]. Oddly, both the United States and Canada are consistent in holding confectionary-related names to be confusing. And see *Jellibean Inc v Skating Clubs of Georgia Inc*, 716 F (2d) 833 (11th Cir 1983) at paras 20-21 (finding that JELLIBEANS and LOLLIPOPS, though not synonymous, were confusing for skating rinks) and *Rowntree Co Ltd v Paulin Chambers Co Ltd et al*, [1968] SCR 134 at 137, 139 (finding that SMARTIES and SMOOTHIES were synonymous and confusing for candy).

For example, a review of the SAINT HONORE and ANNA marks indicates that at issue was the confusion between the three Chinese characters 聖 安娜 in one party's marks and the same two Chinese characters 安娜 in the other party's marks. One party asserted that the ideas suggested by the trademarks are different because it translated the Chinese characters 聖 安娜 as SAINT HONORE while the other party translated the same Chinese characters 安娜 as ANNA.<sup>175</sup> The court said nothing in response directly, but indirectly seemed to agree when it stated that the Chinese characters 安娜 translated as ANNA gave one party's marks a greater degree of inherent distinctiveness than the other party's marks.<sup>176</sup> This is a mistake because both marks included the same Chinese characters and were translated arbitrarily by traders, which has no bearing on how consumers would translate them. Consumers who translate one party's marks as SAINT HONORE will do the same for the other party's marks, and vice versa for consumers who translate them as ANNA. This means that consumers who translate the Chinese characters 聖 安娜 as SAINT HONORE will also translate the Chinese characters 安娜 as HONORE, and consumers who translate the Chinese characters 安娜 as ANNA will also translate the Chinese characters 聖 安娜 as SAINT ANNA. Consumers are not going to switch translation from one mark to another mark, and the court should have explained and decided that the ideas suggested by the trademarks are the same. This becomes even more obvious when we remember that Saint Honore Cake Shop used to be called Saint Anna Bakery, and that a previous translation of the SAINT HONORE mark (see the left side of the chart below) used to be called the SAINT ANNA mark (see the left side of the chart below). The chart below also provides another example of how the same Chinese characters can be translated arbitrarily by traders, which has

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<sup>175</sup> *Saint Honore*, supra note 91 at para 35.

<sup>176</sup> *Saint Honore*, supra note 91 at para 49.



no bearing on how consumers would translate them: the last two Chinese characters literally mean “cake house” (the translation used by Cheung’s Bakery), which were interpreted as “cake shop” or “bakery” (the two translations used by Saint Honore Cake Shop).

<p align="center"><b>Trademark for Current name of Saint Honore Cake Shop</b></p>	<p align="center"><b>Trademark for Previous name of Saint Anna Bakery</b></p>
 <p align="right">177</p>	 <p align="right">178</p>

An example of this mistake using English is the acronym LOL. A new acquaintance may think LOL translates as “laughing out loud” and send you the message: “Wasn’t yesterday’s party hilarious? LOL!” Meanwhile, a best friend may think LOL translates as “lots of love” and send you the message: “Is it true you’re in the hospital? LOL!” What either sender of the messages thinks LOL means has no bearing on the ideas suggested by the texts, as that actually depends on what the receiver thinks LOL means. If you translate LOL as “laughing out loud”, you will do the same for both messages and think the best friend is inappropriately mean. If you translate LOL as “lots of love”, you will also do the same for both messages and think the new acquaintance is inappropriately forward. Since the court correctly concluded that the trademarks were confusing based on other elements, this linguistic mistake did not affect the outcome in the end. Nonetheless, such a linguistic mistake must be avoided in future cases in order to remain consistent with the consumer imagined by the Supreme Court of Canada and the Federal Court of Canada. Whether it be a matter of first impression and imperfect recollection, or the average consumer of the product, both courts are clear that the test for confusion focuses on the mind of

<sup>177</sup> [Trademarks: SAINT HONORE CAKE SHOP LIMITED & CHINESE CHARACTERS DESIGN, Opposed, 1329117](#)

<sup>178</sup> [Trademarks: ANNA'S CAKE HOUSE & Chinese Characters Design, Registered, 1235030, TMA667403](#)

the consumer (the receiver of the message) and not the mind of the trader (the sender of the message). It is a mystery why the linguistic mistakes were not drawn to the attention of the court. The court could not be expected to know that the same Chinese characters would have multiple translations, especially if the parties do not challenge the arbitrariness of the translations.

As a general rule, without evidence connecting the two, it is dangerous to equate a foreign-language mark with a translation because translations can be multiple and arbitrary. For example, SAINT HONORE could also have meant SAINT ANNA. To allow a foreign-language mark to expand into claims for translations is to go beyond the metes and bounds of the registration, in light of the fact that a foreign-language mark can mean different things literally, colloquially, or culturally.

Therefore, a trader who chooses a specific English-language mark (COCA-COLA) must accept the consequences of the scope of its claim, which will not necessarily include other meanings (COCA-POP, COCA-SODA, *etc.*). Any such inclusion should first require evidence that there is likelihood of confusion. The same rationale should apply to traders who choose a specific Chinese-language mark, instead of its possible translations, as consumers may not find that the Chinese-language mark is meaningfully interchangeable with its translations.

### **5.1.2B Comparing for Confusion with Transliterations**

The arguments against equating foreign-language marks to translations also apply to transliterations. Since a claim in an English-language mark does not automatically expand into claims for its homophones,<sup>179</sup> subject to evidence of confusion,<sup>180</sup> it follows that a claim for a foreign-language mark should not include claims for its transliterations without similar evidence.

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<sup>179</sup> Homophones share the same pronunciation but different spelling: BEAU – BOW and BOUGH – BOW; DESSERT – DESERT; LED – LEAD; WHINED – WINED – WIND. Conversely, homographs share the same

For example, Cheung Kong (Holdings) Limited has been using the English-language mark CHEUNG KONG and the Chinese-language mark 長江 since the 1950's in Hong Kong and the 1980's in Toronto for real estate services. Due to a series of events leading up to 1984, it retained the English-language mark and a Toronto competitor ended up with the Chinese-language mark. It registered the English-language mark, which it used as the basis to oppose the Toronto competitor's application for the Chinese-language mark. The Federal Court of Canada took judicial notice of the existence of a significant Chinese community as the potential target market and, as a result, found that the Chinese-language mark was confusing with the English-language mark. This was strange in light of the fact that the registration for CHEUNG KONG gave the impression that it was an invented English term, as it failed to mention that it was a transliteration for certain Chinese characters.<sup>181</sup> This meant that it had no evidence to connect to and, thereby, oppose the competing application for 長江.<sup>182</sup> Fortunately for the registration, the application implicated itself by mentioning that its transliteration was CHEUNG KONG.

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spelling but different pronunciation: If you BOW when picking up the BOWS, we will DESERT you in the DESERT and you will have to rely on a piece of LEAD to LEAD you back, unless you wish to WIND up forgotten and blowing in the WIND. Homonyms are both homophones and homographs simultaneously: Please ADDRESS everyone at this street ADDRESS as to why their dogs BARK at the tree BARK, and ask if they CAN remove the garbage CAN by noon.

<sup>180</sup> No confusion was found in between BREWSKY'S bars and BREWSKI BROTHERS clothing in *Brewski Beer Co v Brewski Brothers, Inc*, 47 USPQ2d 1281 (TTAB 1998); or PHIFTY-50 music albums and 50-50 movie titles in *Eastland Music Group, LLC v Lionsgate Entm't, Inc*, Appeal No 12-2928 (7th Cir 2013), presumably because of the differences in goods and services. Confusion, however, was found between ESSO and SO for petroleum products in *Esso, Inc v Standard Oil Co*, 98 F (2d) 1 (8th Cir 1938); COMSAT for a satellite communications system and COMCET for computer communications engineering technology in *Communications Satellite Corp v Comcet, Inc*, 429 F (2d) 1245 (4th Cir 1970); as well as AUXIGRO and OXYGROW for fertilizer products in *Emerald Bioagriculture Corp v Biosafe Systems, LLC*, Cancellation No 92042503 (TTAB Feb 9, 2006). Contrast that with *Labatt Breweries of Canada Ltd v AG of Canada*, [1980] 1 SCR 914 at 928 (stating in the dictum of a constitutional case that SPECIAL LITE would likely be mistaken for LIGHT BEER, as defined then under the repealed *Food & Drug Act*, RSC 1970, c F-27, s 6).

<sup>181</sup> [Trademarks: CHEUNG KONG, Expunged, 0618425, TMA385395](#); and [Trademarks: CHEUNG KONG, Registered, 1052787, TMA605043](#).

<sup>182</sup> [Trademarks: CHINESE CHARACTERS; DESIGN, Expunged, 0530067, TMA310471](#); [Trademarks: CHINESE CHARACTERS & DESIGN, Expunged, 0683560, TMA433298](#); and [Trademarks: CHINESE CHARACTERS & DESIGN, Refused - Section 38\(8\), 0692232](#).

As a general rule, unless there is evidence to support connecting the two, it is inadvisable to equate a foreign-language mark with a transliteration as transliterations can be multiple and arbitrary. For example, the transliteration CHEUNG KONG can also be spelled CHEON GONE, CHIONG KUNG, *etc.* To allow a foreign-language mark to expand into claims for transliterations could quickly turn into a “grabfest”, especially when we remember that a Chinese-language mark can be read in many dialects with different pronunciations. The two transliterations above were based on how the Cantonese dialect pronounces the Chinese characters, whereas Mandarin pronounces the same Chinese characters as CHANG2 JIANG1.<sup>183</sup> Given that transliterations can be arbitrary in the same way that spellings can be varied, it is important that Western databases adopt the official phonetic system in order to ensure that transliterations are consistent in order to be compared.

Therefore, a trader who chooses to spell an English-language mark a specific way (COCA-COLA) cannot rely upon the law to act automatically as an insurer against other spellings that were not chosen (KOKAH KOLAH, GO GA GOAL AH, *etc.*). Any such reliance should first require evidence that there is likelihood of confusion. The same rationale should apply to traders who decide to use a specific Chinese-language mark, instead of its possible transliterations, as consumers may not intuitively correlate the Chinese-language mark with its transliterations.

A concluding reason to hold traders to their chosen translation (or transliteration) is simply the fact that the trademark application stage provides a better opportunity to obtain direct and honest translations (or transliterations) than during the opposition, expungement, or

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<sup>183</sup> [Trademarks: CHINESE CHARACTERS DESIGN, Registered, 0748168, TMA554984](#) contained the Chinese characters 長江, which it transliterated as CHANG JIANG and translated as CHEUNG KONG. The latter illustrates that traders are unaware of what is required for a translation, as CHEUNG KONG is not a translation. It also illustrates that lawyers and examiners are unaware of what to ask in order to obtain a proper translation, as they probably assume that “Cheung Kong” is akin to the English words “Chop Suey” or “Chow Mein”.

infringement proceedings. Consider how the registration for CHEUNG KONG was used successfully to oppose the competing application for 長江. Despite their difference in appearance, the Federal Court of Canada found that they were similar in sound and in the ideas suggested by them since they both meant “long river”.<sup>184</sup> This finding could not have been based on the registration for CHEUNG KONG, which gave the impression that it was an invented English term by failing to mention that it was a transliteration for Chinese characters that mean “long river”. Instead, this finding was based on the competing application for 長江, which implicated itself by mentioning that its transliteration was CHEUNG KONG and its meaning was “long river”. If the competing application had not been so direct and honest, it could have argued conveniently at trial that its transliteration was CHANG2 JIANG1 (instead of CHEUNG KONG) and its meaning was the “Yangtze River” (instead of “long river”).<sup>185</sup>

What is interesting to note is that neither the registration nor the competing application mentions that both are standard references to the “Yanztze River”: Asia’s longest river is to China what South America’s Amazon is to Brazil, or Africa’s Nile is to Egypt. This means that neither have helpful evidence to oppose future competing applications for YANGTZE, the cultural subject of Chinese diaspora’s nostalgia and a popular song that became an anthem of Chinese pride.<sup>186</sup> This result is desirable because it is likely that both traders failed to provide the colloquial translation in order to avoid a descriptiveness objection from the Canadian examiner. Although both terms had been in use since the 1950’s in Hong Kong and the 1980’s in Toronto

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<sup>184</sup> *Cheung Kong*, *supra* note 9.

<sup>185</sup> [Trademarks: CHINESE CHARACTERS DESIGN, Registered, 0748168, TMA554984](#) contained the Chinese characters 長江, which it transliterated as CHANG JIANG and translated as CHEUNG KONG. The latter illustrates that traders are unaware of what is required for a translation, which should have been “long river” and “Yangtze River”. It also illustrates that lawyers and examiners are unaware of what to ask in order to obtain a proper translation, due to the blinding and paralyzing fear of what is “foreign”.

<sup>186</sup> Jonathan Stock, “Four recurring themes in histories of Chinese music” in Philip V Bohlman, ed, *The Cambridge History of World Music* (New York: Cambridge University Press, 2013) 397.

for real estate services, they probably had not acquired secondary meaning in Canada at the time of their trademark applications. If traders benefit from having examiners think that CHEUNG KONG is an invented English term, or that 長江 is an arbitrary combination that means “long river”, then such traders must accept the corollary difficulty of showing evidence of confusion with YANGTZE.

Professor Craig writes in the copyright context about how the “powerful and mesmerizing badge of ‘property’ ... takes over our understanding and distorts our policy decisions.”<sup>187</sup> We see in this chapter how the blinding and paralyzing fear of what is “foreign” can have the same effects. First, it takes over our understanding of basic laws in that administrative and judicial cases ignored prior judicial explanation of *who* the consumer is – the target consumer of the product, instead of the general public – in their application of the test for confusion to foreign-language marks. Second, it distorts our policy decisions in that the case law still requires evidence that the foreign language used in a trademark is understood by the target consumer, even though the statutory permission to prove *the confusion arising from* linguistic knowledge cannot necessarily be interpreted as a statutory requirement to prove *the existence of* linguistic knowledge.

It is clear from this chapter that the Canadian test for confusion can be improved through an understanding of what is “foreign”. This should be done by including linguistic knowledge as part of “all” the circumstances that are relevant to the test for confusion, and by remembering that the test for confusion focuses on the mind of the consumer instead of the trader. In the words

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<sup>187</sup> Carys Craig, “Locke, Labour and Limiting the Author’s Right: A Warning against a Lockean Approach to Copyright Law” (2002) 28 Queen’s LJ 1 at 57.

of the two-time Nobel Prize winner Marie Curie: “Nothing in life is to be feared, it is only to be understood. Now is the time to understand more, so that we may fear less.”<sup>188</sup>

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<sup>188</sup> Marie Curie in Melvin Bernarde, *Our Precarious Habitat*, 2nd ed (New York: WW Norton & Company, 1973) at v.

# 6 JUDICIAL ALTERNATIVES

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This chapter explains several alternatives in response to the problem of proving linguistic knowledge, as the evidence required to prove such knowledge changes constantly depending on international trade, multicultural consumers, brand extension and cross-branding in order to access untapped markets. Each alternative is explored and its challenges are explained in order to reinforce why the problem is best addressed with the solution of assuming linguistic knowledge.

## **6.1 American Doctrine of Foreign Equivalents**

The first alternative is the American doctrine of foreign equivalents. However, it was rejected as early as 1992 by the same Federal Court of Canada which later included linguistic knowledge as part of the Canadian test for confusion. One reason was because the American doctrine is only a guideline and not law in the United States.<sup>189</sup> The guideline was developed by the common law, is not always applied consistently, and has even resulted in contradictory cases. All this has led some scholars to suggest that at best it is unreliable and should be abolished at worst.<sup>190</sup> Another reason was because the purpose of the American doctrine diverges from that of

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<sup>189</sup> *Krazy Glue*, *supra* note 104 at 172 (“The Appellant further submitted that it would be useful in the context of the facts of this case to consider the doctrine of foreign equivalents as applied in the United States of America, since that country is a party to the Paris Convention. The doctrine of foreign equivalents in the United States of America essentially provides that foreign words or terms may not be registered as a trade mark if the English language equivalent has been previously registered for products which might reasonably be assumed to come from the same source. This doctrine is not based on any statutory provision, but rather is merely a principle to be applied in determining the registrability of a trade mark. I see no basis for importing this American doctrine into our law in view of the statutory scheme in the Act pertaining to the determination of confusion.”).

<sup>190</sup> Shuy, *supra* note 86 at 36 (“McCarthy is surely correct when he states that application of the doctrine of foreign equivalents can result in a finding quite out of phase with reality.”); Elizabeth Rest, “Lost in Translation: A Critical Examination of Conflicting Decisions Applying the Doctrine of Foreign Equivalents” (2006) 96 INTA Trademark Reporter 1211 at 1223 (“there is little agreement among courts regarding what the doctrine actually dictates, and there is disagreements as to when and how the doctrine should be applied”); Serge Krimnus, “The Doctrine of Foreign Equivalents at Death’s Door” (2010) 12:1 NCJL & Tech.



the Canadian test. The Canadian test is in accordance with the dual purposes of trademark law – protecting consumers from confusion and owners from unfair competition – and remains the same for both official-language marks and foreign-language marks.<sup>191</sup> When *Home Juice* prohibited clearly descriptive marks from foreign countries, before they have begun to be used in Canada, it was to protect Canadians and not to obtain a *quid pro quo* from foreign countries. By contrast, the American doctrine extends beyond the purpose of trademark law for the purpose of international comity:<sup>192</sup>

“The international trade foundation for the rule is significant from the standpoint of the protection of the United States trading interests in foreign countries. Since prior to the Lanham Act, the United States, through its Departments of State and Commerce, has protested the registration in foreign countries of terms considered to be generic names in the English language of products sold in the United States and sold or intended to be sold in export trade. The rationale of these protests is that registration of generic terms as trademarks would interfere with the free flow of international trade in products known by that generic term. ... Obviously, to permit registration here of terms in a foreign language which are generic for

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<sup>191</sup> *Cheung Kong*, *supra* note 9 at para 72 (“Second, the purposes of paragraph 12(1)(d) include the protection of consumers from being misled about the source of wares and services, and to enable providers and suppliers to identify their wares and services and to protect them from unfair competition. Hence, it would seem to me that whether a “significant” number of consumers are likely to be confused may be determined, not only by the proportion of those misled, but also in certain circumstances by the absolute number of such persons. As a legal test of the likelihood of confusion, the impression on the “average Canadian”, or even the “average consumer”, may assume a greater homogeneity among actual consumers of a service or ware than is appropriate in such a richly diverse society as contemporary Canada.”).

<sup>192</sup> The concept of international comity suggests reciprocity. This raises questions as to what should happen if a word is generic in one country but not in another country using the same language: For Canada to protest the registration of generic French terms in the United States, will Canada have to cancel current registrations for ASPIRIN, CELLOPHANE, or THERMOS because they are generic English terms in the United States? And for a third country (like China) to protest the registration of generic Chinese terms in the United States, will it have to ignore Canadian registrations that conflict with American genericness?

products sold in a foreign country would be inconsistent with the rationale supporting these international protests.”<sup>193</sup>

Perhaps the Canadian test should also expand to include the purpose of international comity for three reasons. First, Canada’s *Trademarks Act* deems trademark use on exported products to be use in Canada.<sup>194</sup> Second, other jurisdictions have held that passing off on exported products is actionable locally even if the confusion occurs abroad.<sup>195</sup> Third, Canada’s membership in the World Trade Organization as of January 1, 1995 and its anticipated accession to the Nice Agreement, Singapore Treaty and Madrid Protocol – which allow a trademark registered in one member country to extend that registration to any or all of the other member countries – would discourage permitting the registration of foreign-language marks which are generic for products sold in the member countries of these international trade agreements. If extra-territoriality is not an issue for specific trademarks in the examples above, then it should not be an issue for trademarks that are generic terms of products.

Perhaps the policy of international comity should apply to all countries and not just to some countries. This would mean that the Holy See (Vatican City) can protest generic terms in

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<sup>193</sup> *Re Le Sorbet*, *supra* note 154. Contrast that with *Re Spirits International, NV*, 86 USPQ 2d 1078 (TTAB 2008) at 13 (“The purpose of the Trademark Act is two-fold: to protect business and to protect the consumer. . . . The doctrine of foreign equivalents is fundamental to this protection. It extends the protection of the Act to those consumers in this country who speak other languages in addition to English.”) [*Re Spirits* TTAB].

<sup>194</sup> *Trademarks Act*, *supra* note 19, s 4(3) (**Use by export** – “A trademark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.”).

<sup>195</sup> *William Grant & Sons Ltd & Ors v Glen Catrine Bonded Warehouse Ltd & Ors* [2001] ScotCS 116 at para 66 (“[We reject the ground of appeal] that the Lord Ordinary had erred in holding that interdict should apply in respect of export of the defendant’s products bearing the name Grant’s to all countries, since the evidence did not warrant a view that exports to all overseas markets were unlawful. In dealing with the matter, I proceed on the basis that the Lord Ordinary’s findings are more than ample to demonstrate that the defenders are liable to pass off their products as the pursuers’ in many overseas markets and that consumers and others in those markets are likely to experience confusion as a result.”). Lord Clarke supported this position at para 17 of his own opinion (“As is said in *Burn Murdoch Law of Interdict* at para. 348: “Defenders whose residences or business lies within Scottish jurisdiction can by interdict, operating *in personam*, be restrained from making infringing use of the pursuers’ marks anywhere throughout the world.”).

the Latin language. The world's smallest sovereignty currently uses an official language (even its ATM uses Latin) that the United States generally has deemed to be a dead language and irrelevant to the issue of distinctiveness.<sup>196</sup> However, it is uncertain what this would mean for Aboriginal and minority languages that are not the official language of any country (including the Inuit language, which is recognized as an official language only in a subdivision of a country).<sup>197</sup> Either way, it is incorrect for the quote above to apply the policy of international comity only to countries with which the United States has trading interests significant enough to protest their registration of generic names in the English language. And it is also incorrect for the cases below to apply the American doctrine only to languages for which the United States has a linguistic population significant enough to translate.

Despite their divergence in purpose, the American doctrine takes the same approach as the Canadian test by translating foreign-language marks into English in order to decide issues such as trademark distinctiveness<sup>198</sup> and likelihood of confusion<sup>199</sup>:

“Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine genericness, descriptiveness, as

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<sup>196</sup> *Trademark Manual of Examining Procedures*, § 12.09.03(g) s (**Considerations Relevant to Determination of Descriptiveness or Genericness – Foreign Equivalents** – “Latin is generally considered a dead language. However, if evidence exists that the relevant purchasing public still uses a Latin term (e.g., if the term appears in current dictionaries or news articles, then that Latin term is not considered dead. The same analysis should be applied to other uncommon languages.”).

<sup>197</sup> *Inuit Act*, *supra* note 138, c 17. A territory's statute must receive judicial notice.

<sup>198</sup> *Lanham Act 1946*, 15 USC, c 22, § 1052(e) (“No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it – (e) Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them.”).

<sup>199</sup> *Lanham Act 1946*, 15 USC, c 22, § 1052(d) (“No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it – (d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: ...”).

well as similarity of connotation in order to ascertain confusing similarity with English word marks”<sup>200</sup>

The doctrine applies if “it is likely that the ordinary American purchaser would ‘stop and translate [the word] into its English equivalent’.”<sup>201</sup> This sentence alone resulted in uncertainty as courts tried to reconcile two major contradictions.

First, the ordinary American purchaser was clarified to mean only those “familiar with the foreign language”<sup>202</sup> until a later case contradicted it by claiming that “the term includes all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English.”<sup>203</sup> The cases can supposedly be reconciled to mean that the ordinary American purchaser should be restricted to *the fluent consumer* in general cases, but expanded to both *the fluent and illiterate consumers* in the specific case of geographic deceptiveness and descriptiveness.

Second, “translate” was clarified to exclude transliterations. When a trademark application for VITAMILK was opposed due to prior use, the applicant tried to predate the opponent’s prior use by tacking on its earlier use of the original Chinese-language mark 維他奶 (WEI2 TA1 NAI3).<sup>204</sup> The tacking was not allowed because the Chinese-language mark was rejected as a legal equivalent to VITAMILK. The two marks were not considered to continue the

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<sup>200</sup> *Palm Bay Imports, Inc v Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F (3d) 1369, 73 USPQ 2d 1689 (Fed Cir 2005) at 1377 [*Palm Bay*].

<sup>201</sup> *Palm Bay*, *supra* note 200.

<sup>202</sup> *Re Thomas*, 79 USPQ2d 1021, 2014 (TTAB 2006) at 1024 [*Re Thomas*].

<sup>203</sup> *Re Spirits International, NV*, 563 F (3d) 1347 (Fed Cir 2009) at 1352.

<sup>204</sup> *Green Spot (Thailand) Ltd v Vitasoy Int’l Holdings Ltd*, Opposition No 91165010 (February 21, 2008) at 9 (“As a matter of law, the doctrine of foreign equivalents does not apply to a foreign mark partially comprised of characters that have no English translation ... The fact that the first two characters of the mark have no meaning in English makes the mark overall incapable of translation.”). If this decision seems to have the reverse logic of my analysis above, it is because this decision reversed the facts by assuming that the foreign-language mark is the successor to and transliteration of the English equivalent.

same commercial impression because the American doctrine applies to translations of meanings, not transliterations of sounds. However, this clarification has been contradicted since then. When the trademark use of HANA BANK resulted in a lawsuit for trademark infringement, the user tried to predate the registrant's prior use by tacking on its earlier use of the original Korean-language mark 하나은행 (HA NA EUN HAENG).<sup>205</sup> The tacking was allowed even though the first two characters were transliterated as HANA, which had no meaning in English. The Korean-language mark was accepted as a legal equivalent to HANA BANK even though the first two characters could have been transliterated as HA NA, ANA or HANNAH. The trademarks were considered to continue the same commercial impression even though the first two characters were not literally translated as "one" to mean "united" or "whole". As a result, the trademark registration for HANA FINANCIAL was not infringed by the later use of HANA BANK due to an earlier use of the original Korean-language mark. It is interesting to note that if the disputing parties had translated instead of transliterated their original Korean-language marks, the comparison would not have been between HANA BANK and HANA FINANCIAL, but between ONE BANK and ONE FINANCIAL. Such a comparison would have led to a finding that the trademarks lacked distinctiveness. This would have been consistent with a court finding that there was no confusion between SUN BANK and SUN FEDERAL for banking services. Although similar in sight, sound and meaning, the court found that the word SUN lacked distinctiveness.<sup>206</sup>

The uncertainty described above continues in the actual application of the doctrine, as the subsections below try to illustrate where the ordinary American purchaser is likely to "stop and translate" the foreign-language mark. In this regard, the American doctrine is even less

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<sup>205</sup> *Hana Financial, Inc v Hana Bank et al*, 735 F (3d) 1158 (9th Cir 2013), aff'd 135 US 907 (2015).

<sup>206</sup> *Sun Banks v Sun Federal Savings & Loan*, 651 F (2d) 311 (5th Cir 1981).

satisfactory than the Canadian test and can also benefit from assuming linguistic knowledge for all foreign-language marks.

### **6.1.1 Comparing English to a Foreign Language**

When comparing an English-language mark to a foreign-language mark, the foreign-language mark is translated into English since one of the trademarks needs to be translated and English is the only official language of the United States. Examples include applying the American doctrine and finding confusion between the French-language mark CHAT NOIR and BLACK CAT;<sup>207</sup> the Spanish language mark EL SOL and SUN;<sup>208</sup> the Italian language mark LUPO and WOLF;<sup>209</sup> the Spanish language mark BUENOS DIAS and GOOD MORNING;<sup>210</sup> the Spanish language mark KRIPTONITA and KRYPTONITE;<sup>211</sup> the French-language mark MARCHÉ NOIR and BLACK MARKET MINERALS;<sup>212</sup> as well as the Spanish language mark LA PEREGRINA and PILGRIM.<sup>213</sup> In the same way, the American doctrine can be applied but find that there is no confusion between marks that lack distinctiveness (such as the French-language mark HAUTE MODE and HI-FASHION SAMPLER,<sup>214</sup> as well as the French-language mark LABONTÉ and GOOD-NESS<sup>215</sup>) or have other distinguishing features (such as the French-language mark DECI DELÀ and HERE & THERE & Design<sup>216</sup>).

The Canadian test would consider whether there is evidence that the target consumer is familiar with the foreign language used in the trademarks. This means that the French-language

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<sup>207</sup> *Ex parte Odol-Werke Wien Gessellschaft MBH*, 111 USPQ 286 (Comm'r Pats 1956).

<sup>208</sup> *Re Hub Distrib, Inc*, 218 USPQ 284 (TTAB 1983).

<sup>209</sup> *Re Ithaca Idus, Inc*, 230 USPQ 702 (TTAB 1986).

<sup>210</sup> *Re Am Safety Razor Co*, 2 USPQ 2d 1459 (TTAB 1987).

<sup>211</sup> *DC Comics v Pan Grain Mfg Co*, 77 USPQ 2d 1120 (TTAB 2005).

<sup>212</sup> *Re Thomas*, *supra* note 202.

<sup>213</sup> *Re La Peregrina*, 86 USPQ 2d 1645 (TTAB 2008).

<sup>214</sup> *Re L'Oréal*, 222 USPQ 925 (TTAB 1984).

<sup>215</sup> *Re Ness & Co*, 18 USPQ 2d 1815 (TTAB 1991).

<sup>216</sup> *Horn's Inc v Sanofi Beaute Inc*, 43 USPQ 2d 1008 (SDNY 1997).

marks would automatically be compared with their English translations, and vice versa, because both French and English are official languages of Canada. This also means that the Spanish and Italian language marks will not be compared with their English translations if their products were marketed on a national scale.

### **6.1.2 Comparing the Same Foreign Language**

When comparing two marks in the same foreign language, the comparison is still based on the English translations and not on the foreign language. This can lead to interesting but presumably reconcilable results. For example, the American doctrine was applied to the French-language marks BON JOLIE and TRÈS JOLIE since the ordinary American purchaser would have enough basic French to translate them as “quite pretty” and “very pretty”, but found that there was no confusion because the trademarks lacked distinctiveness.<sup>217</sup> Contrast that with a similar but presumably reconcilable example where the American doctrine was not applied to the French-language marks VEUVE ROYALE and VEUVE CLICQUOT since the ordinary American purchaser would not have enough advanced French to translate them as “royal widow” and “widow Clicquot”, but still found that there was confusion based on other grounds.<sup>218</sup> This point was driven home when the American doctrine was applied and confusion was found with the Spanish language marks CHUPA CHUPS and CHUPA GURTS. Even though the literal translation for “chupa” was “to lick” or “to suck”, the ordinary American purchaser was deemed to have enough Spanish to understand that “chupa” was slang for “lollipop”.<sup>219</sup> Presumably it

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<sup>217</sup> *Re Lar Mor Int'l, Inc*, 221 USPQ 180 (TTAB 1983) at 181-183 (“[i]t seems to us that the fact both marks may be comprised of foreign words should not mean that we can disregard their meanings. Indeed, we believe that many members of the American public, even those who have only a rudimentary acquaintance with the French language are likely to understand the significance of the respective terms;”)

<sup>218</sup> *Palm Bay*, *supra* note 200.

<sup>219</sup> *Enrique Bernat*, *supra* note 166.

was the presence of a large Spanish-speaking population in the United States that was responsible for the result that the ordinary American purchaser is presumed not to understand an actual French word but can understand Spanish slang.

The Canadian test is clearest in this scenario because French and Spanish have the opposite status in Canada from that in the United States. First, the French-language marks would be compared as is without translating into English because French is an official language in Canada. Second, the Spanish language mark would still be compared as is without translating into English if the product is known to be marketed nationally and the percentage of Spanish speakers was still deemed to be insignificant.<sup>220</sup> Third, the Spanish language mark would be treated differently in Canada because Canadian courts have not espoused the international comity purpose of the American doctrine:

“Moreover, the policy of international comity has substantial weight in this situation. If we permit Chupa Chups to monopolize the term ‘chupa’, we will impede other Mexican candy makers’ ability to compete effectively in the U.S. lollipop market. Just as we do not expect Mexico to interfere with Tootsie’s ability to market its product in Mexico by granting trademark protection to the word ‘pop’ to another American confectioner, so we cannot justify debilitating Dulces Vero’s attempts to market ‘Chupa Gurts’ in the United States by sanctioning Chupa Chups’ bid for trademark protection in the word ‘Chupa.’”<sup>221</sup>

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<sup>220</sup> The latest census of 2011 shows 1.3% of the Canada population spoke Spanish. Canada’s total population was 33,476,688 (<http://www12.statcan.gc.ca/census-recensement/2011/as-sa/98-310-x/98-310-x2011001-eng.pdf>) and its Spanish-speaking population was 439,000 ([http://www12.statcan.gc.ca/census-recensement/2011/as-sa/98-314-x/98-314-x2011003\\_2-eng.pdf](http://www12.statcan.gc.ca/census-recensement/2011/as-sa/98-314-x/98-314-x2011003_2-eng.pdf)).

<sup>221</sup> *Enrique Bernat, supra* note 166.



The policy of international comity appears to have been adopted as a purpose of the American doctrine after 1985, as it was ignored multiple times in prior cases. The generic term GREENGROCER for a British retailer of fruits and vegetables was refused protection in the United States even though “[t]he parties agree that the term is generic in Britain. Since we deal here with American trademark law, and thus American consumers, neither British usage nor the dictionary definition indicating such usage are determinative.”<sup>222</sup> The United States rejected generic terms from Britain, even though Britain had already gone as far as to accept colloquial slang from the United States with the reasoning that failing to do so would be to ignore the influence of the American film industry in England.<sup>223</sup> Likewise, the generic term SEIKO for a Japanese sporting store was refused protection in the United States because “[w]hile the plaintiff has sought to show that Seiko is a generic term in Japanese, it is not so recognized in this country. Accordingly, the trademark must still be regarded as arbitrary and fanciful in the United States.”<sup>224</sup> It became apparent that this case would have been decided differently in later years when the generic term OTOKOYAMA for a Japanese sake was granted protection in the United States because “[if] one United States merchant were given the exclusive right to use that word to designate its brand of sake, competing merchants would be prevented from calling their product by the word which designates that product in Japanese.”<sup>225</sup>

### **6.1.3 Comparing Different Foreign Languages**

When comparing two marks in different foreign languages, the comparison may be based on the English translations or may be based on the foreign languages, as decided on a case-by-

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<sup>222</sup> *Carcione v The Greengrocer, Inc*, 205 USPQ (BNA) 1075 (ED Cal 1979).

<sup>223</sup> *Re La Marquise*, *supra* note 150.

<sup>224</sup> *Seiko Sporting Goods USA, Inc v Kabushiki Kaisha Hattori Tokeiten*, 545 F Supp 221 (SDNY 1982) at 226.

<sup>225</sup> *Otokoyama Co Ltd v Wine of Japan Import, Inc*, 175 F (3d) 266 (2nd Cir 1999) at 272.

case basis. This can lead to contradictory results. The general rule is that the doctrine does not apply because the ordinary American purchaser would probably be unfamiliar with multiple foreign languages:<sup>226</sup> the Italian language mark BEL ARIA and the French-language mark BEL AIR were compared as is, which meant that there was no confusion because the former mark had an Italian connotation and the latter mark had a geographical connotation.<sup>227</sup> Contrast that with a contradictory example where the doctrine was applied because the ordinary American purchaser familiar with one foreign language was deemed to be capable of deciphering the other foreign language: the Italian language mark DUE TORRI and the Spanish language marks TORRES and TRES TORRES were compared in English, which resulted in the finding of confusion among the translations of “two towers”, “towers” and “three towers”.<sup>228</sup> Perhaps the discrepancy arises from the fact that the latter case involved a Spanish language mark, since the ordinary American purchaser was deemed to understand even Spanish slang.

The Canadian test has not produced any cases involving different foreign languages. While it is unclear how Canada would compare the Italian language mark to the Spanish language mark if each targeted its respective linguistic population, it is clear that Canada would compare them as is without translation if each were marketed on a national scale and less than 1% of the Canadian population spoke each language. And if a translation was warranted, Canada would translate the Italian language mark BEL ARIA into French for comparison with the French-language mark BEL AIR, whereas the United States would have translated both language marks into English for comparison. The uncertainty of the American doctrine is more pronounced with the Canadian test in this situation because Canadians – “presumably” fluent in both English and French – are more likely to be confused with other Romance languages. Even if

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<sup>226</sup> *Brown Shoe Co v Robbins*, 90 USPQ 2d 1752 (TTAB 2009) at 1756 [*Brown Shoe*].

<sup>227</sup> *Safeway Stores Inc v Bel Canto Fancy Foods Ltd*, 5 USPQ 2d 1980 (TTAB 1987).

<sup>228</sup> *Miguel Torres SA v Casa Vinicola Gerardo Cesari SRL*, 49 USPQ 2d 1818 (TTAB 1998).

such Canadians are not fluent in Italian or Spanish, their bilingual knowledge increases the possibility of their understanding such languages. The need to establish evidence as to the existence of multi-linguists, their numbers, and how well they understand other Romance languages can be avoided by assuming linguistic knowledge for all foreign-language marks.

The uncertainty described above is also found in cases where the doctrine does not apply, such as in the subsections below where the ordinary American purchaser is unlikely to “stop and translate” the foreign-language mark.

#### **6.1.4 Multiple Meanings Discourage Translation**

The American doctrine does not apply if a foreign-language mark has no literal translation in English. An example is the French-language mark REPECHAGE and SECOND CHANCE, since the French-language mark could mean “to recover” or “to fish out”.<sup>229</sup> Another example is the Spanish language mark PALOMA and DOVE, since the Spanish language mark could mean “dove” or “pigeon”.<sup>230</sup> Some might find this rationale weak since a dove is a domesticated breed or whiter version of a pigeon, but the same rationale was applied when comparing marks in the same foreign language, as in the case of the Spanish language marks for PALOMA and PALOMITA.<sup>231</sup> Trying to decide whether an English translation is literal enough can lead to interesting but presumably reconcilable results. Contrast the two PALOMA cases with a similar example involving the Spanish language mark EL GALLO and ROOSTER:

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<sup>229</sup> *Re Sarkli*, 721 F (2d), 220 USPQ 111 (Fed Cir 1983) at 353.

<sup>230</sup> *Re Buckner Enters Corp*, 6 USPQ 2d 1316 (TTAB 1987).

<sup>231</sup> *Brown Shoe*, *supra* note 226.

although the Spanish language mark had multiple meanings, the American doctrine was applied because evidence showed that its use focused on the English translation of “rooster”.<sup>232</sup>

### **6.1.5 Marketplace Meaning Discourages Translation**

The American doctrine does not apply if a foreign-language mark is used in a marketplace setting that discourages translation into English. An example is the Spanish language mark LA POSADA being used with the words “motor hotel”, which discouraged the actual translation of “the inn”.<sup>233</sup> Another example is the Spanish language mark TIA MARIA being used in a Mexican restaurant with Mexican interior and Mexican food, which discouraged translation and avoided confusion with the English-language mark AUNT MARY’S for canned produce.<sup>234</sup> The same rationale applies if the marketplace meaning is different from the translated meaning in English. An example is not translating the French-language mark CORDON BLEU because the marketplace recognizes it “as is” without translation.<sup>235</sup>

### **6.1.6 Language Combination Discourages Translation**

The American doctrine does not apply if a foreign-language mark contains multiple languages, including English, because the ordinary American purchaser is not going to translate only part of a mark. This enabled the following generic English words to become distinctive trademarks that were registrable: LA YOGURT for yogurt,<sup>236</sup> LE CASE for jewellery and gift boxes,<sup>237</sup> and LE CRYSTAL NATUREL for deodorant crystals.<sup>238</sup> This point was driven home

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<sup>232</sup> *Re Perez*, 21 USPQ 2d 1075 (TTAB 1991).

<sup>233</sup> *Re Pan Tex Hotel Corp.*, 190 USPQ 109 (TTAB 1976).

<sup>234</sup> *Re Tia Maria, Inc.*, 188 USPQ 524 (TTAB 1975).

<sup>235</sup> *Cont’l Nut Co v Le Cordon Bleu SARL*, 494 F (2d) 1395, 181 USPQ 646 (CCPC 1974).

<sup>236</sup> *Re Johanna Farms*, 8 USPQ 2d (BNA) 1408 (TTAB 1988).

<sup>237</sup> *Re Universal Package Corp.*, 222 USPQ 344 (TTAB 1984).

<sup>238</sup> *In French Transit Ltd v Modern Coupon Systems Inc.*, 29 USPQ 2d (SDNY 1992).

when an applicant tried to register LE SORBET for ices by arguing that LE was French and SORBET was English. The court disagreed and deemed the entire phrase to be French, translated it into English, then found it to be generic and unregistrable.<sup>239</sup>

The three scenarios above where the American doctrine was not applied have no similar counterparts in the Canadian test.<sup>240</sup> This is because Canadian courts translate the foreign-language mark upon taking judicial notice of linguistic knowledge, as illustrated most clearly by the different results in the *Saint Anna* and the *Saint Honore* cases. The *Saint Anna* case ignored the Chinese-language marks when it concluded that the number of Canadians fluent in Chinese was insignificant. Conversely, the *Saint Honore* case translated the Chinese-language marks even though they had multiple meanings (they could have been transliterated but were translated arbitrarily); they had marketplace meanings that discouraged translations (they were used in Chinese bakeries where the owners spoke Chinese and sold coconut buns, egg tarts and moon cakes); and they were used in a language combination (albeit they are just Chinese-language marks with the English translations attached).

In this regard, the American doctrine is even less satisfactory than the Canadian test because it is inconsistent with regard to whom it applies (is the ordinary American purchaser fluent in the foreign language?), to what it applies (are transliterations excluded?), to when it applies (can a foreign equivalent be tacked on as a legal equivalent?), to where it applies (is the ordinary American purchaser likely to stop and translate?), and to why it applies (is international comity a purpose only after 1985?). Even if these inconsistencies were reconciled miraculously, it is still uncertain whether traders actually intend for consumers to stop and translate their

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<sup>239</sup> *Re Le Sorbet*, *supra* note 154.

<sup>240</sup> The examples in Chapter 5 for LE JUICE and WOLAINE do not count because English and French are official languages in Canada, whereas the American doctrine treats French as a foreign language.

foreign-language marks in light of the translation problems discussed in Chapter 3. The unflattering translations for COLA-COLA – as well as the name changes for PEPSI, KFC, and MCDONALD’S without corresponding changes in the translations – all suggest that courts cannot assume that a foreign-language mark is intended to be translated or what the translation will be. The American doctrine can also benefit from assuming linguistic knowledge for all foreign-language marks, as doing so focuses the evidence on the trademarks as they are and the association between them, which allows their distinctiveness and confusion to be assessed in the same manner as trademarks in the official languages.

## **6.2 European Approach**

The second alternative is to consider the European approach.

While the purpose of the American doctrine of foreign equivalent is international comity, the purpose of the European approach is the harmonization of its internal market.<sup>241</sup> This is because the European Union is an economic and political union that was created after the Second World War with “the idea being that countries that trade with one another become economically interdependent and so more likely to avoid conflict.”<sup>242</sup> This was the reasoning behind awarding the 2012 Nobel Peace Prize to the European Union in honour of its six decades of contributions “to the advancement of peace and reconciliation, democracy and human rights in Europe” by which “historical enemies can become close partners.”<sup>243</sup> International trade provides a great incentive to keep the peace. It is also no secret that the current island dispute between China and

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<sup>241</sup> Bently & Sherman, *supra* 32 at 705.

<sup>242</sup> “The EU in brief”, European Union (8 September 2016), online: <[https://europa.eu/european-union/about-eu/eu-in-brief\\_en](https://europa.eu/european-union/about-eu/eu-in-brief_en)>.

<sup>243</sup> “The Nobel Peace Prize 2012 to the European Union (EU) – Press Release”, Nobelprize.org (10 Sept 2016), online: <[http://www.nobelprize.org/nobel\\_prizes/peace/laureates/2012/press.html](http://www.nobelprize.org/nobel_prizes/peace/laureates/2012/press.html)>.

Japan has been mitigated by \$345 billion of trade, proving that “trade partners” might just lead to “peace partners”.

This harmonization has resulted in the following legal system for registering trademarks: (1) a national system to register trademarks in one member country; (2) a regional system to register trademarks in the member countries of Belgium, the Netherlands and Luxembourg; (3) a collective system managed by the European Union Intellectual Property Office to register European Union Trade Marks in all member countries; and (4) an international system to register trademarks in any country that is a signatory to the Madrid Protocol.<sup>244</sup> Although the four tiers are supposed to complement each other, the subsections below reveal how the stratified system has resulted in inequality in assessing foreign-language marks for distinctiveness<sup>245</sup> and confusion<sup>246</sup> under the collective system managed by the European Union Intellectual Property Office. In this regard, the European approach is just as unsatisfactory as the Canadian test for confusion and can also benefit from assuming linguistic knowledge for all foreign-language marks.

### **6.2.1 Official & Working Languages**

Under the collective system managed by the European Union Intellectual Property Office, these 24 languages receive the highest level of protection because they are officially recognized by the 28 member countries of the European Union.<sup>247</sup>

A trademark in an official language is unregistrable because it lacks distinctiveness if it is the generic term for a good or service, or if it describes the characteristic of a good or service, in

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<sup>244</sup> “Where to register”, European Union Intellectual Property Office (last accessed on 27 April 2017), online: <<https://euipo.europa.eu/ohimportal/en/trade-marks-in-the-european-union>>.

<sup>245</sup> (EC) No 207/2009, *supra* note 152 at 7(1)(b) and (c).

<sup>246</sup> (EC) No 207/2009, *supra* note 152 at 8 (1)(b).

<sup>247</sup> See “Member countries of the EU”, *supra* note 54 and “Official EU Languages”, *supra* note 55.

any of the official languages. This is true even if the official language has a small linguistic population or generates little economic activity. As a result, an examiner must translate a trademark into all of the official languages to ensure that it is not generic or descriptive in any of them.<sup>248</sup> This means that the collective system must be consistent with “the national system to register trademarks in one member country”, but the reverse is not guaranteed. For example, the national system in Spain allowed the registration of MATRATZEN even though it meant “mattress” in German, the second most common official language in the European Union. Spain did so because its population did not understand German and, therefore, the trademark was not generic as far as Spanish consumers were concerned.<sup>249</sup>

A trademark in an official language is unregistrable because it is confusing with an earlier mark if the relevant public makes an association between the marks in the territory where the earlier mark is protected. For example, BIMBO DOUGHNUTS for pastry and bakery products was confusing with an earlier registration in Spain for DOUGHNUTS for confectionary and pastry products. Although English was the most common official language in the European Union, it was not understood by the relevant public in Spain. The fact that both trademarks had no meaning to the relevant public in Spain increased their distinctiveness,<sup>250</sup> but not enough to avoid the likelihood of confusion.<sup>251</sup>

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<sup>248</sup> Gredley, *supra* note 17 at 105.

<sup>249</sup> This inconsistency is criticized by the authors with the statement “This cannot be correct.” when they discuss the MATRATZEN case in William Cornish et al, *Intellectual Property: Patents, Copyright, Trademarks and Allied Rights*, 7th ed (London: Sweet & Maxwell, 2010) at 740.

<sup>250</sup> *Bimbo SA v OHIM (BIMBO DOUGHNUTS)*, T-569/10, ECLI:EU:T:2012:535 at paras 52-53, 56-62 [*Bimbo*].

<sup>251</sup> *Bimbo*, *supra* note 250 at paras 90-94, 97-100.



## **6.2.2 Indigenous Regional & Minority Languages**

Under the collective system managed by the European Union Intellectual Property Office, these 79 languages receive special protection because they are used by the 203 national minorities or linguistic groups that promote Europe’s cultural heritage.<sup>252</sup> These languages originate from a certain region (such as Catalan and Welsh) or from a certain minority community (such as Romani and Yiddish) that are indigenous to the European Union.<sup>253</sup>

A trademark in a non-official language lacks distinctiveness if it is understood in at least a part of the European Union. This is true only if the relevant public in that “part of the European Union” understands the non-official language, because a trademark’s registrability at the national level in a member country should be consistent with its registrability at the collective level throughout the European Union. As a result, ESPETEC for raw meat sausages and dried pork cannot be registered because it means “a type of sausage that is not cooked but left to dry in order to be eaten” in the Catalan language, which is used in a part of Spain.<sup>254</sup>

A trademark in a non-official language is confusing with an earlier mark if it is understood by the relevant public in the territory where the earlier mark is protected. For example, the Turkish-language mark HELLIM for milk products was confusing with the earlier Greek-language mark HALLOUMI for cheese. Although Turkish was not an official language of the European Union, it was understood by the relevant public in Cyprus, where the earlier mark

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<sup>252</sup> “What languages does the European Charter for Regional or Minority Languages apply to?”, Council of Europe (last accessed on 27 April 2017), online <<http://www.coe.int/en/web/european-charter-regional-or-minority-languages/languages-covered>>. And see “States Parties to the European Charter for Regional or Minority Languages and their regional or minority languages”, Council of Europe (1 January 2016), online: <<https://rm.coe.int/CoERMPublicCommonSearchServices/DisplayDCTMContent?documentId=09000016806dc1e8>>.

<sup>253</sup> European Commission Directorate-General for Communication, *Speaking for Europe: Languages in the European Union* (Luxembourg: Office for Official Publications of the European Commission, 2008) at 9.

<sup>254</sup> *Sogepi Consulting y Publicidad, SL v OHIM (ESPETEC)*, T-72/11, ECLI:EU:T:2012:424 at paras 35-36.

was protected. The fact that both Turkish and Greek were official languages in Cyprus certainly increased the likelihood of the relevant public confusing the two trademarks.<sup>255</sup>

### **6.2.3 Foreign Languages**

Under the collective system managed by the European Union Intellectual Property Office, these languages receive the least legal protection because they do not have any formal status as the languages of immigrant communities (such as Arabic and Chinese) that are not indigenous to the European Union.<sup>256</sup>

A trademark in a foreign language lacks distinctiveness or is confusing in the same manner as an indigenous regional & minority language. This is worrisome because the two groups of languages are being treated equally when the latter group is supposed to receive special protection to protect and promote Europe's cultural heritage. As a result, a foreign language – which is supposed to receive less legal protection – could actually receive more trademark recognition than an indigenous language such as Catalan, especially if the immigrant population increases in significance while the local population decreases. Another worry is the differential treatment between foreign languages themselves. For example, a registration for the Arab-language mark EL BAINA for halal food was enough to block another confusing application, because the courts found that halal food was only consumed by Arabic consumers who understood the language.<sup>257</sup> Compare this to the opposite finding for four registrations for the Chinese-language marks WANG LAO JI for traditional medicine. The four registrations

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<sup>255</sup> *Organismos Kypriakis Galaktokomikis Viomihantias v OHIM (HELLIM)*, T-534/10, ECLI:EU:T:2012:292, aff'd *Foundation for the Protection of the Traditional Cheese of Cyprus named Halloumi v OHIM (HELLIM)*, C-393/12, ECLI:EU:C:2012:207.

<sup>256</sup> Richard Creech, *Law and Language in the European Union: the Paradox of a Babel United in Diversity* (Amsterdam: Europa Law Publishing, 2005) at 50.

<sup>257</sup> *Loutfi Management Propriété intellectuelle SARL v AMJ Meatproducts NV, Halalsupply NV*, C-147/14, ECLI:EU:C:2015:420.

were not enough to block another confusing application, because the courts found that traditional medicine were also consumed by the average European consumers who were not Chinese and did not understand the language.<sup>258</sup>

In this regard, the European approach is just as unsatisfactory as the Canadian test because it results in a stratified system. Trademark distinctiveness will depend on the linguistic populations and economic activities associated with a language. Trademark confusion will differ according to the territory where the earlier mark is protected. The European approach can also benefit from assuming linguistic knowledge for all foreign-language marks, as doing so focuses the evidence on the trademarks as they are and the association between them, which allows their distinctiveness and confusion to be assessed in the same manner as trademarks in the official languages.

### **6.3 Chinese Approach**

The third alternative is to consider the Chinese approach.

There is little use in looking at multilingual Hong Kong and Singapore, which do not have difficulty adjudicating English-language and Chinese-language marks.<sup>259</sup> This dissertation is developing a workable model for those without any knowledge of a foreign language (such as Chinese) in order to assess and compare such marks. This is similar to how bilingual Canada has no difficulty adjudicating English-language and French-language marks, whereas the United States needed the doctrine of foreign equivalents because it had no knowledge of French.

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<sup>258</sup> *Multi Access Limited v Guangzhou Baiyunshan Pharmaceutical Holdings Co, Ltd*, R 888/2016-2 at paras 52 and 83.

<sup>259</sup> As explained in Chapter 1, English is an official language of Hong Kong and Singapore. This may explain why Professor NG-LOY Wee Loon's comprehensive treatise on the *Law of Intellectual Property of Singapore* only makes reference to one Chinese-language mark at para [17.1.22].

On the other hand, China and Taiwan are monolingual like the United States and may have case law on assessing English-language marks and comparing them to Chinese-language marks. Such case law is of little use when both countries are civil law jurisdictions, which have neither judicial comity with the Western countries above nor reporting databases that are freely accessible (such as Quicklaw, Westlaw, and CanLII). It is important to remember that China enacted its first trademark law only in 1982.<sup>260</sup> Despite the paucity of cases, as well as the shortness and v\agueness of their reasoning, it can be instructive to consider the most famous and recent trademark decisions coming out of China. While the purpose of the American doctrine of foreign equivalent is international comity, and the purpose of the European approach is the harmonization of its internal market, it appears from the subsections below that the purpose of the Chinese approach comes from political pressure to affirm intellectual property rights and develop a friendlier environment for international businesses.

### **6.3.1 Example of TRUMP**

The first decision involved Donald Trump. Donald Trump owned multiple trademark registrations in China for TRUMP, which was licensed on everything from steaks to universities. Many other traders in China also registered TRUMP for different goods and services, the most famous being toilets that conduct pregnancy tests. It was inevitable that Donald Trump would eventually clash with the other traders: his 2006 trademark application to use TRUMP for real estate services was denied due to another trader's earlier registration for construction services,

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<sup>260</sup> Peter Yu, "Building the Ladder: Three Decades of Development of the Chinese Patent System" (2013) 5 WIPOJ 1 at 8. And equally applicable to trademarks is the author's comment about patents at 15 ("Thus, even though government leaders, policy makers and industry executives are often frustrated by the lack of progress in the Chinese intellectual property system – or, for that matter, the intellectual property system in other emerging countries – they need to think hard about what timeframe would be realistic for a country to develop a well-functioning patent system.").

and his 2007 trademark application to use TRUMP for restaurants was also denied due to another trader's earlier registration for coffee shops, restaurants and catering. Donald Trump spent a decade losing at every administrative and judicial level to which he appealed: even though he sent 300 pounds of materials to convince China that TRUMP was an internationally recognized brand in 2009, and he wrote to the United States Commerce Department requesting intervention in 2011.<sup>261</sup> So it was nothing short of a miracle (or mystery) when China's highest court approved his registration of TRUMP for restaurants in May 2016, as well as invalidated another trader's registration for constructions services.

First, China has a first-to-file system for recognizing trademark rights. So why would a court decide that another trader's prior registration for coffee shops, restaurants and catering no longer barred Donald Trump's later trademark application to use the same trademark for restaurants?

Second, it is difficult to invalidate trademarks after the 5-year registration period. So why would a court decide in November 2016 to invalidate another trader's pre-2006 registration for construction services in order to approve Donald Trump's 2006 trademark application to use the same trademark for real estate services?

Third, TRUMP is a common word. So why would a court reward Donald Trump with a monopoly over an English word? The finding was based on the 300 pounds of materials that TRUMP was an internationally recognized brand. But we need to understand – incredible as it sounds – that China's administrative and judicial levels were correct to deny Donald Trump's trademark applications, while China's highest court was incorrect to approve them. Consider

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<sup>261</sup> Jason Cherkis & Christina Wilkie, "Trump Once Asked for Obama's Help in a Trade Dispute with China: Trump's 2011 letter to Commerce Secretary Gary Locke claimed China had a 'deceitful culture'", The Huffington Post (13 September 2016), online: <[http://www.huffingtonpost.com/entry/trump-trade-dispute-china-obama\\_us\\_57d869a7e4b0fbd4b7bc2d1a](http://www.huffingtonpost.com/entry/trump-trade-dispute-china-obama_us_57d869a7e4b0fbd4b7bc2d1a)>.

how the Canadian test for confusion currently requires proof that the average consumer of the product will understand the foreign-language mark, how the American doctrine of foreign equivalents requires that the ordinary purchaser is likely to “stop and translate”, or how the European approach requires that the relevant public will understand the non-official language. Applying the same expectation in China would mean accepting the reality that the average Chinese consumers of real estate services, the ordinary Chinese purchasers at restaurants, or the relevant Chinese public cannot even read or sound out, much less understand, the foreign-language mark TRUMP. For every indignant protest that TRUMP should be recognized in China anyway because it is a common word in English, let us remember that 安娜 (ANNA) was not recognized in Canada even though it was a common name in Chinese. And for every cynical scoff at the idea that the Chinese public does not recognize TRUMP when Donald Trump has appeared on television shows and magazine covers, let us remember that the Canadian public was not expected to recognize 長江 (YANGTZE) even though it was geographical landmark and trademarked as early as the 1950’s by Li Ka-Shing. As Asia’s richest man and #23 on Forbe’s 2018 ranking of the world’s billionaires, Li Ka-Shing and his corporate trademark have received more international attention than Donald Trump (ranked at #766).

Suffice it to say, the sudden turn of events after a decade of losing litigation raised speculation that China’s decisions were politically motivated by Donald Trump’s presidential campaign at that time. The rumour mills churned even faster when China approved 38 new trademark applications for TRUMP and its translation as 川普 (CHUAN1 PU3) in February 2017, setting a record for the number and speed of the approvals.<sup>262</sup>

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<sup>262</sup> Sui-Lee Wee, “In China, Trump Wins a Trove of New Trademarks”, The New York Times (8 March 2017), online: <<https://www.nytimes.com/2017/03/08/business/china-trademark-donald-trump.html>>.

### **6.3.2 Example of JORDAN**

The second decision involved Michael Jordan. The standard translation that is internationally accepted for JORDAN, whether it be the name of a person or a country, is 約旦 (YUE1 DAN4). However, when Michael Jordan debuted on Chinese television during the 1984 Olympics, a news reporter made up the new translation 喬丹 (QIAO2 DAN1). It is not clear why the reporter did not use the standard translation. Perhaps the reporter thought the legendary basketball player deserved a unique translation with an extraordinary meaning: “tall – red” evokes a positive image because this specific Chinese character for “red” suggests sincerity and loyalty of heart. The new translation became popular and was registered by a clothing chain in China. Michael Jordan then spent years suing the clothing chain until he finally won an infringement case on December 8, 2016.<sup>263</sup> This decision from China’s highest court was astounding for three reasons.

First, there is a standard translation for JORDAN. So why would a court decide that the new translation actually identified Michael Jordan? The finding was based on evidence that the Chinese media has identified Michael Jordan by the new translation since the 1984 Olympics. This evidence exposes a weakness in Michael Jordan’s case from a trademark perspective: the new translation was neither used by Michael Jordan nor used as a trademark. The evidence suggests that the new translation was actually used by the public and used as information. Nevertheless, there is support for deciding that such use can enure to a specific trader in light of *Coca-Cola v Busch*.<sup>264</sup> The Coca-Cola Company advertised its products in association with the COCA-COLA mark, which the public abbreviated as COKE. Since The Coca-Cola Company

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<sup>263</sup> Sui-Lee Wee, “Michael Jordan Owns Right to His Name in Chinese Characters, Too, Court Rules”, *The New York Times* (7 Dec 2016), online: <<https://www.nytimes.com/2016/12/07/business/international/china-michael-jordan-trademark-lawsuit.html>>.

<sup>264</sup> *Coca-Cola v Busch*, *supra* note 174. (“... abbreviation of the trademark which the public has used and adopted as designating the product ... is equally to be protected as the trademark itself.”).

was not using the abbreviation, a competitor started using the variation KOKE. In order to persuade an American court that it had a complaint for confusion, The Coca-Cola Company first had to claim that the use by others of the COKE abbreviation should enure to it as the owner of the COCA-COLA mark.

Second, there is nothing distinctive about the name JORDAN. So why would a court decide that the new translation only identified Michael Jordan and did not also identify anyone and everyone named Jordan? The decision was based on evidence that the Chinese company accused of taking the new translation from Michael Jordan also registered other trademarks associated specifically with Michael Jordan: an NBA silhouette that was amended to reflect Michael Jordan's physique, the number 23 that used to be on Michael Jordan's basketball jersey, and the Chinese names of Michael Jordan's children.<sup>265</sup> This evidence could be dismissed on the basis that none of the registrations relate to trademarks or names actually belong to Michael Jordan: the trademarks belong to Nike, Inc.<sup>266</sup> and the names to his children. Nevertheless, there is support that such evidence is relevant in light of a much repeated commentary on passing off, the common law forefather of trademark infringement: "Why should the court be astute to say that the defendant cannot succeed in doing that which he is straining every nerve to do?"<sup>267</sup>

Third, there was at least a 10-year delay between the clothing chain in China registering the new translation in 2000 and Michael Jordan commencing his lawsuit in 2012. Although Nike, Inc. registered JORDAN in the 1990's, it did nothing with respect to filing or opposing

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<sup>265</sup> The Real Jordan, "Status Update: Merits of the Complaint" (last accessed on 27 April 2017), online: <<http://www.therealjordan.com/en/facts-of-the-case.aspx>>.

<sup>266</sup> AIR JORDAN, Nike Innovate C.V., China, 7455399 (class 25). JORDAN, Nike Innovate C.V. China, 775251 (class 25). JORDAN, Nike Innovate C.V. China, 775253 (class 28). JORDAN, Nike Innovate C.V. China, 775254 (class 18).

<sup>267</sup> NG-LOY, *supra* note 65 at para [18.1.4], referring to *Malayan Tobacco Distributors Ltd v United Kingdom Tobacco Ltd*, [1937] MLJ 147 at 150. And see *Harrods Ltd v Harrodian School Ltd*, [1996] RPC 697 at 706, quoting *Slazenger & Sons v Feltham & Co* (1889), 6 RPC 531 at 538.



trademark applications for the new translation.<sup>268</sup> So why would a court reward Michael Jordan for the inexcusable delay, especially when trademark registrations were supposed to be difficult to invalidate after the 5-year registration period? During that time, the clothing chain had become well known to the public through its large-scale activities: registering almost 500 trademarks, investing over \$10 million USD in annual advertising, establishing over 5,700 retail outlets, and attempting to become a publicly traded company.<sup>269</sup> If it is wrong for one to benefit from Michael Jordan's popularity, then is it not also wrong for the other to benefit from the clothing chain's decade of advertising? This could be a reason behind the decision from China's highest court that Michael Jordan can only claim the new translation with respect to the writing (乔丹) but not with respect to the pronunciation (QIAO2 DAN1). This means that although the clothing chain can no longer use the Chinese characters, it can continue to use the PinYin letters by which it is also known. It can also use other Chinese characters that correspond with the same PinYin letters, which can compete with and dilute the uniqueness of the new translation that Michael Jordan just won.

If Michael Jordan could have known that this would be the result, would he still have commenced the lawsuits in 2012 or would he have chosen to rebrand instead? His decision was probably pre-determined by the advice he sought. For example, an ad agency would know nothing of litigation but be quick to advise on rebranding. The marketing experts might realize that there is no mandatory translation for JORDAN. This meant that Michael Jordan was free to ignore both the standard translation that was internationally accepted and the new translation

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<sup>268</sup> Industry Insights, "3 Take-aways From Michael Jordan's Chinese Supreme Court Trademark Victory For Companies Doing Business in China", SportTechie (15 December 2016), online: <<http://www.sporttechie.com/2016/12/15/industryinsights/3-take-aways-from-michael-jordans-chinese-supreme-court-trademark-victory-for-companies-doing-business-in-china/>>.

<sup>269</sup> Deanna Wong & Stefaan Meuwissen, "No Trademark Slam Dunk for Michael Jordan in China", Bloomberg Law (2 June 2015), online: <<https://bol.bna.com/no-trademark-slam-dunk-for-michael-jordan-in-china/>>.

given to him by the Chinese media. He was free to create and register his own Chinese name, use it in all future communications, and publicize in future interviews that any other Chinese translations have nothing to do with him. Doing so could have neutralized the Chinese company and publicized its illegitimacy just as effectively, and without the years and fees spent on litigation. On the other hand, a law firm is not in the business of rebranding but would have ample advice on litigation.

Legal experts might assume that Michael Jordan's situation is the same as that of Jeremy Lin. Jeremy Lin now plays point guard for the Charlotte Hornets, the NBA team owned by Michael Jordan. When he filed applications in China for his trademarks, including JEREMY LIN and LINSANITY in English, he discovered that another company in China had already registered his Chinese name.<sup>270</sup> His situation differs from that of Michael Jordan, however, because he does not have the option of rebranding. His Chinese name is independent, as it is neither a standard translation nor a media designation of his English name. His Chinese name is also much more personal, as it what his parents have called him since birth. We must consider whether Donald Trump and Michael Jordan deserve the same protection for their Chinese translations as Jeremy Lin does for his Chinese name, especially in light of Professor Scassa's observation that names are "the simplest, most literal and most obvious of all symbols of identify" and surnames "can reflect one's cultural, ethnic, religious or familial heritage."<sup>271</sup> Fortunately for Jeremy Lin, his boss already knows how to win a trademark case in China.

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<sup>270</sup> Benjamin Kang Lim, "Jeremy Lin Trademarks Scooped Up By Chinese Company Last August", The Huffington Post (27 February 2012), online: <[http://www.huffingtonpost.com/2012/02/27/jeremy-lin-trademark-scooped-chinese-company\\_n\\_1303271.html](http://www.huffingtonpost.com/2012/02/27/jeremy-lin-trademark-scooped-chinese-company_n_1303271.html)>.

<sup>271</sup> Teresa Scassa, *Legislating the Mother Tongue: Language, the Individual and the State* (SJD Thesis, University of Michigan, 1995) quoting from Harold Isaacs, "Basic Group Identity: The Idols of the Tribe" in Nathan Glazer & Daniel Moynihan, eds, *Ethnicity: Theory and Experience* (Cambridge: Harvard University Press, 1975) 29 at 50 and "Parent's Selection of Children's Surnames" (1983) 51 Geo Wash L Rev 583 respectively [Scassa].

It is clear from this chapter that the Chinese approach is actually the closest to assuming linguistic knowledge out of all the countries discussed. This reveals how Canada, the United States, and the European Union themselves are sensitive to foreign-language marks but fail to appreciate that others can also be blinded and paralyzed with the “foreign-ness” of English-language marks. The expectation for Chinese locals to be *fluent consumers* regardless of whether a trademark is in Chinese or English means that the Western countries above have failed to apply the very approach that they expect from China.

# 7 LINGUISTIC KNOWLEDGE

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This chapter tests the solution of assuming linguistic knowledge by applying it to the criteria for trademark registrability, as well as to the trader's rights against infringement, against depreciation of goodwill, to license, and to translate. Assuming linguistic knowledge serve the dual purposes of trademark law in protecting the consumer from confusion and the trader from unfair competition, because assessing foreign-language marks in the same manner as trademarks in the official languages stops the expansion of rights by minimizing claims that any and all translations infringe or depreciate a registered trademark.

## **7.1 Registrability of Trademarks**

Section 12 of Canada's *Trademarks Act* sets out a defined list of when trademarks are registrable in order to receive statutory protection. The criteria for registrability used to mean little for foreign-language marks. It had limited application when the test for confusion always imagined *the illiterate consumer*. This was true even though it was odd and contradictory that foreign-language marks that are not Romanized were deemed to be designs (which had no distinctiveness issue), but still had to provide translations as if they were words (in order to assess for distinctiveness). The inclusion of *the fluent consumer* now raises the question whether registrability should be assessed based on the foreign language used in the trademark or based on the English translation of the trademark. This is an important issue because conducting the assessment in different languages could affect the registrability of foreign-language marks, as demonstrated in the subsections below.

### **7.1.1 Names or Surnames**

Section 12(1)(a) of Canada's *Trademarks Act* states that "a trademark is registrable if it is not a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years."

This is generally assessed by checking a Canadian directory to see if it has 25 entries or more of the name or the surname. For example, the surname "McDonald" is not registrable due to its numerous entries in the Canadian telephone directory (although the fast food restaurant MCDONALD'S could register its trademark after it acquired secondary meaning to overcome its original lack of distinctiveness). The same approach meant that foreign surnames such as the Spanish "Galanos",<sup>272</sup> the Japanese "Nishi",<sup>273</sup> and the Arabic "Abd-Ru-Shin"<sup>274</sup> were registrable because they were unlikely to be recognized as such or found in a telephone directory in Canada. Would it matter if the surnames found in a telephone directory are skewed representations as a result of segregation (such as Germany mandating Jewish names to the point of requiring all Jewish males and females to use Israel and Sarah respectively), assimilation (such as Italy forbidding foreign names to the point of "re-italianizing" gravestones), or nation-building (such as Bulgari's name-change program in order to conceal its Turkish minority)?<sup>275</sup>

Applying the same general assessment to names and surnames in non-Roman languages will produce different results depending on whether the assessment is based on the non-Roman language or the English translation. For example, the surname "Goh" is registrable due to its limited entries in the mainstream Canadian telephone directory. This assessment should not

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<sup>272</sup> *Galanos v Canada (Registrar of Trade Marks)* (1982), 69 CPR (2d) 144 (FCTD).

<sup>273</sup> *Nishi v Robert Morse Appliances Ltd* (1990), 34 CPR (3d) 161 (FCTD).

<sup>274</sup> *Drolet v Stiftung Grasbotschaft*, 2009 FC 17, [201] 1 FCR 492 (FCTD) [*Drolet*].

<sup>275</sup> Scassa, *supra* note 271 at 156-162.

change due to the increased entries by considering that “Goh”, “Ng”, and “Wu” are actually English versions of 吳 from Southeast Asia, Hong Kong, and China respectively, as most Canadians will neither know of the association nor confuse the surnames in English. They are more likely to be confused by “Chen”, “Cheng”, and “Cheung”, even though all three come from different Chinese characters. On the other hand, 吳 itself should not be registrable due to its numerous entries in Chinese-Canadian telephone directories. It is one of the 100 most common Chinese surnames listed in a classic Chinese text called *Hundred Family Surnames* (one of three literary texts that children must memorize in order to learn Chinese characters). The corollary of not equating Chinese surnames with their English translations means that the unregistrability of “Anna” should not apply automatically to 安娜, as there *can* also be different Chinese versions of the English name. Notwithstanding this, 安娜 is unregistrable because the numerous entries in Chinese-Canadian telephone directories serve as evidence to prove that it *is* the standard translation that is internationally accepted for “Anna”.

Now that the test for confusion considers linguistic knowledge as part of the surrounding circumstances, should cultural differences also become a consideration when it comes to name-based trademarks? For example, Anglo-speaking countries start with the personal names and end with surnames. Chinese-speaking countries reverse the order by starting with the surnames to indicate the family, then following with the personal names to indicate the individual.<sup>276</sup> This

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<sup>276</sup> Chinese personal names can be one character or two characters (just as English personal names can be limited to a first name only, or can be composed of first and middle names). What matters is that the first character indicates the generation of the individual in the family. This is because it often happens in traditionally large families that the youngest aunt/uncle is born after the oldest niece/nephew, or there are 30-year differences between cousins of the same generation. Since one’s generation takes precedence over one’s age, generational names are an important source of information in helping to determine one’s hierarchy in the family. The importance of generational names is illustrated by America’s beloved cellist Yo-Yo Ma: around 1755, one of his ancestors not only documented the past generational names of the Ma family back to Yo-Yo’s 13<sup>th</sup> great-grandfather in 1435 but also dictated the future generational names of the Ma family up to Yo-Yo’s 30<sup>th</sup> great-grandchild. See Henry Louis Gates, Jr., *Faces of America: How 12 Extraordinary People Discovered Their Pasts* (New York: NYUP, 2010) at 99-101.

cultural norm can also apply to English translations of Chinese names, which means America's beloved cellist would call himself MA Yo-Yo in Chinese-speaking countries. Unfortunately, doing so causes confusion in the West, so he follows the cultural norm in Anglo-speaking countries by calling himself Yo-Yo MA. However, not all Chinese follow the cultural norm in Anglo-speaking countries, so Anglo-speakers are often and rightfully confused when faced with English translations of Chinese names. Some Chinese try to minimize the confusion by capitalizing the surname (as in MA) or by joining both components of their personal names (as in Yo-Yo). If an English translation mirrors a Chinese name instead of following the English cultural norm, can someone else use an English translation which reverses the order?<sup>277</sup>

### **7.1.2 Distinctiveness of Trademarks**

Sections 12(1)(b) and (c) of Canada's *Trademarks Act* state that "a trademark is registrable if it is not (b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the goods or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin; (c) the name in any

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<sup>277</sup> *Apple Inc v Wholesale Central Ptd Ltd*, [2010] ATMO 7 found that a trademark application for DOPi was not confusing with trademark registrations for iPOD and IPOD. No author, "*Ex parte I Rokeach & Sons, Inc* (1953)" (1954) 44:1 INTA Trademark Reporter 102 at 102-103 ("With this conclusion there can be no doubt, the word Kosher, whether written in Hebrew characters or not, is considered wholly incapable of functioning as a trademark owned by any particular individual or company. The letters as shown on the drawing are not written as they ordinarily appear, but the word as shown is the mirror image of the word when normally written, having the appearance, for example, the word would have when viewed from the inside of a store on the window of which the word appears. Being so obviously unregistrable when written in normal manner, I do not believe that the word could be registered when viewed from the rear side."). This appears consistent with the Intellectual Property Office of Singapore's finding in *Guangzhou Pharmaceutical Holding Limited v Multi Access Limited*, [2017] SGIPOS 13 at paras 9 and 37 ("The Applicant's Marks as registered in Singapore have the same Chinese characters written from right to left and the Proprietor's Mark has the Chinese characters written from left to right. ... In 2006, in so far as the average Chinese reader in Singapore is concerned, he or she would not likely read a Chinese phrase from right to left anymore. ... Consequently, the two marks would not look similar to the average consumer in Singapore.") [*Wang Lao Ji*].

language of any of the goods or services in connection with which it is used or proposed to be used.”

As previously discussed in subsection 5.1.1 on “Assessing for Distinctiveness”, the difference between descriptive marks being barred in the English or French language versus generic marks being barred in any language should be removed because traders should be prohibited from doing in a foreign language what they cannot do in English or French.

On the one hand, both the Supreme Court of Canada’s “matter of first impression and imperfect recollection” and the Federal Court of Canada’s “average consumer of the product” statements are clear that the test for confusion focuses on the mind of the consumer. This may suggest that the distinctiveness should be assessed based on the foreign language used in the trademark, since *the fluent consumer* will be thinking in that foreign language. For example, *the fluent consumer* will think in English when reading the English words and will think in French when reading the French words in the sentence: “You committed a *faux pas* by bringing your *bouquet* from the *ballet* into the *café* where we had *croissants* before heading to the *restaurant*.” *The fluent consumer* will not translate the entire sentence into English in order to understand it: “You committed a [fake step/social blunder] by bringing your [bunch of flowers] from the [Italian dance performance] into the [coffee shop] where we had [French rolls] before heading to the [establishment for eating].” Nor will *the fluent consumer* translate the entire sentence into French.

On the other hand, such an approach would place a heavy burden on courts to familiarize themselves with the foreign language used in the trademarks in dispute in order to access the mind of the consumer. The fact remains that Canadian courts think only in Canada’s official



languages, so it is a practical necessity for them to assess distinctiveness based on the English or French translation of the trademark.

The inclusion of linguistic knowledge in the test for confusion now means that the spectrum running from strong to weak distinctiveness for trademarks will also apply to foreign-language marks. The subsections below will continue to review the stories of The Coca-Cola Company and the two Chinese bakeries in Canada that originally ignored linguistic knowledge to illustrate how conducting the assessment in different languages will result in different levels of trademark distinctiveness.

#### **7.1.2.1 Inherently Distinctive Marks**

Inherently distinctive marks may be fanciful, coined, or arbitrary marks.

A fanciful and coined mark is an invented word that has no dictionary definition. Therefore it has a strong distinctiveness because it has no meaning as a word and only has meaning as a mark. This is the case with PEPSI-COLA's translation 百事可樂, since 可樂 was distinctive in Chinese when first coined in 1933 and the four characters have no meaning as a combination. The same rationale applies if the Chinese characters 聖安娜 were to have no meaning as a combination.

An arbitrary mark is a word that has a dictionary definition, but is used arbitrarily in a meaningless context. Therefore it also has a strong distinctiveness because its meaning as a word is irrelevant to the arbitrary meaning of the trademark. This is the case with PEPSI-COLA's translation 百事可樂, since neither the literal meaning "hundred things possible happy" nor the suggested meaning "happy with everything" has anything to do with colas. The same rationale applies to the Chinese characters 聖安娜, since neither the literal meaning HOLY –

PEACEFUL – ELEGANT nor the colloquial meaning SAINT ANNA has anything to do with pastries.

#### **7.1.2.2 Suggestive Marks**

A suggestive mark is a word that has a dictionary definition, and is used to hint at the character or quality of the product. Therefore it is less distinctive because its meaning as a word is relevant to the hinted meaning of the trademark. This is the case with COCA-COLA's translation 可口可樂 being used in association with colas, since 可口 meant “tasty”. The same rationale applies if the Chinese characters 聖安娜 were used in association with baking communion bread for Christian and Catholic churches, since both the literal meaning HOLY – PEACEFUL – ELEGANT and the colloquial meaning SAINT ANNA are religious.

#### **7.1.2.3 Descriptive/Misdescriptive Marks**

A descriptive (or misdescriptive) mark is a word that has a dictionary definition, and is used to describe (or mislead as to) the character or quality of the product. Therefore it is not distinctive, because its meaning as a word is the same as the actual meaning of the trademark, but it can become distinctive if it acquires secondary meaning. This would be the case if COCA-COLA had been translated literally as 古柯 (GU3 KE1 means “coca”) and 汽水 (QI4 SHUI3 means “air water” as in a carbonated drink), unless the trademark acquired secondary meaning so that consumers no longer associate it with any and all carbonated drinks made from coca leaves. The same rationale applies if the Chinese characters 聖安娜 were translated as SAINT HONORÉ (the name of the French patron saint of bakers and pastry chefs; the name of a municipality in Québec; the name of a commune and a street in France) or SAINT ANNA (the

name of the Virgin Mary's mother; Jesus' grandmother), unless the trademark acquired secondary meaning so that consumers no longer associate it with the famous person or place of the same name.

#### **7.1.2.4 Generic Marks**

A generic mark is a word that has a dictionary definition, and is used as a common word for the product itself. Therefore it can never be distinctive because its meaning as a word is the same as the actual meaning of the product itself. This would be the case regardless of whether COCA-COLA is translated literally as 古柯汽水 or colloquially as 可口可樂. This is because 汽水 has always meant “air water” as in a carbonated drink, whereas 可樂 was distinctive in Chinese when first coined in 1933 but has come to mean “cola” and now lacks distinctiveness. The same rationale applies if the Chinese characters 聖安娜 were translated as CHALLAH, which is the common name for a type of Jewish bread eaten on the Sabbath.

It is important to note that the subsections above only illustrate how linguistic knowledge can affect trademark distinctiveness: the Chinese characters remain the same, yet their trademark distinctiveness will vary depending on their English translations. And translations have linguistic limitations, as they may fail to capture all the linguistic possibilities of foreign languages. For example, there is only one word in English for “cousin”, but there are multiple such words in Chinese which immediately specify whether the cousin is male or female, older or younger, on the paternal side or maternal side, and related by blood or marriage. The test for confusion is thus applied to foreign-language marks within the limits of a mind that only understands English, not within the mind of *the fluent consumer* open to all its cultural connotations.

Some may find this problematic and suggest solving it by reverting to the time when all foreign-language marks were treated by imagining *the illiterate consumer*. This approach was acceptable in a national economy when each country established its own trademark system in accordance with its own official language(s). It is no longer acceptable in today's global economy where foreign languages cross national boundaries when people migrate and intermarry, corporations merge with and acquire one another, and countries trade with each other.

### **7.1.3 Confusion of Trademarks**

Section 12(1)(d) of Canada's *Trademarks Act* states that "a trademark is registrable if it is not confusing with a registered trademark."

As previously discussed in subsection 5.1.2 on "Comparing for Confusion", foreign-language marks should not be compared for confusion based on their translations because the test for confusion does not make any references to languages. The recommended solution to assume linguistic knowledge, instead of requiring proof of it *before* including it in the test for confusion, does not mean that evidence as to how consumers perceive the trademark is no longer required. On the contrary, the courts can still leave the burden on the trademark applicant to dispute the assumption by proving that consumers have no linguistic knowledge for any registered foreign-language mark that is barring the application. After all, it is the applicant who is *in petitorio*.<sup>278</sup> The subsections below illustrate that the kind of evidence required for the test for confusion also applies to linguistic knowledge: while evidence as to *the existence of* linguistic knowledge is not required, evidence as to *the confusion arising from* linguistic knowledge remains relevant.

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<sup>278</sup> The test for confusion in opposition proceedings requires the trademark applicant to prove there is no likelihood of confusion, according to *Mattel*, *supra* note 99 at para 6. It is only infringement proceedings that require traders to prove that there is likelihood of confusion, according to *Veuve Clicquot Ponsardin*, *supra* note 99 at para 14.

### 7.1.3.1 Reference Sources

The first type of evidence could be reference sources such as almanacs, biographies, dictionaries, encyclopedias, gazetteers, thesauruses, yearbooks, *etc.*<sup>279</sup> An example is how PEPSI-COLA was found to be not confusing with COCA-COLA because a reference to dictionaries established that “Cola would, therefore, appear to be a word which might appropriately be used in association with beverages and, in particular, with that class of non-alcoholic beverages colloquially known by the description of ‘soft drinks’.”<sup>280</sup> Another example is how DIXI-COLA was found to be not confusing with COCA-COLA because scientific and popular literature recognized Cola “as the name of a tree native to Africa” and pharmaceutical and scientific publications suggested that “it could be used to make a beverage that would successfully compete with tea and coffee as a refreshing and invigorating drink.”<sup>281</sup>

Although it is important to respect the territoriality of trademarks, it must be noted that reference sources need not be restricted by national boundaries. Canada’s *Trademarks Act* prohibits generic marks that are “the name in any language of any of the goods or services in connection with which it is used or proposed to be used.”<sup>282</sup> The *Home Juice* case accepted evidence regarding the French word MAISON from foreign dictionaries published in France, which contained different definitions from the domestic dictionaries published in Canada. The court considered the meaning of the French word in France because failing to do so would enable “a shrewd trader [to] monopolize a new French expression by registering it as a trade mark as soon as it started being used in France or in another French-speaking country and before it could

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<sup>279</sup> *Donald F Duncan, Inc, v Royal Tops Manufacturing Company, Inc, and Randy Brown*, 343 F (2d) 655, 144 USPQ 617 (7th Cir 1965) at paras 28, 67-68 [*Royal Tops*]. And see *Dixi-Cola Laboratories, Inc, et al, v Coca-Cola Co*, 117 F (2d) 352 (4th Cir 1941) at 358 [*Dixi-Cola*].

<sup>280</sup> *Pepsi-Cola*, *supra* note 102 at 617.

<sup>281</sup> *Dixi-Cola*, *supra* note 279 at 355.

<sup>282</sup> *Trademarks Act*, *supra* note 19, s 12(1)(c).

be shown to have begun being used in Canada.”<sup>283</sup> This rationale could also apply to foreign-language marks. Since the 1970 case already described English and French as international languages with “a vocabulary that is extremely difficult to define especially in these days when communication media are no longer confined within national boundaries,” the same logic could apply today to Chinese (the most widely-spoken language in the world) as well as to Spanish and Arabic (both are more widely spoken than French worldwide).<sup>284</sup>

### **7.1.3.2 Social Influences**

A second type of evidence could be social influences ranging from contemporary (blogs, Facebook, LinkedIn, Twitter, YouTube, *etc.*) to traditional (newspapers, magazines, radio, television, film, *etc.*) media.<sup>285</sup>

Keeping in mind the importance of respecting the territoriality of trademark, it would appear that social influences should be restricted by national boundaries; namely, the social influence may originate from a foreign source, but it should not be considered unless it ends with a local consumer. Not restricting reference sources makes sense since such evidence serves to explain the origin and meaning of the word used in the trademark, but not the trademark itself. Conversely, restricting social influences seems necessary because such evidence serves to prove the knowledge and use of the trademark in association with specific goods and services. This raises the question as to whether the territoriality of social influences will matter after Canada abandons the use requirement for trademark applications. *Re an Application by La Marquise*

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<sup>283</sup> *Home Juice*, *supra* note 150 at para 51.

<sup>284</sup> “Summary by Language Size”, Ethnologue, Languages of the World (last accessed on 27 April 2017), online: <<http://www.ethnologue.com/statistics/size>>. (There are 1,302 million Chinese speakers; 427 million Spanish speakers; 339 million English speakers; 267 million Arabic speakers; and 75.9 million French speakers worldwide.)

<sup>285</sup> *Royal Tops*, *supra* note 279 at paras 53-55.

*Footwear*<sup>286</sup> accepted evidence regarding the English slang OOMPH from the United States, because failing to do so would be to ignore the influence of the American film industry in England:

“I should perhaps add this: much argument was addressed upon the footing that, after all, the word, in so far as it is in current use, however short and brutish a life it may have, is American slang rather than, as we would say, part of our own native tongue. That is a matter upon which one might have debate for hours – whether it is the fact that the English tongue as spoken in these islands and the English tongue as spoken in the United States or in Canada or in Australia or in other parts of the globe is or is not one and the same language. I do not propose to throw any light upon any possible answer to the question, save to say that where, as here, the word is primarily employed in the film industry, and, as is well known, are shown and seen by hundreds of thousands of people throughout the whole of the English-speaking world, I think that it would be an affectation to say that a word which has gained any currency as an American slang word ought to be treated in these islands, in the absence of any evidence one way or the other, as a foreign word.”

This rationale could also apply to foreign-language marks nowadays given that many of Canada’s linguistic populations have their own highly profitable and widely distributed media, including newspaper and magazines, radio, television and movies.

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<sup>286</sup> *Re La Marquise Footwear*, *supra* note 150.

### 7.1.3.3 Government Documents

A third type of evidence could be government documents such as trademark registrations, patent specifications, corporate certificates, *etc.*<sup>287</sup> For example, PEPSI-COLA was found to be not confusing with COCA-COLA due to evidence of “a series of 22 trademarks registered Canada in during a period of 29 years, viz, from 1902 to 1930 [*sic*], in connection with beverages [which showed] that the word Cola had been adopted in Canada as an item in the naming of different beverages.”<sup>288</sup> Conversely, The Coca-Cola Company tried unsuccessfully to use its five trademark registrations to stop another competitor from using DIXI-COLA.<sup>289</sup> One reason for the failure was because a claim to the exclusive use of COCA-COLA was insufficient to monopolize the word COLA, as the court noted that there were at least 143 registrations in the United States using the word COLA as a suffix for competing drinks.<sup>290</sup> Another reason for the failure was because the company had admitted previously in affidavits that “the name in large measure [was] descriptive of the character of the article” in order to benefit from a then-existing provision “which permits the registration of a descriptive mark by one who has made actual and exclusive use thereof for ten years next preceding the approval of the act.”<sup>291</sup>

Another example of “government documents” comes from the *Saint Honore* case, where evidence that federal Members of Parliament and provincial Members of the Legislative

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<sup>287</sup> *Royal Tops*, *supra* note 279 at paras 43-52, 56-57, 62-66. And see *Parke, Davis & Co v Empire Laboratories Ltd*, [1964] SCR 351, 1964 CanLII 74 at 355-356 (“... there was evidence that the appellant at one time held a United States patent on sealed capsules with similar bands from 1932 until it expire in 1949. ... Then, after the patent had expired, the appellant registered its 10 trademarks in Canada on September 19, 1950. In this way it sought to perpetuate its monopoly of the patent by applying for registration of the trademarks which, if regularly renewed, may be perpetuated. A similar situation arose in the case of *Canadian Shredded Wheat Company v Kellogg Company et al.* ... Lord Russell ((1938) D.L.R.) at p. 150 stated: ‘... There can be little doubt that had the plaintiff, when the patent expired, attempted to register the words ‘Shredded Wheat’ as a trademark for the sale of biscuits and crackers, the application would have met with short shrift. It would be attempting by registering the name of the patented product to prolong the patent monopoly; and this may not be done.’”).

<sup>288</sup> *Pepsi-Cola*, *supra* note 102 at 618.

<sup>289</sup> *Dixi-Cola*, *supra* note 279 at 353, 355.

<sup>290</sup> *Dixi-Cola*, *supra* note 279 at 358.

<sup>291</sup> *Dixi-Cola*, *supra* note 279 at 356.



Assembly who are non-Chinese now have Chinese names on their business cards and newsletters assisted the court in taking judicial notice of a significant Chinese linguistic population in Canada.<sup>292</sup> Keep in mind that this is different from using the evidence to prove *the confusion arising from* linguistic knowledge, which was illustrated during the United States election of 2016. The voting ballots in California translated Donald J. Trump’s name as 唐納德 J. 特郎普 (TANG2 NA4 DE2 J. TE4 LANG3 PU3), while the voting ballots in New York translated it as 唐諾得 J. 川普 (TANG2 NUO4 DE2 J. CHUAN1 PU3).<sup>293</sup> Are the voting ballots evidence that both are standard translations that are internationally accepted for the names “Donald” and “Trump”, which means they need to acquire secondary meaning to overcome the original lack of distinctiveness? Alternatively, are the voting ballots evidence that there are no standard translations for the names, which means they are not barred from registration as “a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years”?<sup>294</sup> Foreign government documents provide conflicting evidence because China uses the former translation, while most other Chinese jurisdictions (Hong Kong, Singapore, and Taiwan) use the latter translation. The United States government could have created a third translation in order to avoid the political awkwardness of choosing between the existing translations, which would have avoided the practical confusion of having contradictory voting ballots. Since Donald Trump used and registered the latter translation, does the former translation remain free for others to use? Since both translations mirror Donald Trump’s English

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<sup>292</sup> *Saint Honore*, *supra* note 91 at para 27.

<sup>293</sup> Nikhil Sonnad, “New York’s and California’s Ballots Disagree on How to Write ‘Donald Trump’ in Chinese” (8 Nov 2016), online: <<http://qz.com/831181/election-2016-how-do-you-write-donald-trump-in-chinese/>>.

<sup>294</sup> *Trademarks Act*, *supra* note 19, s 12(1)(a).

name instead of following Chinese cultural norm, can someone else use Chinese trademarks which reverse the order?<sup>295</sup>

Although it is important to respect the territoriality of trademarks, judicial willingness to consider French references and American influences raises the possibility that the courts may also accept the relevance of foreign trademark registrations, and even foreign court decisions. Accepting foreign trademark registrations in keeping with the policy of international comity discussed in Chapter 6, as well as with international trademark systems, such as the Madrid Protocol, which extends a trademark registration in one member country to any or all of the other member countries. And foreign court decisions could arguably be admissible as “government documents” since courts form the judicial branch of government. Of course, foreign trademark registrations may carry little persuasive weight when issued from countries known for trademark squatters, just as foreign court decisions may have little precedential value.<sup>296</sup>

#### **7.1.3.4 Corporate Materials**

A fourth type of evidence could be corporate materials such as licence agreements, order sheets, promotional materials, cease-and-desist letters, *etc.*<sup>297</sup> For example, DIXI-COLA was found to be not confusing with COCA-COLA because “The Coca-Cola Company itself has recognized the propriety of competitive trade names containing the word “Cola” by consenting

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<sup>295</sup> *Wang Lao Ji*, *supra* note 277 discussed how the Intellectual Property Office of Singapore found no confusion when one party’s trademarks wrote Chinese characters from left to right and another party’s trademark wrote the same Chinese characters from right to left.

<sup>296</sup> The Law Library of Congress, “The Impact of Foreign Law on Domestic Judgments” (2010) Global Legal Research Center at 1 noted that “From time to time, American courts, which are relatively isolated from foreign influence, consider ‘civilized standards’ and ‘views that have been expressed by ... other nations’ to support their decisions.”, whereas at 3 noted that “[Chinese] judges are familiar with foreign methods of legal interpretation and apply their knowledge of foreign legal doctrines in their domestic practice, but do not mention foreign law directly.”).

<sup>297</sup> *Royal Tops*, *supra* note 279 at paras 40-42, 69-70.

to a number of consent decrees.”<sup>298</sup> As a result of weekly lawsuits against competitors from 1911-1941, the company won twenty-nine court orders in the duration of thirty years to enjoin the use of the word “Cola” on its own. Twenty-three of them were consent decrees.<sup>299</sup>

#### **7.1.3.5 Expert Witnesses**

A fifth type of evidence could be expert witnesses such as linguists, etymologists, social scientists, *etc.* A pessimist would assume that such evidence would be reduced to experts contradicting each other on the distinctiveness of and the confusion between whatever marks are in question,<sup>300</sup> but an optimist would hope that the court can separate the truth from the contradictions. From Singapore<sup>301</sup> to the United States,<sup>302</sup> it is now common place for an expert witness to study a word, express an opinion as to its origin, and explain its meaning in order to assist the courts in assessing for distinctiveness or comparing for confusion.<sup>303</sup>

#### **7.1.3.6 Lay Testimonies**

The sixth type of evidence could be lay testimonies such as non-expert witnesses, customer surveys, *etc.*<sup>304</sup> For example, The Coca-Cola Company introduced forty-one witnesses to testify that “when they saw goods labeled by a name containing the suffix ‘COLA’, they were led to believe, not that the goods were COCA-COLA, but that they originated with the Coca-

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<sup>298</sup> *Dixi-Cola*, *supra* note 279 at 358.

<sup>299</sup> *Dixi-Cola*, *supra* note 279 at 359.

<sup>300</sup> *Yee Hong*, *supra* note 70 at para 16.

<sup>301</sup> *Yomeishu Seizo Co Ltd v Sinma Medical Products (M) Sdn Bhd* in NG-LOY Wee Loon, “The Meaning of ‘Invented’ in Trade Mark Law” (1997) 9 Sing Ac LJ 203-210.

<sup>302</sup> *Royal Tops*, *supra* note 279 at para 28. And see Shuy, *supra* note 86.

<sup>303</sup> *Cinar*, *supra* note 4 at para 55 also accepted expert evidence from a semiologist in a copyright infringement case based on the criteria listed in para 49 (“For expert evidence to be admitted at trial, it must (a) be relevant; (b) be necessary to assist the trier of fact; (c) not offend any exclusionary rule; and (d) invoke a properly qualified expert: *R v Mohan*, [1994] 2 S.C.R. 9. These criteria apply to trials for copyright infringement, as they do in other intellectual property cases: *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, [2011] 2 SCR 387, at para. 75.”).

<sup>304</sup> *Royal Tops*, *supra* note 279 at paras 58-61, 71-78.

Cola Company”.<sup>305</sup> Although the court found such evidence insufficient to stop a competitor from using DIXI-COLA, since it found that a claim to the exclusive use of COCA-COLA was insufficient to monopolize the word COLA, the court did find unfair competition on another ground: a scheme to confuse consumers by copying the colour, the script, and the display.<sup>306</sup> The fact that the court finding was not based on trademark infringement, but on unfair competition, was emphasized with its affirmation that “the product including the coloring matter is free to all who can make it *if no intrinsic deceiving element is present*”<sup>307</sup> [*emphasis added*]. Likewise, the court took judicial notice of a significant Chinese linguistic community in Canada in the *Saint Honore* case because 1,905 of the 2,259 customer surveys (conducted in previous years on other issues) were filled out in Chinese instead of English.<sup>308</sup>

### **7.1.3.7 Translations vs Transliterations**

A new type of evidence could be comparing the trademark in dispute with its foreign-language equivalents. Perhaps a novel argument can be made that the foreign-language equivalents shed light on how much a trader values the sound or the meaning of a trademark. For example, MICROSOFT is translated literally as 微軟. Can the translation be used to oppose a competitor from using BABY SOFT by helping to overcome arguments that MICROSOFT has lost much – perhaps all – of its original meaning due to the combination? Consider also that the MAVERICKS is translated literally as 小牛隊. Can the translation be used as evidence that MAVERICKS only means “little cows team” and should not oppose a competing basketball team from using RENEGADES? Conversely, COCA-COLA is transliterated phonetically as 可

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<sup>305</sup> *Dixi-Cola*, *supra* note 279 at 354-355.

<sup>306</sup> *Dixi-Cola*, *supra* note 279 at 359.

<sup>307</sup> *Dixi-Cola*, *supra* note 279 at 361.

<sup>308</sup> *Saint Honore*, *supra* note 91 at para 48.

□ 可樂. Although the English trademark originally focused on the meaning to refer to the product's ingredients, can the Chinese transliteration support a claim that it has evolved to focus just as much on the sound? Even though the English trademark could not block a competitor from selling PEPSI-COLA, can the Chinese transliteration help to oppose the American actress who is popular with Asian fans from selling CUOCO COLA?

Perhaps such a novel argument would carry more (or less) weight depending on how many (or few) other foreign-language equivalents are consistent with the Chinese-language mark in valuing the meaning vis-à-vis the sound. Since the current judicial application of the test for confusion requires evidence of linguistic knowledge, it would probably limit this novel argument only to foreign-language equivalents for which there is evidence that the consumers understand the language. However, if the test for confusion were to assume linguistic knowledge, then this novel argument would probably expand to accepting all foreign-language equivalents as evidence. Such an argument would be particularly interesting with the 1,073 trademark applications in Canada that contain the typographical symbol @.<sup>309</sup> Some languages translate @ as a variation of the English letter “a”, while other languages translate @ as a variation of the English word “at”. Most languages, however, translate @ according to how it looks to that culture: a little mouse, an elephant's trunk, a maggot, a snail, a spider monkey, a pickled fish roll, *etc.*<sup>310</sup>

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<sup>309</sup> “Search Criteria ‘@’ in Trademark”, Canadian Trademarks Database (last modified 22 June 2017), online: <<http://www.ic.gc.ca/app/opic-cipo/trdmrks/srch/home?lang=eng>>.

<sup>310</sup> Tom Chatfield, “How do you say @ in other languages?”, BBC (7 March 2016), online: <<http://www.bbc.com/future/story/20160307-how-do-you-say-in-other-languages>>.

#### **7.1.4 Prohibited Marks**

Section 12(1)(e) of Canada's *Trademarks Act* states that "a trademark is registrable if it is not a mark of which the adoption is prohibited by section 9 or 10."

An example of a prohibited mark is "any scandalous, obscene or immoral word or device".<sup>311</sup> Canada currently makes this value judgment from the perspective of the general public.<sup>312</sup> This is consistent with the United States denying FUKU to a Japanese restaurant trying to transliterate "good fortune" from Japanese to English,<sup>313</sup> as well as the United Kingdom denying FOOK on t-shirts.<sup>314</sup> Although Canadians are presumably bilingual enough to know that PHOQUE means "seal", the word still sounds scandalous in English. This may be a reason why the Canadian application for the French- and English-language mark PHOQUE EWE, despite the accompanying picture of a seal and a sheep, was abandoned.<sup>315</sup> This would probably mean similar denials for a Vietnamese restaurant using PHO KING, as only Vietnamese speakers or foodies would know "pho" is a type of noodle soup pronounced like "fir/fur".

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<sup>311</sup> *Trademarks Act*, *supra* note 19, s 9(1)(j) (**Prohibited marks** – "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 ... any scandalous, obscene or immoral word or device;").

<sup>312</sup> *Drolet*, *supra* note 274 at para 166; *Miss Universe, Inc v Bohna* (1991), 36 CPR (3d) 76 (TMOB), *aff'd* [1992] 3 FCR 682 (FCTD), *rev'd* on other grounds [1995] 1 FCR 614 (FCA). And see Canadian Intellectual Property Office, *Trademarks Examination Manual* (Ottawa: Innovation, Science and Economic Development Canada, 21 September 2017) at 4 of 5, online: <<https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr03636.html#iv.10>>. Section IV.10.6 states, "A scandalous word or design is one which is offensive to the public or individual sense or propriety or morality, or is a slur on nationality and is generally regarded as offensive. It is generally defined as causing general outrage or indignation. A word is obscene if marked by violations of accepted language inhibitions or regarded as taboo in polite usage. This word is generally defined as something that is offensive or disgusting by accepted standards of morality or decency; or offensive to the senses. A word or design is immoral when it is in conflict with generally or traditionally held moral principles, and generally defined as not conforming to accepted standard of morality." [emphasis added].

<sup>313</sup> Beth Hutchens, "It's Pronounce Foo Koo", IPWatchdog (8 May 2012), online: <<http://www.ipwatchdog.com/2012/05/08/its-pronounced-foo-koo/id=24687/>>.

<sup>314</sup> *Re Application No 2309350* (2004), O/133/04, *aff'd* O/182/05. Even though the case of *Re Registered Trade Mark No 2184549 (sub nom Dennis Wooman v French Connection Ltd)* (2005), O/330/05, *aff'd* O/137/06 later found FCUK not to be offensive, it also made the value judgment from the perspective of the general public at para 71 ("Finally, he held that it was clear from the evidence that FCUK was a brand directed at younger persons, who were less likely to be offended by the 'word play', but this was not a relevant consideration since the mark would be seen by people of all ages and backgrounds.").

<sup>315</sup> [Trademarks: PHOQUE. Abandoned. 1673343.](#)

The question is whether this value judgment should still be from the perspective of the general public when a trademark references a specific group. Canada kept the perspective of the general public when it permitted a restaurant's registration of THE RUDE NATIVE,<sup>316</sup> but the United States switched to the perspective of the specific group being referenced when it cancelled a football team's registration for REDSKINS<sup>317</sup> and originally denied a Chinese band's application for THE SLANTS.<sup>318</sup> The latter approach adopted by the United States raised the additional question of what to do if there are multiple and contradictory opinions within a specific group. For every Chinese person who believes that racial slurs such as THE SLANTS or CHINKED OUT can be reclaimed from their derogatory meanings, there is another Chinese person who would rather have them disappear forever. This was illustrated when Oprah Winfrey interviewed Jay-Z Carter about his use of the racial slur for African-Americans. Jay-Z defended his use on the basis that his generation took the power out of the racial slur, and he even rationalized that eliminating the racial slur will only result in others taking its place anyway. Oprah's response was that the horrific history of the word was beyond redemption in light of "the millions of people [in her generation] who heard that as their last word as they were hanging from a tree."<sup>319</sup>

Another question is whether either perspective should assume linguistic knowledge for a foreign-language mark? Consider a popular brand of toothpaste in Asia that is sold with the English word DARKIE and the Chinese characters for "black man". The toothpaste is now sold

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<sup>316</sup> *Rude Native Inc v Tyrone T Resto Lounge*, 2010 FC 1278, 195 ACWS (3d) 1128 (FCTD) was an infringement case where neither the defendant (nor the judge) challenged the registration as a prohibited mark.

<sup>317</sup> *Pro-Football, Inc v Amanda Blackhorse*, 112 F Supp (3d) 439 (ED Va 2015), appeal docketed, No 15-1874 (4th Cir, August 6, 2015) [*Pro-Football*].

<sup>318</sup> *Re Simon Shiao Tam*, 808 F (3d) 1321 (Fed Cir 2015), aff'd as *Matal v Tam*, 582 US \_\_ (2017), Docket No 15-1293 [*Re Simon*].

<sup>319</sup> Oprah Winfrey, "Oprah Interviews Jay-Z" (Oct 2009), *O Magazing* (blog), online at 8: <<http://www.oprah.com/omagazine/Oprah-Interviews-Jay-Z-October-2009-Issue-of-O-Magazine>>.

in Canada as DARLIE,<sup>320</sup> but with the same Chinese characters. The perspective of the general public would think nothing of the Chinese characters, but assuming linguistic knowledge would allow for a value judgment on the acceptability of “black man”. Likewise, the perspective of a specific group would not become an issue without first assuming linguistic knowledge. Since the registration for the Chinese characters included an explanation that they mean “black man”, it appears that Canada does not consider the term offensive to the specific group being referenced.<sup>321</sup>

All these questions may become moot if the prohibition on “any scandalous, obscene or immoral word or device” becomes unconstitutional. Canada could very well follow the Supreme Court of the United States in deciding that such a prohibition violates the constitutional right to free speech.<sup>322</sup> This is very likely in light of the fact that Canada prohibits both the registration and the use of such marks, whereas the United States prohibited only the registration and originally found that free speech was not infringed because traders could still use such marks.<sup>323</sup> Striking down such a prohibition would open the door for anyone and everyone to register marks that reference and offend a specific group. Perhaps there should be a distinction between those who “draw attention to their wares and service through shock tactics”<sup>324</sup> and those who have suffered such references and, thus, have a legitimate interest in reclaiming them from their derogatory meanings.

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<sup>320</sup> [Trademarks: DARLIE, Registered, 0627543, TMA375418](#); and [Trademarks: DARLIE MAN Logo, Registered, 1688144, TMA948291](#).

<sup>321</sup> [Trademarks: HEI REN IN CHINESE CHARACTER DESIGN, Registered, 0772976, TMA586312](#). Contrast that with Leigh Montville, *Sting Like A Bee: Muhammad Ali vs The United States of America* (New York: Doubleday, 2017) at 181-182 (“Dr. Martin Luther King in the keynote speech seemed to take a lesson from Ali’s presentations when he said that he had consulted an English language dictionary and found that 60 of 120 synonyms for the word “black” were offensive. All 124 synonyms for “white” were favorable. Maybe a new word for “black” should be applied to African Americans.”).

<sup>322</sup> *Re Simon*, *supra* note 318.

<sup>323</sup> *Pro-Football*, *supra* note 317.

<sup>324</sup> *Vaver*, *supra* note 21 at 482.



A second example of a prohibited mark is “any badge, crest, emblem or mark ... (ii) of any university, or (iii) adopted and used by any public authority”.<sup>325</sup> These prohibited marks are called official marks and are the nuclear bombs of all marks for three reasons. First, the test for obtaining them focuses on the applicant, not on the official marks. This means that any university or a Canadian public authority<sup>326</sup> can obtain an unlimited number of official marks that are descriptive, confusing with registered trademarks, and not limited by goods and services. Second, they only need to be advertised to come into effect, as they are neither trademarks nor registered. This means that these perpetual official marks are not subject to the usual prosecution, opposition, expungement, or renewal proceedings. Third, the requirement for them to be “adopted and used” is lower than that for a trademark to be “used” in association with goods and services, just as the prohibition against anything “consisting of, or so nearly resembling as to be likely to be mistaken for” them is stronger than that against anything “confusing” with a trademark. This means that these unlimited and perpetual official marks are easier to obtain and to enforce than trademarks. Accordingly, it is important to limit their monopoly to what was advertised in order to avoid their expansion automatically into translations. We must keep in mind that official marks can still prohibit translations in the same manner that they currently prohibit other trademarks: by proving similarity. The comment also applies to official marks in foreign languages.<sup>327</sup>

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<sup>325</sup> *Trademarks Act*, *supra* note 19, s 9(1)(n) (**Prohibited marks** – “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 ... 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.”).

<sup>326</sup> *United States Postal Service v Canada Post Corp*, 2007 FCA 10, 54 CPR (4th) 121, leave to appeal to SCC refused, 31906 (28 June 2007).

<sup>327</sup> The College of Traditional Chinese Medicine Practitioners and Acupuncturists of Ontario obtained three official marks in 2016: [Trademarks: CTCMPAO & Design, Advertised, 0922204](#), [Trademarks: CTCMPAO & Design, Advertised, 0923578](#), and [Trademarks: CTCMPAO & Design, Advertised, 0922205](#).

### **7.1.5 Plant Breeders' Rights Act**

Section 12(1)(f) of Canada's *Trademarks Act* states that "a trademark is registrable if it is not a denomination the adoption of which is prohibited by section 10.1." Section 10.1 in turn states that where "a denomination must, under the *Plant Breeders' Rights Act*, be used to designate a plant variety, no person shall adopt it as a trademark in association with the plant variety or another plant variety of the same species or use it in a way likely to mislead, nor shall any person so adopt or so use any mark so nearly resembling that denomination as to be likely to be mistaken therefor."

This means that The Coca-Cola Company could only register COCA-COLA because the hyphenated combination acquired secondary meaning to overcome the original lack of distinctiveness in the two components.<sup>328</sup> COCA was descriptive of the leaf extracts from the South American plant *erythroxylum coca*, which had the botanical term 古柯 (GU3 KE1). After COCA became part of COCA-COLA, it kept the English botanical meaning but changed the Chinese meaning to 可口 (KE3 KOU3 meant "tasty"). COLA was descriptive of the bean extracts from the Western African tree *cola acuminata* and *cola nitida*, which had the botanical term 可拉 (KE3 LA1). After COLA became part of COCA-COLA, it gained the additional English meaning of a "soft drink, pop, soda" and also changed the Chinese meaning to 可樂 (KE3 LE4 was distinctive in Chinese when first coined in 1933, but has come to mean "cola" and now lacks distinctiveness).

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<sup>328</sup> *Dixi-Cola*, *supra* note 279 at 357, 360 ("It will be perceived that in some of these earlier cases the Coca Cola Company, in answer to the charges made against its trade-name, successfully maintained the position that the name of the beverage was not deceptive, but was actually justified by the ingredients, while in the present case the company is endeavoring to show that the name is purely arbitrary and fanciful, and does not truly describe the nature of the product.") and ("With this rule in mind, we can realize the full significance of the evidence that the word "cola" was originally adopted in part for its descriptive properties, and has since become a generic term, used in common by manufacturers as part of the trade-names for their products;").

### **7.1.6 Geographical Indications**

Section 12(1)(g), (h), and (h.1) of Canada's *Trademarks Act* states that "a trademark is registrable if it is not in whole or in part a protected geographical indication, where the trademark is to be registered in association with [(g) a wine, (h) a spirit, or (h.1) an agricultural product or food]<sup>329</sup> not originating in a territory indicated by the geographical indication."

This is generally assessed by checking a Canadian list of wines, spirits, and agricultural product or food. Just like the difference between descriptive marks being barred in the English or French language versus generic marks being barred in any language, the list of geographical indications does not include translations for wines or spirits but only includes translations for agricultural products and food.<sup>330</sup>

Imagine that YANGTZE is on the list as a geographical indication. Should it automatically block subsequent applications for CHEUNG KONG or 長江? The answer is clearly "NO" if we consider what would happen if KENTUCKY was also on the list, as it would not block the standard translation KEN3 TA3 JI1 (肯塔基) for the geographical name. The reality is that we do not extend protection automatically from a geographical indication KENTUCKY to its acronym KY or to its nickname BLUEGRASS STATE. So why should we extend do it for its translation when Chapter 3 has shown that we cannot assume that a foreign-language mark is intended to be translated or what the translation will be?

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<sup>329</sup> While the statute currently limits geographical indications to a list of wines and spirits, the list will be expanded due to the Canada-Europe Union Comprehensive Economic and Trade Agreement (CETA). The expansion may be a welcome change for traders who have been circumventing the statute's limits by using certification marks as *de facto* geographical indications for the products that were not on the list (e.g., beer, cheeses, meats, confectionary and baked products).

<sup>330</sup> *Trademarks Act, supra* note 19, s 11.12(1) ("List – There shall be kept under the supervision of the Registrar a list of geographic indications and, in the case of geographical indications identifying an agricultural product or food, translations of those indications."). And see the corresponding subsections (2.1), (3.1), (4)-(5). Contrast "the automatic protection of translations" for wines and spirits in section 11.14 with "the limited-to-the-list protection of translations" for agricultural products or food in section 11.15.

### **7.1.7 Olympic and Paralympic Marks Act**

Section 12(1)(i) of Canada's *Trademarks Act* states that "a trademark is registrable if it is not subject to subsection 3(3) and paragraph 3(4)(a) of the *Olympic and Paralympic Marks Act*, a mark the adoption of which is prohibited by subsection 3(1) of that Act."

The inclusion of linguistic knowledge in the test for confusion does not make a difference because the *Olympic and Paralympic Marks Act* already states that no person "shall use in connection with a business, as a trademark or otherwise, a mark that is a translation in any language of an Olympic or Paralympic mark."<sup>331</sup> Contrast that with official marks, the prohibition of which does not anticipate translations. The question now is whether extending the prohibition of an Olympic or Paralympic mark to its foreign-language translation also prohibits similar foreign-language marks. After all, the *Olympic and Paralympic Marks Act* specifically prohibits the adoption or use of a mark that "so nearly resembles an Olympic or Paralympic mark as to be likely to be mistaken for it,"<sup>332</sup> but fails to do the same for its translation. Is this poor drafting or is this a clear sign that this prohibition supports comparing foreign-language marks for confusion based on the English or French translations of the trademark, instead of the foreign language used in the trademark?

## **7.2 Rights of (Limits/Defences to) Registration**

Up to now, the solutions proposed have been tested only against the criteria for registrability listed in section 12. It is also important to test them in the context of a trader's rights against infringement in sections 19-20, against depreciation of goodwill in section 22, to

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<sup>331</sup> *Olympic and Paralympic Marks Act*, SC 2007, c 25, s 3(2) [*Olympic Act*].

<sup>332</sup> *Olympic Act*, *supra* note 331, s 3(1).

license in section 50, and to translate. After all, the introduction of this dissertation acknowledged that their credibility depends on how well they serve the dual purposes of trademark law in protecting the consumer from confusion and the trader from unfair competition.

Consumers usually have no participation in or say on a trademark, although they are used (or mis-used) by traders as the justification supporting its litigation. It is difficult to believe that a trader's rights also benefit consumers when one looks at the contradictory arguments in the case law. For example, one trader will argue that the trademarks are confusing while the other trader will argue the opposite,<sup>333</sup> just as one passenger will recline the airplane seat while the passenger behind will object to it.<sup>334</sup> Focusing on the resource (trademark space or seat space) does not benefit consumers, who become schizophrenic puppets dancing at the behest of traders. Focusing instead on the parties vying for the resource can change the answer by redefining the question: do traders infringe while objecting to others infringing? Or, do passengers recline while objecting to others reclining?<sup>335</sup>

Why is it that traders can engage in brand extension or cross-branding themselves in order to access untapped markets, yet they are convinced that others will cannibalize existing

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<sup>333</sup> Beebe, *supra* note 7 at 2025.

<sup>334</sup> Christopher Buccafusco & Christopher Jon Sprigman, "Who Deserves Those 4 Inches of Airplane Seat Space?", *Slate* (23 Sept 2014), online: [http://www.slate.com/articles/health\\_and\\_science/science/2014/09/airplane\\_seat\\_reclining\\_can\\_economics\\_reveal\\_who\\_deserves\\_the\\_space.html](http://www.slate.com/articles/health_and_science/science/2014/09/airplane_seat_reclining_can_economics_reveal_who_deserves_the_space.html).

<sup>335</sup> Consider the beloved American novel "To Kill A Mockingbird". While several law articles have lauded the protagonist, Atticus Finch, the best praise is found in Steven Lubert, "Review: Reconstructing Atticus Finch: To Kill a Mockingbird by Harper Lee" (1999) 97:6 *Mich L Rev* 1339 at 1339 ("The name of Atticus Finch has been invoked to defend and inspire lawyers, to rebut lawyer jokes, and to justify (and fine-tune) the adversary system. Lawyers are greedy. What about Atticus Finch? Lawyers only serve the rich. Not Atticus Finch. Professionalism is a lost ideal. Remember Atticus Finch."). Focusing on Atticus Finch vis-à-vis other lawyers makes him a hero: only he had the integrity to defend a black man wrongly accused of raping a white woman, and only he had enough faith in the justice system to encourage the black defendant to stand trial and to appeal a biased verdict instead of making a run for freedom. Focusing instead on Atticus Finch vis-à-vis himself reveals his hypocrisy: he failed to exercise the same level of integrity when the town's recluse later protects his children by killing their attacker in self-defense, as he accepted the sheriff's persuasion that it would be too cruel to subject the town's recluse to legal scrutiny and public attention. Only by redefining the question does the answer change as to whether Atticus Finch is a hero or a hypocrite: the lawyer, who earlier encouraged an innocent defendant to entrust life and liberty to a racist jury, later spared the town's recluse from the inconvenience of a trial that was sure to end in an acquittal.

sales instead of creating new markets? An example of this hypocrisy is margarine. When Emperor Louis Napoleon III held a competition to find an affordable butter alternative for his military and the poor, he awarded the prize to margarine in 1869. It turned out that winning a competition does not guarantee market success, because the French peasants turned up their noses at margarine as a butter substitute. The former was made from vegetable oil and had a pale white colour, while the latter was made from milk and had a sunnier complexion from happy cows. Nevertheless, North Americans were convinced that this French invention would cannibalize the sale of butter and lobbied for legislation to stop the anticipated confusion between the two. The United States tried a piece-meal approach such as compulsory labelling, manufacturing licensing, sales tax, and colour bans. The colour bans ranged from prohibiting the margarine to be dyed yellow to look like butter (which was also dyed yellow) to requiring that margarine be dyed pink.<sup>336</sup> Canada took an aggressive approach<sup>337</sup> by banning margarine from 1886 to 1948, a year that marked two notable events. First, Newfoundland joined the Canadian Confederation on the condition that “Canada agreed to constitutionally protect the manufacture and sale of margarine in Canada, but retained its powers to prohibit and/or restrict the export of margarine from the new province.”<sup>337</sup> Then, the Supreme Court of Canada decided that federal legislation could not prohibit the manufacture or sale of margarine. Although it remained within federal jurisdiction to prohibit the importation of margarine, that applied to foreign trade and not

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<sup>336</sup> Mitchell Okun, *Fair Play in the Marketplace: The First Battle for Pure Food and Drugs* (Dekalb, Ill.: Northern Illinois University Press, 1986) at 254, 263, 266.

<sup>337</sup> *Royal Commission on Renewing and Strengthening our Place in Canada* (St. John’s: Office of the Queen’s Printer, 30 June 2003) at 17, online: <<http://www.gov.nl.ca/publicat/royalcomm/section2.pdf>>. I was puzzled as to why Newfoundland would agree to have its right to sell margarine to the greater Canadian population restricted until I fortuitously happened upon Carmen Reinhart & Kenneth Rogoff, *This Time is Different: Eight Centuries of Financial Folly* (United Kingdom: Princeton University Press, 2009) at 82-83 (“By 1932, interest payments alone absorbed the lion’s share of [Newfoundland’s] revenues. A default seemed inevitable. Technically (and it was only technically) Newfoundland did not default. As David Hale observes: ‘... The British parliament and the parliament of a self-governing dominion agreed that democracy should be subordinate to debt. The oldest parliament in the British Empire, after Westminster, was abolished and a dictatorship was imposed on 280,000 English-speaking people who had known seventy-eight years of direct democracy. The British government then used its constitutional powers to steer the country into a federation with Canada.’”).

to Newfoundland as part of Canada.<sup>338</sup> There is no literature explaining why the United States was surprisingly milder in its approach than Canada, but perhaps the American belief in free markets restrained an outright ban and resulted in surreptitious legislation.

Another example of this hypocrisy is coffee. While we might expect that tea traders would perceive a threat from coffee, this was not the case. Even stranger is the historical evidence that it was actually the wine and beer traders who tried to stop competition from coffee.<sup>339</sup> This is puzzling until we realize that what matters is not any and all traders, but a specific group of traders who are also producers: tea traders in Europe did not perceive a threat because they imported tea from China, but wine traders in France and Italy tried to protect their country's industry, as did beer traders in Germany. Perhaps it was a sign of the times, but these wine and beer traders did not rely on legal prohibition as much as on moral judgment: France translated Olearius' travelogue to warn against the evils of coffee, Italy would have declared coffee as Satanic if Pope Clement VIII had not found it to be delicious, and King Frederick II claimed that German soldiers who drank coffee were unpatriotic because they could not win wars like beer drinkers.<sup>340</sup>

The hypocrisy becomes even more obvious when we compare traders' past behaviour vis-à-vis their current lawsuits. For example, The Coca-Cola Company claimed descriptiveness in 1905 in order to benefit from a then-existing provision "which permits the registration of a descriptive mark by one who has made actual and exclusive use thereof for ten years next preceding the approval of the act."<sup>341</sup> After receiving its registration, it then tried to claim

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<sup>338</sup> *Reference re Validity of Section 5(a) Dairy Industry Act*, [1949] SCR 1, aff'd [1950] UKPC 31.

<sup>339</sup> Calestous Juma, *Innovation and Its Enemies: Why People Resist New Technologies* (New York: Oxford University Press, 2016) at 61-62.

<sup>340</sup> Bennett Weinberg & Bonnie Bealer, *The World of Caffeine: The Science and Culture of the World's Most Popular Drug* (New York: Routledge, 2002) at 67-68, 85-86.

<sup>341</sup> *Dixi-Cola*, *supra* note 279 at 356.

distinctiveness in order to sue competitors such as PEPSI-COLA for confusion.<sup>342</sup> Likewise, a trader unsuccessfully tried to claim that YO-YO was descriptive in 1931 in order to overcome a competitor's registration of FLORES YO-YO.<sup>343</sup> After purchasing FLORES YO-YO and registering YO-YO, it then claimed distinctiveness in order to sue competitors for confusion.<sup>344</sup> In short, traders use the case law to litigate their claims against others in order to stop what they perceive as unfair competition against themselves.

The subsections below discuss the growing gap between traders and consumers as a result of dilution and licensing, and we must beware not to widen it further through foreign-language marks. In this regard, the solution of assuming linguistic knowledge serve the dual purposes of trademark law in protecting the consumer from confusion and the trader from unfair competition.

### **7.2.1 Right against Infringement**

Trademarks have come a long way from past characterizations as a liability instead of an asset,<sup>345</sup> as identifying source only instead of guaranteeing quality also,<sup>346</sup> and as protecting

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<sup>342</sup> *Coca-Cola Company of Canada Limited v Pepsi-Cola Company of Canada Limited*, [1942] 1 All ER 615 [*Pepsi-Cola*]. And see *Dixi-Cola*, *supra* note 279 at 357 (“It will be perceived that in some of these earlier cases the Coca Cola Company, in answer to the charges made against its trade-name, successfully maintained the position that the name of the beverage was not deceptive, but was actually justified by the ingredients, while in the present case the company is endeavoring to show that the name is purely arbitrary and fanciful, and does not truly describe the nature of its product.”).

<sup>343</sup> *Royal Tops*, *supra* note 279 at paras 24-25, 27 (When the application YO-YO was blocked by the registration FLORES YO-YO, the applicant argued that YO-YO was descriptive. This led the court to comment, “Thus, not only did the applicant recognize that ‘Yo-Yo’ was then in use in the Philippines as the name applied to a toy, but also the probability that it was a generic term incapable of exclusive appropriation.”).

<sup>344</sup> *Royal Tops*, *supra* note 279 at para 22 (“[Plaintiff argues] that trademarks are presumed to be valid. In this connection plaintiff also places much reliance upon a contention that ‘Yo-Yo’ is an arbitrary mark, a word which originated with [plaintiff] and coined by him. No finding was made by the trial court on this point and, for reasons subsequently shown, we think the contention is fallacious.”).

<sup>345</sup> Schechter, *supra* note 6 at 814 (15<sup>th</sup> Century England required trademarks “so that defective work might be traced to the guilty craftsman and heavily punished, or that ‘foreign’ goods smuggled into an area over which the guild had a monopoly might be discovered and confiscated.”).

<sup>346</sup> Sheldon Burshtein, “Trademark Licensing in Canada: The Control Regime Turns 21” (2014) 104:5 INTA Trademark Reporter 1001 at 1005. (“In Canada, a trademark is a guarantee of origin and is only inferentially an



consumers primarily instead of traders equally.<sup>347</sup> The dual purposes of trademark law now are to protect consumers from confusion and traders from unfair competition.<sup>348</sup> This requires that a trademark functions to identify the source (and quality) of goods and services.<sup>349</sup>

Section 19 of Canada's *Trademarks Act* prohibits using a trademark that is identical with goods and services that are identical to a registration.<sup>350</sup> Section 20 expands that to prohibit using a trademark that is similar, regardless of the goods and services, to a registration.<sup>351</sup> There is little to say here because the solutions proposed for registrability in section 12 should be applied in exactly the same manner to infringement in sections 19-20. The subsections below discuss three problems that currently exist with infringement – and are exacerbated with dilution – when deciding whether or not to expand rights even more by allowing traders to claim that a foreign-language mark is identical or similar to a registered trademark.

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assurance of quality. Similarly, a House of Lords decision said that, in England, a trademark is not a representation of quality. In the United States, a trademark represents a single source but has also been said to serve as an assurance of quality.”).

<sup>347</sup> *GA Hardie & Co v Canada (Registrar of Trade Marks)*, [1949] SCR 483 at para 64 (20<sup>th</sup> Century Canada repeated “[t]hat the interest of the public is always important was emphasized in this Court upon a somewhat different point in *Lightning Fastener Co. Ltd. v. Canadian Goodrich Co. Ltd.*, [1932] S.C.R. 189, where Rinfret J., (now Chief Justice) stated at p. 196: ‘and it should not be forgotten that legislation concerning patents, trademarks and the like exists primarily in the interest and for the protection of the public, so much so that it could be said that the public is a third party to all patent or trademark litigation.’”).

<sup>348</sup> Schechter on *The Historical Foundations*, *supra* note 25 at 20-21.

<sup>349</sup> Schechter, *supra* note 6 at 813-814 (“The orthodox definition of “the primary and proper function of a trade-mark” is that given by the Supreme Court of the United States in the leading case of *Hanover Star Milling Co. v Metcalf*: “to identify the origin or ownership of the goods to which it is affixed.”).

<sup>350</sup> *Trademarks Act*, *supra* note 19, s 19 (**Rights conferred by registration** – “Subject to sections 21, 32 and 67, the registration of a trademark in respect of any goods or services, unless shown to be invalid, gives the owner of the trademark the exclusive right to the use throughout Canada of the trademark in respect of those goods or services.”).

<sup>351</sup> *Trademarks Act*, *supra* note 19, s 20(1) (**Infringement** – “The right of the owner of a registered trademark to its exclusive use shall be deemed to be infringed by a person not entitled to its use under this Act who (a) sells, distributes or advertises any goods or services in association with a confusing trademark or trade-name; (b) manufactures, causes to be manufactured, possesses, imports, exports or attempts to export any goods in association with a confusing trademark or trade-name, for the purpose of their sale or distribution, (c) sells, offers for sale or distributes any label or packaging, in any form, bearing a trademark or trade-name if ... (d) manufactures, causes to be manufactured, possesses, imports, exports or attempts to export any label or packaging, in any form, bearing a trademark or trade-name, for the purpose of its sale or distribution or for the purpose of the sale, distribution or advertisement of goods or services in association with it, if ...”).

### **7.2.1.1 Rights without End**

The first problem is that Canada's *Trademarks Act* has 10-year terms that can be renewed without end, unlike copyright and patents. This means that the rights are perpetual as long as the trademark is used, however lightly.<sup>352</sup> Giving a perpetual right to a word is one thing; giving a perpetual right to a word, its synonyms, and its translations would be another. We must ask ourselves what is the public interest in doing the latter when the Supreme Court of Canada – commenting on BARBIE – observed that a novel benefit is not even required in exchange for the monopoly: “[Mattel] has merely appropriated a common child’s diminutive for Barbara.”<sup>353</sup>

A possible solution is to accept the fact that not every use must be valued or owned. This will leave some uses to the public: “Thus, it should be emphasized that expressive concerns could be equally well protected by simply cutting back on the scope of trademark law. Signaling capacity could, for example, be fully protected by insuring exclusivity in words and symbols only as they appear on labels. So long as the public understood that the label (as statutorily defined) was the only place to look for a designation of source or origin, trademarks could be made freely available for all other purposes.”<sup>354</sup>

A labour-based justification for trademark rights may accept the solution above. This justification came from a Lockean natural rights theory that one is entitled to the fruits of one’s labour, on the conditions that the entitlement (1) leaves enough and as good for others, and (2) is not wasteful.<sup>355</sup> This entitlement suggests that traders cannot assume that they create all the value

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<sup>352</sup> Vaver, *supra* note 21 at 547 (“Registrants are not readily deprived of their ‘property’, however lax they may have been in creating or maintaining it. Light use of the mark – even a genuine single use or a use that tests the market – may save the registration.”)

<sup>353</sup> *Mattel*, *supra* note 99 at para 21.

<sup>354</sup> Rochelle Dreyfuss, “Expressive Genericity: Trademarks as Language in the Pepsi Generation” (1989) 65 *Notre Dame L Rev* 397 at 399, n 14 [Dreyfuss].

<sup>355</sup> Peter Drahos, *The Philosophy of Intellectual Property* (Aldershot: Dartmouth Publishing Company Ltd, 1996) at 42-43 (“Locke’s solution to the problem of the God-given commons and private appropriation starts with the assumption that ‘every Man has a Property in his own Person’. This assumption leads Locke to claim that an

in their trademarks because there is scholarship to suggest that consumers also invest in trademarks,<sup>356</sup> especially at the encouragement of trademark owners in this day and age of social media.<sup>357</sup> Consider the examples where originally it was not the trader who used “its” trademark, but a news reporter who created the Chinese translation for JORDAN or the government who invested in Chinese translations for TRUMP. These examples are different from The Coca-Cola Company holding an international competition to find “its” Chinese-language mark. A corollary to the entitlement is that one should not reap where one has not sown. This can be a double-edged sword for traders, as the Supreme Court of Canada has affirmed Professor Vaver’s observation that “One might as well say that the well-known mark owner is reaping where it has not sown when it stops a trader in a geographic or market field remote from the owner’s fields from using the same or a similar mark uncompetitively.”<sup>358</sup> The first condition suggests that traders cannot assume that they are entitled to foreign-language equivalents of their trademarks. Consider a reverse example of this assumption: subsection 5.1.2 on “Comparing for Confusion” explained how a court finding that PEPSI-COLA did not infringe COCA-COLA (because COLA was descriptive in English) led to the incorrect conclusion that 百事可樂 also did not infringe 可口可樂 (even though the Chinese equivalent was descriptive when first coined in 1933). Therefore, since a trademark claim does not automatically expand into claims for its synonyms or homophones, subject to evidence of confusion, an English-language mark should also be independent of its translations or transliterations. The second condition reinforces the suggestion

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individual’s labour also belongs to that individual. ... The first [condition] states that labour only originates a property right to the object to which it is joined ‘where there is enough, and as good left in common for others’. The second [condition states] ... ‘As much as any one can make use of to the advantage of life before it spoils; so much he may by his labour fix a Property in.’”) [Drahoš].

<sup>356</sup> Steven Wilf, “Who Authors Trademarks?” (1999) 17 *Cardozo Arts & Ent LJ* 1.

<sup>357</sup> Gerhardt, *supra* note 12.

<sup>358</sup> *Mattel*, *supra* note 99 at para 22, quoting David Vaver, “Unconventional and Well-Known Trade Marks”, (2005) *Sing JLS* 1 at 16.

that traders cannot assume that they are entitled to foreign-language equivalents of their trademarks. Locke already recognized in the 17<sup>th</sup> Century that the second condition has little use in a society where individuals are able to store wealth (*e.g.*, money), so just imagine the uselessness of the second condition in a society where corporations are able to amass wealth (*e.g.*, trademarks) faster and longer than individuals. In noting the inconsistency of the second condition, which would permit the hoarding of non-perishable stocks but not the wasting of perishable plums, Professor Drahos commented that Locke “glides over the connections between property, wealth, political and social power and the implications of this for a theory like his which claims that men are naturally equal and have a natural right to property.”<sup>359</sup> Locke could have addressed the inconsistency by stating that the entitlement is conditional on being useful *at and continuously after* the time of taking, instead of being useful *before* it spoils.<sup>360</sup> Such a philosophical theory would align better with the trademark doctrine, as even first-to-file trademark countries require that a trademark be used (eventually) in order to maintain a registration.

An unjust enrichment-based justification for trademark rights will reject the solution above. This justification came from an Aristotelian corrective justice theory that one should not be enriched at the expense of another.<sup>361</sup> This theory could be a reason why traders often assume that “free riding” is a wrong that needs a remedy. Consider again the examples where originally it was not the trader who used “its” trademark, but a news reporter who created the Chinese

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<sup>359</sup> Drahos, *supra* note 355 at 43.

<sup>360</sup> As a Christian philosopher whose theory was premised on the existence of God, surely Locke was aware of the Parable of the Talents from the Bible: A servant was entrusted with talents when his master went on a journey. The servant buried the talents in the ground and returned it upon the master’s return. He was rebuked for being wicked and lazy even though the talents were all accounted for and even though digging a hole to bury and to retrieve the talents was more work than depositing the talents at the bank.

<sup>361</sup> Spyros Maniatis & Anselm Kamperman Sanders, “A consumer trade mark: protection based on origin and quality” (1993) 15:11 Eur IP Rev 406 at 124 (“To enrich oneself at the expense of another is considered to be sinful. The recipient can redeem himself by restoring the natural order to what it was before by giving back what he has gained and thus rectifying his wrongdoing, resulting in absolution.”) [Maniatis & Sanders].

translation for JORDAN or the government who invested in Chinese translations for TRUMP. But is it not unjust for these traders to enrich themselves with the translations at the expense of society? If the rebuttal is that there is no injustice because society's use of the translations was not *use as a trademark*, then the translations would be available to all as a potential trademark. This means that the first "free rider" to enrich itself with the translations as trademarks did not do so at the expense of the "rightful owner" of JORDAN or TRUMP. If the rebuttal is that the "free rider" is co-opting some sort of association with the "rightful owner", then corporations should also be prohibited from co-opting social causes without compensating the charities and non-profit organizations that started the social campaigns. This theory could also be a reason why traders assume that there should be compensation for using what is assumed to be foreign-language equivalents of their trademarks. But what (if any) should the compensation be? Imagine a poor man who has nothing to eat but plain bread on a daily basis. Asked by a neighbour if he ever tired of his poverty, the man replied that he enjoyed each mouthful of plain bread with a deep sniff of the fragrant cooking from the restaurant next door. Overhearing this, the restaurant owner took the poor man to court and demanded to be paid the value of "sniffing the food". The wise judge agreed, grabbed the restaurant owner's ear and rewarded him with the value of "hearing the coins"!

A personality-based justification for trademark rights will reject the solution above. This justification came from a Hegelian natural rights theory that expressing one's will is fundamental to exercising one's freedom.<sup>362</sup> Although traders cannot assume entitlement, this theory explains why traders may nevertheless need to claim the foreign-language equivalents of their trademarks.

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<sup>362</sup> Drahos, *supra* note 355 at 77-78 ("The underlying reality is that 'property is the first embodiment of freedom'. ... One suggestion has been that private property is the institution which allow the exercise of subjective freedom, ... Another is that the making of property claims contributes to the development of personality. ... Good for Hegel is 'freedom realized, the absolute end and aim of the world.'").

Consider the example of Michael Jordan. What if he had political objections to the Chinese translation created by the news reporter for JORDAN, because he feared that the meaning of “tall – red” evoked a negative image of him standing tall for red Communism? Although it may be objectionable for corporations to claim personality rights, Pfizer and The Coca-Cola Company are still useful as illustrations. What if Pfizer had moral objections to the Chinese translation given by the public to VIAGRA, because it was repulsed by the incestuous meaning of “great brother”? Before coming up with its winning Chinese translation for COCA-COLA, what recourse would The Coca-Cola Company have had to stop unflattering Chinese translations such as the random “female horse stuffed with wax” or “bite the wax tadpole”?

An incentive-based justification for trademarks will reject the solution above. This justification came from Landes’ and Posner’s economic theory that legal protection for reducing search costs<sup>363</sup> – and increasing words<sup>364</sup> – is the incentive for doing so in the first place. (It should be noted that Dreyfuss disagreed that traders need incentives.<sup>365</sup>) This theory explains again why traders may need to claim the foreign-language equivalents of their trademarks. Consider the example of The Coca-Cola Company. Allowing multiple Chinese translations such as the random “female horse stuffed with wax” or “bite the wax tadpole” would increase search costs; whereas, creating the winning Chinese translation for COCA-COLA benefitted consumers looking for the product and benefitted society by enriching the Chinese language.

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<sup>363</sup> William Landes & Richard Posner, “The Economics of Trademark Law” in *The Economic Structure of Intellectual Property Law* (Cambridge, Mass: Bellnap Press, 2003) at 168 (“The benefits of trademark in lowering consumer search costs presuppose legal protection ... If the law does not prevent it, free riding may destroy the information capital embodied in a trademark, and the prospect of free riding may therefore eliminate the incentive to develop a valuable trademark in the first place.”) [Landes & Posner].

<sup>364</sup> Landes & Posner, *supra* note 363 at 169 (“Trademarks improve the language in three ways. They increase the stock of names of things, thus economizing on communication and information costs in the ways suggested. They create new generic words – words that denote entire products, not just individual brands. Trademarks further enrich language by creating words or phrases that people value for their intrinsic pleasingness as well as their information value, ...”).

<sup>365</sup> Dreyfuss, *supra* note 354 at 399 (“... free ridership on the commercial aspect of marks is not a problem [with respect to expressive uses of trademarks] and besides, there is little need to create economic incentives to encourage businesses to develop a vocabulary with which to conduct commerce.”).

### **7.2.1.2 Rights without Exceptions**

The second problem is that Canada's *Trademarks Act* generally has no explicit exceptions, again unlike copyright and patents. Users such as competitors, consumers, or citizens are expected to know the internal limits to trademark rights means that there is no infringement unless there is (1) use *in association with goods and services* according to section 4, and (2) use *as a trademark* according to section 2.<sup>366</sup> Is it reasonable to expect users to understand a limit/defence that legal experts struggle with? Consider the fact that “[m]any commentators and courts have misunderstood the difference between use *as a trademark* and trademark use.”<sup>367</sup> Even when limited exceptions are explicit,<sup>368</sup> users are expected to keep calm and carry on with the limited defences when served with a cease-and-desist letter threatening civil and criminal liability.<sup>369</sup> Unfortunately, many trademark applicants and letter recipients lack the financial

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<sup>366</sup> *Compagnie Générale des Établissements Michelin-Michelin & Cie v. National Automobile, Aerospace, Transportation and General Workers Union of Canada (CAW-Canada)* (1996), [1997] 2 FCR 306, 71 CPR (3d) 348 (FCTD) at 360 (“The test for “use” in Section 20 requires two separate elements of proof from both Section 2 and Section 4. In effect, the first element taken from Section 4 is: (1) did the Defendants associate their services with the Plaintiff’s trademarks? The second element from Section 2 is: (2) did the Defendant use the marks as a trademark for purposes of distinguishing or identifying the Defendant’s services in connection with the Plaintiff’s wares or services?”), at 364-365 (“‘Use’ is the foundation for Section 19, Section 20 and Section 22 as grounds of infringement but the secondary elements for each ground once the primary ‘use’ has been established are different. Section 19 requires use of the identical mark for identical wares and services while Section 20 states that the mark need only be ‘confusing’ and not identical to the registered mark. Section 22 is even more open-ended since the mark need not even be confusing as long as its use is likely to depreciate the value of the goodwill: ... The grounds for infringement move from their narrowest in Section 19 to their most expansive in Section 22 but ‘use’ remains the basic building block or linchpin for all of the grounds.”) [*Compagnie Générale des Établissements Michelin*].

<sup>367</sup> Kelly Gill et al, *Fox on Canadian Law of Trademarks and Unfair Competition*, 4th ed (Toronto: Carswell, 2002) at 7.2(d)(ii) [Gill].

<sup>368</sup> *Trademarks Act*, *supra* note 19, s 20 contains exceptions for any *bona fide* use at (1.1), any utilitarian feature at (1.2), and a spirit at (2).

<sup>369</sup> Imagine how frightened lay defendants must be by threats against themselves if even White House witnesses are frightened by subpoenas regarding third parties according to Chris Whipple, *The Gatekeepers: How the White House Chiefs of Staff Define Every Presidency* (New York: Crown, 2017) at 212 (“This was really a burden on many [White House staff], the first time they had interacted with a prosecutor or with the criminal justice system, and they were scared ... You could always tell a member of the [White House] staff who had gotten a subpoena [for Bill Clinton’s impeachment hearing].”).

resources for a legal opinion on the merits of such threats. Although such humble worries rarely make the news, we must pay attention to their unnecessary frequency.<sup>370</sup>

It is understandable that traders with little understanding of the law may be overzealous in frightening other trademark applicants and users. Their lawyers, however, should be the voice of reason. Despite the fiduciary duty that lawyers owe their clients,<sup>371</sup> is it reasonable to expect lawyers to self-monitor against four potential conflicts of interests? First, what if the lawyer is tempted by the financial rewards of easy billing that comes from issuing cease-and-desist letters?<sup>372</sup> Second, what if the lawyer is desirous of the professional opportunities provided by increased publicity that comes from court litigation? Third, what if the lawyer is worried about client attrition for not creating-and-solving problems that maintain client dependency on the prescient-and-powerful lawyer? Finally, what if the lawyer is afraid of professional liability because what was reasonable at the time suddenly looks negligent after a problem arises? Consider the example of Metallica, the band that sued Napster for copyright infringement and

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<sup>370</sup> Roger Hughes, “Emergent Diversity in the Common Law Relating to Intellectual Property” in Catherine Ng, Lionel Bently & Giuseppina D’Agostino, eds, *The Common Law of Intellectual Property: Essays in Honour of Professor David Vaver* (United Kingdom: Hart Publishing Ltd, 2010) at 125 (“We are quick to recognize the contributions of the Supreme and Appellate Courts, as well as those of reputable academics such as Professor David Vaver, in defining and reshaping the courses of the common law. However, one must not lose sight of our ‘friends in low places’, where it all begins. Cases brought in the courts are shaped by the practice and procedures in those courts and the remedies there afforded. The day-to-day determination of disputes goes unnoticed, leaving academia to ponder the rare cases brought and defended by the richer and more determined of our litigants.”).

<sup>371</sup> *Strother v 3464920 Canada Inc*, 2007 SCC 24 at para 1 (“A fundamental duty of a lawyer is to act in the best interest of his or her client to the exclusion of other adverse interests, except those duly disclosed by the lawyer and willingly accepted by the client. ... Fiduciary responsibilities include the duty of loyalty, of which an element is the avoidance of interest, ...”), at para 35 (“Nonetheless, I appreciate that the legal profession has gotten away with inherent conflicts of interest. Compare its insistence that the traditional relationship between solicitor and client meant that the legal profession must be exempted from the *Proceeds of Crime (Money Laundering) and Terrorist Financing Act*, SC 2000, c 17 in order to uphold solicitor-client privilege to its surreptitious change of that same traditional relationship by permitting limited liability partnerships without explaining to clients that the law partners are no longer jointly and severally liable for solicitor malpractice, thereby shifting the risk to clients and insurers. See *Canada (AG) v Federation of Law Societies of Canada*, 2015 SCC 7 and Philip Slayton, *Lawyers Gone Bad* (Toronto: Penguin Group (Canada), 2007) at 17-19 respectively”) [Slayton].

<sup>372</sup> Slayton, *supra* note 371 at 8-9 (“Over docketing is tolerated, if not encouraged, by firms that value profit above all else and set unrealistic billing goals for their partners and associates. ... Out-and-out cheating about the number of hours worked is only the half of it. Billing by the hour, whether a lawyer is lying or not, creates bad incentives and encourages unprofessional behavior. The longer it takes a lawyer to solve his client’s problem, the greater his income.”).



threatened a Canadian cover band with a cease-and-desist warning that was 41 pages too long.<sup>373</sup> When the warning led to a public uproar, Metallica blamed it on an overzealous lawyer who acted without the band's knowledge. It is overzealous indeed for a lawyer to do so much work without any client authority – with no likelihood of bill payment and every certainty of professional liability.

A possible solution is to have Canada's *Trademarks Act* articulate the general principle that trademark rights are an exception to the public use of words. This should be reinforced by also articulating specific limits to trademark rights.<sup>374</sup> Defences are already legislated for trademarks in the United States<sup>375</sup> and already added for copyright in Canada.<sup>376</sup> This would help traders whose fears of genericide lead to claims of a duty to police their trademarks, as they probably need statutory repudiation of the existence of such a duty.<sup>377</sup> Such a general principle and specific limits might have protected a professor collecting consumer complaints against

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<sup>373</sup> Mike Masnick, "Metallica Sends 41 Page Legal Threat to Canadian Cover Band [Updated]", Techdirt (14 Jan 2016), online: <<https://www.techdirt.com/articles/20160113/13005233336/metallica-sends-41-page-legal-threat-to-canadian-cover-band-updated.shtml>>.

<sup>374</sup> Carys Craig, "Perfume by Any Other Name May Smell as Sweet ... But Who Can Say?: A Comment on *L'Oreal v Bellure*" (2010) 22 IPJ 321 at 333-334 ("In Canadian trademark law there is, for example, no exception to liability for the fair use of a protected mark. The doctrinal limits of trademark protection (such as the need for a plaintiff to establish confusion in the marketplace, or the inability to control non-commercial or non-trademark uses) typically do a decent job of drawing the boundaries around the registered owner's rights.") [Craig].

<sup>375</sup> *Lanham Act 1946*, 15 USC, c 22, § 1115(b)(4).

<sup>376</sup> *Copyright Act*, RSC 1985, c C-42, s 29.

<sup>377</sup> Gary Locke, United States Secretary of Commerce, *Report to Congress: Trademark Litigation Tactics and Federal Government Services to Protect Trademarks and Prevent Counterfeiting*, United States Patent and Trademark Office (27 April 2011), online: <[https://www.uspto.gov/ip/TMLitigationReport\\_final\\_2011April27.pdf](https://www.uspto.gov/ip/TMLitigationReport_final_2011April27.pdf)>. Page 14 of the report perpetuates the myth that traders have a duty to police, but does not provide any statutory basis for this even though registered trademarks are a creature of statute: ("In view of the mark owner's obligation to police violations, aggressive enforcement of one's trademark rights does not automatically equate to abuse or bullying."). Page 6 of the report incorrectly claims that YOYO's registration was lost due to genericide, when the registration was actually invalidated: ("Conversely, if a trademark owner does not diligently police proper use of its mark (e.g., by competitors, the public, and the media), a term that is originally coined and thus inherently the strongest type of trademark, can become generic and fall into the public domain. The trademark landscape is littered with distinctive terms that were once registered as trademarks, but became generic, including 'cellophane' for a transparent wrapping, 'escalator' for moveable staircases, 'trampoline' for a rebound tumbler, and 'yo-yo' for a spinning toy on a string."). See *Royal Tops*, *supra* note 279 at paras 24-25, 27 (When the application YO-YO was blocked by the registration FLORES YO-YO, the applicant argued that YO-YO was descriptive. This led the court to comment, "Thus, not only did the applicant recognize that 'Yo-Yo' was then in use in the Philippines as the name applied to a toy, but also the probability that it was a generic term incapable of exclusive appropriation.").

United Airlines on [www.untied.com](http://www.untied.com), as the Federal Court of Canada ruled against him on the basis that “parody and satire are not defences to trademark infringement”.<sup>378</sup> On the other hand, the existence of such defences in the United States did not protect a satirist who poked fun at PETA (People for the Ethical Treatment of Animals) with a website for People Eating Tasty Animals on [www.peta.org](http://www.peta.org), where a court stringently decided that the parody needed to be conveyed immediately via the website’s domain name instead of being conveyed later via the website’s content.<sup>379</sup>

Another possible solution is to rely on a constitutional defence, such as Canada’s freedom of expression<sup>380</sup> and the United States’ freedom of speech.<sup>381</sup> Professors Craig and Scassa have cautioned that the many social costs of expanding trademark rights outweigh the one benefit to traders, as constitutional rights may be harmed.<sup>382</sup> Professor Vaver warned against burdening the court system unnecessarily with undergoing such constitutional analysis.<sup>383</sup> Courts themselves seem reluctant to adjudicate such trademark matters.<sup>384</sup> Most importantly, the public does not understand a constitutional defence and regular Canadians cannot readily assess for themselves if their actions are legitimate, or are ripe for liability as often claimed by trademark owners in cease-and-desist letters.

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<sup>378</sup> *Cooperstock*, *supra* note 35 at para 83.

<sup>379</sup> *People for the Ethical Treatment of Animals v Doughney*, 263 F (3d) 359 (4th Cir 2001) at 366. The same court, however, later distinguished the test for parody from the test for confusion in stating that the latter “must evaluate an allegedly infringing domain name in conjunction with the content of the website identified by the domain name” in *Lamparello v Falwell*, 410 F (3d) 309 (4th Cir 2005) at 316.

<sup>380</sup> *Charter*, *supra* note 125, s 2.

<sup>381</sup> *US Const amend I*.

<sup>382</sup> Craig, *supra* note 374 at 330. Teresa Scassa, “Trademarks Worth a Thousand Words: Freedom of Expression and the Use of the Trademarks of Others” (2012) 53:5 *Les Cahiers de droit* 877. And see Mark Lemley, “The Modern Lanham Act and the Death of Common Sense” (1999) 108:7 *Yale LJ* 1687 at 1696 [Lemley].

<sup>383</sup> David Vaver, “Trademark Law Reform and the Reasonable Rideau Canal Skater” (Keynote Address at “Following the Signs: New Directions in Trademark Law” conference hosted by the Ottawa Centre for Law, Technology and Society on 8 May 2017), online: <<https://techlaw.uottawa.ca/tm17ca-blog-david-vaver>>.

<sup>384</sup> Dreyfuss, *supra* note 354 at 412 (“Although somewhat opaque on this point, the Court managed to duck the constitutional issue.”). And see the Canadian court’s reluctance in *Compagnie Générale des Établissements Michelin*, *supra* note 366.

### **7.2.1.3 Rights without Responsibilities**

The third problem is that Canada's *Trademarks Act* generally has no liability for trademark abuse by traders, even though civil and criminal liability exists for trademark infringement by users such as competitors, consumers, or citizens. Relying on injurious falsehood is tenuous, especially for users who are not businesses.<sup>385</sup> Relying on vexatious proceedings is pointless, especially with traders who issue cease-and-desist letters without proceeding to court.<sup>386</sup> Both approaches increase litigation by creating counter-claims in response to trademark abuse when what is needed are defences to discourage trademark abuse in the first place. The result is that there is little to discourage traders from making unfounded claims and much to encourage users to settle in order to avoid a fine or imprisonment.<sup>387</sup>

A possible solution is to have Canada's *Trademarks Act* articulate civil and criminal liability for trademark abuse as it currently does for trademark infringement.<sup>388</sup> After all, those who claim the right to keep a guard dog to discourage trespassers from their property should

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<sup>385</sup> *Trademarks Act*, *supra* note 19, s 7(a) (**Unfair Competition and Prohibited Marks** – “No person shall (a) make a false or misleading statement tending to discredit the business, goods or services of a competitor;”). Although the common law tort of injurious falsehood requires proving malice, such proof is not required for its statutory equivalent according to *S & S Industries Inc v Rowell*, [1966] SCR 419 at 425 (“There is no express requirement that the false or misleading statements be made with knowledge of their falsity, or that they be made maliciously.”).

<sup>386</sup> *Trademarks Act*, *supra* note 19, s 38(4) (**Fivolous opposition** – “If the Registrar considers that the opposition does not raise a substantial issue for decision, he shall reject it and shall give notice of his decision to the opponent.”). Section 40 of the *Federal Courts Act* also prohibits vexatious proceedings.

<sup>387</sup> *Trademarks Act*, *supra* note 19, s 51.01(6) (**Punishment** – “Every person who commits an offence under any subsections (1) to (5) is liable (a) on conviction on indictment, to a fine of not more than \$1,000,000 or to imprisonment for a term of not more than five years or to both; or (b) on summary conviction, to a fine of not more than \$25,000 or to imprisonment for a term of not more than six months or to both.”).

<sup>388</sup> NG-LOY, *supra* note 65 at para [26.1.9] (“Section 35 [of Singapore's *Trade Marks Act*] provides a remedy for a person who is aggrieved by a groundless threat of infringement proceedings ... The recipient of such threats can get a declaration that the threats are unjustifiable, an injunction against continuance of the threats, and damages in respect of any loss suffered by the threats.”). And see the United Kingdom *Trade Marks Act 1994 (UK)*, c 26, s 21 on “Remedy for groundless threats of infringement proceedings”, as well as the *Intellectual Property (Unjustified Threats) Act 2017 (UK)*, c 14.

assume the responsibility when it bites a passerby on the adjoining sidewalk. Are trademark rights being abused? Some courts seemed to think so:

“... in the practical world powerful traders will naturally assert their rights even in marginal cases. ... Registration will require the public to look to its defences. ... Moreover, it must not be forgotten that the monopoly extends to confusingly similar marks. In any marginal case defendants, SMEs particularly, are likely to back off when they receive a letter before action. It is cheaper and more certain to do that than stand and fight, even if in principle they have a defence.”<sup>389</sup>

The subsections above illustrate how trademark law is understood and used mostly by traders and rarely by consumers. Trademark law needs re-balancing immediately. The subsections below illustrate how the dual purposes of protecting consumers and traders<sup>390</sup> have become even more unbalanced as a result of dilution and licensing, and why it must not be tilted further through foreign-language marks.

### **7.2.2 Right against Depreciation**

As explained above, the dual purposes of protecting consumers and traders are accomplished by requiring that a trademark distinguishes the goods and services of one trader

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<sup>389</sup> *Nichols Plc's Trade Mark Application*, [2003] RPC 16 at para 14, aff'd [2005] RPC 12 (ECJ).

<sup>390</sup> *Cheung Kong*, *supra* note 9 at para 72 (“Second, the purposes of paragraph 12(1)(d) include the protection of consumers from being misled about the source of wares and services, and to enable providers and suppliers to identify their wares and services and to protect them from unfair competition.”). And see *Re Spirits International*, *supra* note 193 at 13 (“The purpose of the Trademark Act is two-fold: to protect business and to protect the consumer.”).

from another. This makes common sense since a trademark's distinctiveness depends on the goods and services to which the trademarks apply.<sup>391</sup>

Or so it did until 1953.

That was the year in which section 22 of Canada's *Trademarks Act* first prohibited depreciation of goodwill.<sup>392</sup> The scope of depreciation of goodwill is unclear because the Supreme Court of Canada has stated that it could go beyond dilution by "blurring" and "tarnishing",<sup>393</sup> which means that the depreciation of goodwill could go further than American anti-dilution law to include "free riding" or even further than European anti-dilution law to include a fourth or fifth prohibition that has yet to be articulated.<sup>394</sup> For this reason, the subsections below try to anticipate the possible limits of depreciation of goodwill – and its potential effects on foreign-language marks – by reviewing Frank Schechter's 1927 article on the rational basis of trademark protection.<sup>395</sup>

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<sup>391</sup> NG-LOY, *supra* note 65 at para [20.3.3] ("The specification of goods/services is an important feature of the registration process. For example, it is by reference to this specification of goods/services that the Registry determines whether the trade mark satisfies the 'distinctiveness' requirement.").

<sup>392</sup> *Trademarks Act*, *supra* note 19, s 22(1) ("**Depreciation of goodwill** – No person shall use a trademark registered by another person in a manner that is likely to have the effect of depreciating the value of the goodwill attaching thereto.").

<sup>393</sup> *Veuve Clicquot*, *supra* note 99 at para 67 ("I do not suggest that the concept of "depreciation" in s. 22 is necessarily limited to the notions of blurring and tarnishment. Canadian courts have not yet had an opportunity to explore its limits."). Although section 22 is not relevant to opposition proceedings, an argument can be made that it should be. Imagine that *Veuve Clicquot* had decided that there was no confusion per section 20 but that there was depreciation of goodwill per section 22. Would the court only grant the remedy of enjoining the use of CLIQUOT because it depreciates the registered mark CLICQUOT, but not grant the remedy of expunging the trademark registration for CLIQUOT? That would result in a strange scenario where a mark cannot be used but can remain registered, presumably until such time that the lack of use results in the expungement of the registration. But if the court can grant both an injunction and an expungement per section 22, then the Trademarks Opposition Board should also be able to refuse an application per section 22. Otherwise, another strange scenario would occur where a mark cannot be used but can become registered, only to be expunged after registration for lack of use.

<sup>394</sup> Even American anti-dilution itself could have gone beyond tarnishing and blurring, according to Graeme Dinwoodie, "(National) Trademark Laws and the (Non-National) Domain Name System" (2000) 21:3 U Pa J Intl Econ L 499 at 523 ("Indeed, this trend was so pervasive that some commentators started to reconceptualize dilution case law as covering three cases: tarnishment, blurring, and cybersquatting.") [Dinwoodie on Domain Name].

<sup>395</sup> Schechter, *supra* note 6.

### 7.2.2.1 Dilution of Trademark

The first thing Schechter advocated was the right against dilution of arbitrary, coined or fanciful marks. This is clear from his repeated statements that such trademarks deserve more protection than commonplace ones<sup>396</sup> because they were “added to rather than withdrawn from the human vocabulary ... [otherwise] these marks must inevitably be lost in the commonplace words of the language, despite the originality and ingenuity in their contrivance,”<sup>397</sup> as well as from his concluding principles:

“(1) that the value of the modern trademark lies in its selling power; (2) that this selling power depends for its psychological hold upon the public, not merely upon the merit of the goods upon which it is used, but equally upon its own *uniqueness and singularity*; (3) that such *uniqueness or singularity* is vitiated or impaired upon either related or non-related goods; and (4) that the degree of its protection depends in turn upon the extent to which, through the efforts or ingenuity of its owner, it is actually *unique and different* from others.”<sup>398</sup> [*emphasis added*]

Cohen criticized Schechter’s legal reasoning for being circular: “It purports to base legal protection upon economic value, when as a matter of actual fact, the economic value of a sales device depends upon the extent to which it will be legally protected”<sup>399</sup> and its opposite vicious circle “accepts the fact that courts do protect private exploitation of a given word as a reason why private exploitation of that word should be protected.”<sup>400</sup> Another way to explain Cohen’s

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<sup>396</sup> Schechter, *supra* note 6 at 830, 832.

<sup>397</sup> Schechter, *supra* note 6 at 829.

<sup>398</sup> Schechter, *supra* note 6 at 831.

<sup>399</sup> Felix Cohen, “Transcendental Nonsense and the Functional Approach” (1935) 35:6 Columbia L Rev 809 at 815 [Cohen].

<sup>400</sup> Cohen, *supra* note 399 at 815.

criticism is his suggestion that we should not be assessing Schechter's legal reasoning based on the theory it defends but based on the question it propounds.<sup>401</sup> This means not being distracted by Schechter's emphasis on the injury done to trademarks and staying focused on Schechter's assumption that "courts are not *creating* ... but merely *recognizing* ... a supernatural Something that is immanent in certain trade names and symbols".<sup>402</sup> This also means staying focused on the effects of Schechter's assumption, which range from quelling public opposition on the circular thinking<sup>403</sup> to redistributing wealth:

"Language is socially useful apart from law, as air is socially useful, but neither language nor air is a source of economic wealth unless some people are prevented from using these resources in ways that are permitted to other people."<sup>404</sup>

The analysis above is relevant to foreign-language marks because Schechter's approach suggests that transliterations that add to the vocabulary deserve more protection than translations that already exist in the foreign language. This could also be stretched to make the bizarre argument that foreign-language marks for which the courts do not recognize linguistic knowledge, by virtue of being deemed as an inarticulate design instead of being recognized as a word that already exists, deserve more protection than those which are understood by consumers. In this regard, Cohen's approach is preferable in that its application would remain the same for all foreign languages.

It is important to note that Schechter did not actually advocate for the right against dilution of famous marks. After all, a trademark can be arbitrary, coined or fanciful without

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<sup>401</sup> Cohen, *supra* note 399 at 829.

<sup>402</sup> Cohen, *supra* note 399 at 815-816.

<sup>403</sup> Cohen, *supra* note 399 at 816 ("The effect of this theory, in the law of unfair competition as elsewhere, is to dull lay understanding and criticism of what courts do in fact.").

<sup>404</sup> Cohen, *supra* note 399 at 816.

being famous (and vice versa). Beebe and others, however, seemed to interpret Schechter as advocating for famous marks. Beebe noted that “Cohen correctly identified the fundamental problem ... that Schechter tried to hide from his realist readers by focusing to such an extent on the damage to the plaintiff’s *famous mark* rather than the motives of the defendant – on the harm rather than on the misappropriation”;<sup>405</sup> that “Wolff expressed his sympathy with Schechter’s efforts to protect *famous trademarks* from dilution”;<sup>406</sup> and that Schechter “spoke of the need to protect *famous marks* ‘against vitiation or dissociation from the particular product in connection with which it has been used’.”<sup>407</sup> This interpretation could be due to Schechter’s testimony to the United States Congress: “I have limited that notion of mine to marks of an arbitrary or fanciful or original nature ... *particularly* a unique and fanciful mark such as ODOL or KODAK.”<sup>408</sup> Both trademarks were mentioned in Schechter’s article and were famous marks. But bolstering protection for distinctive marks by emphasizing their fame (and the subsequent harm) is different from advocating protection for famous marks even if they are non-distinctive. The fact remains that Schechter’s concluding principles make no mention of famous marks.

The analysis above is important to foreign-language marks because Beebe et al’s interpretation is the current state of American anti-dilution law, which protects only trademarks that are “famous”.<sup>409</sup> Even though fame is determined by considering a non-exhaustive list of

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<sup>405</sup> Barton Beebe, “The suppressed misappropriation origins of the trademark antidilution law: The Landgericht Elberfeld’s *Odol* Opinion and Frank Schechter’s ‘The Rational Basis of Trademark Protection’” in Dreyfuss & Ginsburg, eds, *Intellectual Property at the Edge* (United Kingdom: Cambridge University Press, 2014) 59 at 74 [Beebe on Schechter].

<sup>406</sup> Beebe on Schechter, *supra* note 405 at 75.

<sup>407</sup> Beebe on Schechter, *supra* note 405 at 77.

<sup>408</sup> Beebe on Schechter, *supra* note 405 at 78-79.

<sup>409</sup> It is important to note that “famous” for the dilution doctrine is not the same as “famous” for the Paris Convention. With respect to the former, see NG-LOY Wee Loon, “The Sense and Sensibility in the Anti-Dilution Right” (2012) 24 *Sing Ac LJ* 927 at 940 (“It is now clear that the US anti-dilution right is reserved for trade marks with a very high level of reputation, namely, reputation against the general public; niche fame is not good enough.”) [NG-LOY on Anti-dilution]. With respect to the latter, see the concurring reason in *Grupo Gigante SA de CV v Dallo & Co*, 391 F (3d) 1088 (9th Cir 2004) at para 80 (“To enjoy extraterritorial trademark protection, the owner of a foreign trademark need not show the level of recognition necessary to receive nation-wide protection against



factors,<sup>410</sup> there is scholarship to suggest that it is being applied haphazardly. Beebe conducted a study illustrating that the dilution doctrine is unnecessary in many cases.<sup>411</sup> Lemley explained that the courts can be too quick to perceive or even to ignore fame based on local experiences.<sup>412</sup> This also raises the possibility of local experiences becoming an unintentional bias when it comes to recognizing the fame of foreign-language marks. For example, a court in the United States would likely be unimpressed by claims to fame for 乔丹 or QIAO2 DAN1, which it has never heard of nor seen. But an American court would understand immediately once it is informed that those are the respective Chinese translation and pronunciation for JORDAN. Although it should not do so, the court will subconsciously superimpose Michael Jordan's fame onto the Chinese translation and pronunciation, thus equating them with JORDAN. Another example is how a judge in the United States would likely recognize the fame of OPRAH based on her average television viewership of 13 million. An American judge does not have to be a talk show fan to come across OPRAH's talk show while flipping American television channels or be

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trademark dilution. On the other hand, the foreign trademark owner who does not use a mark in the United States must show more than the level of recognition that is necessary in a domestic trademark infringement case.”). Although the concurring reason goes on to adopt the same standard of 50% at paras 87-90, the fame required for international trade agreements is still less because it is restricted to the relevant American market instead of the general consuming public: (“I do not believe that a showing that 20 to 22 percent of the relevant market is familiar with the foreign mark establishes that a “significant” or “substantial” percentage of that market is familiar with the foreign mark. ... I would adopt a similar standard [known to more than 50 percent of the defendant's potential customers] for the exception for famous or well-known foreign marks.”).

<sup>410</sup> *Trademark Dilution Revision Act 2006*, 15 USC, c 22, §1123(b)(2)(A) (“ ... a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following: (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties. (ii) The amount, volume, and geographical extent of sales of goods or services offered under the mark. (iii) The extent of actual recognition of the mark. Whether the mark was registered ... ”).

<sup>411</sup> Barton Beebe, “The Continuing Debacle of U.S. Antidilution Law: Evidence from the First Year of Trademark Dilution Revision Act Case Law” (2007-2008) 24 *Santa Clara Computer & High Tech LJ* 449 at 450 (“antidilution law (in the United States) continues to have no appreciable effect on the outcomes of federal trademark cases or the remedies issuing from those outcomes.”).

<sup>412</sup> Lemley, *supra* note 405 at 1698-1699 (“But courts applying the state and federal dilution statutes have been quite willing to conclude that a local favorite, or a rather obscure company, is “famous” within the meaning of the Act. Thus, marks such as Intermatic, Gazette, Dennison, Nailtiques, TeleTech, Wedgewood (for new homes, not china), Papal Visit 1999, and Wawa have been declared famous. Worse, many courts seem willing to find dilution without even inquiring into the fame of the mark.”).

exposed to OPRAH’s billboard ads while driving on American roads. But the same court may not have heard of Graham Norton, the host of a 20-year-old British talk show with over 4 million viewers in the United Kingdom. Even though Graham Norton interviews America’s most recognized and highest paid celebrities – Madonna, David Beckham, Justin Bieber, Emily Blunt, George Clooney, Hugh Jackman, Will Smith, Sir Elton John and Sir Patrick Stewart – on a weekly basis, his American counterpart in the same industry had never seen his show. This was obvious when Stephen Colbert interviewed Graham Norton and was surprised to hear that guests chatted over cocktails and drinks on the latter’s show. And the same court would likely never have heard of LUYU, a Chinese talk show host who averaged more than 10 times the number of OPRAH viewers with 140 million viewers in China. LUYU’s fame in the United States would only exist amongst those who watch Chinese satellite shows or read Chinese magazines. This helps us to understand why – incredible as it sounds – a court in China may not recognize the fame of JORDAN or TRUMP. While Chinese basketball fans who watch NBA games and Chinese businessmen who read FORBES magazines may recognize such fame, a Chinese judge may actually lack the local experiences to do so. This is also why few in China recognize America’s most famous “Chinese” dishes: General Tso chicken, chow mein, beef broccoli (broccoli is not even a Chinese vegetable), chop suey, and Chinese fortune cookies.<sup>413</sup>

Canada’s depreciation of goodwill is more expansive than the American anti-dilution law because it does not require fame and it has no limits as defences.<sup>414</sup> Regardless of the

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<sup>413</sup> Ian Cheney, *The Search for General Tso* (United States: Wicked Delicate Films, 2015). Jennifer Lee, *The Fortune Cookie Chronicles: Adventures in the World of Chinese Food* (New York: Hachet Book Group USA, 2008).

<sup>414</sup> *Veuve Clicquot*, *supra* note 99 at para 46 (“Section 22 has four elements. Firstly, that a claimant’s registered trademark was used by the defendant in connection with wares or service – whether or not such wares and services are competitive with those of the claimant. Secondly, that the claimant’s registered trademark is sufficiently well known to have significant goodwill attached to it. Section 22 does not require the mark to be well known or famous (in contrast to the analogous European and U.S. laws), but a defendant cannot depreciate the value of the goodwill that does not exist. Thirdly, the claimant’s mark was used in a manner *likely* to have an effect on that goodwill (i.e.

terminology of, requirements for, and limits to this law, the inclusion of linguistic knowledge raises the question as to “what is the actual mark that needs to preserve its uniqueness and protect against vitiation?”<sup>415</sup> In other words, does the right to protect the mark JORDAN necessarily also mean a right to protect the Chinese translation 乔丹 or the Chinese pronunciation QIAO2 DAN1? Although dilution does not require confusion and only assesses distinctiveness, the general recommendation to assume linguistic knowledge should still apply to dilution, and the specific recommendation to translate foreign-language marks into the official language(s) of the country assessing for distinctiveness should not apply to dilution. Why? When registrability and infringement assess for distinctiveness, their purpose is to prevent confusion by ensuring that a trader does not monopolize common words and prohibit others from their generic or clearly descriptive use. Contrast that with dilution, which assesses for distinctiveness with the completely different purpose of ensuring that others do not dilute or depreciate a trader’s goodwill.

#### **7.2.2.2 Dilution of Goods and Services**

The second thing Schechter advocated was the right against dilution of goods and services. He began with the orthodox belief that a trademark identifies the origin or ownership of

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linkage) and fourthly that the *likely* effect would be to depreciate the value of its goodwill (i.e. damage.”). See Craig, *supra* note 374 at 333-334 (“Section 22, however, threatens to offer more expansive control. In the United States, protection against the dilution of the distinctive quality of a famous mark is limited by section 1125(4) of the *Lanham Act*, which shields from liability non-commercial uses, uses in news reporting, and ‘fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark.’”).

<sup>415</sup> Schechter, *supra* note 6 at 822, 825 (“It ignores the fact that the creation and retention of custom, rather than the designation of source, is the primary purpose of the trademark today, and that the preservation of the uniqueness or individuality of the trademark is of paramount importance to its owner.”) and (“It is the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name by its use upon non-competing goods. The more distinctive or unique the mark, the deeper is its impress upon the public consciousness, and the greater its need for protection against vitiation or disassociation from the particular product in connection with which it has been used.”) and (“... the preservation of the uniqueness of a mark should constitute the only rational basis for its protection.”).

goods, which he quickly dismissed by arguing that consumers no longer know the specific source of a trademarked good.<sup>416</sup> He claimed instead that a trademark, in reality, creates and retains goodwill.<sup>417</sup> The resulting consequence would be that trademark protection need no longer be limited to specific goods, but should be expanded to non-competing goods.<sup>418</sup> His new basis for trademark protection is summed up in the much repeated passage:

“The real injury in all such cases can only be gauged in the light of what has been said concerning the function of a trademark. It is the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name by its use upon *non-competing goods*. The more distinctive or unique the mark, the deeper is its impress upon the public consciousness, and the greater its need for protection against vitiation or dissociation from *the particular product* in connection with which it has been used.”<sup>419</sup> [*emphasis added*]

Brown agreed with Schechter that trademarks have a persuasive function in that “[t]hey not only reach over the shoulders of the retailer, they reach from a radio program on Sunday to a

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<sup>416</sup> Schechter, *supra* note 6 at 813-814 (“The orthodox definition of “the primary and proper function of a trade-mark” is that given by the Supreme Court of the United States in the leading case of *Hanover Star Milling Co. v. Metcalf*: “to identify the origin or ownership of the goods to which it is affixed. ... To what extent does the trademark of today really function as either? Actually, not in the least! It has been repeatedly pointed out by the very courts that insist on defining trademarks in terms of ownership or origin that, owing to the ramifications of modern trade and the national and international distribution of goods from the manufacturer through the jobber or importer and the retailer to the consumer, the source or origin of the goods bearing a well-known trademark is seldom known to the consumer.”).

<sup>417</sup> Schechter, *supra* note 6 at 818 (“To describe a trademark merely as a symbol of good will, without recognizing in it an agency for the actual creation and perpetuation of good will, ignores the most potent aspect of the nature of a trademark and that phase most in need of protection.”).

<sup>418</sup> Schechter, *supra* note 6 at 822-823 (“The doctrine that the same trademark may be used on different classes of goods [was] recently restated by the Supreme Court ... But why does a limitation of the protection of trademarks to goods of the same class logically and necessarily follow from the rule that there is no property in a trademark in gross? ... Quite apart from the destruction of the uniqueness of a mark by its use on other goods, which will be discussed later on, once a mark has come to indicate to the public a constant and uniform source of satisfaction, its owner should be allowed the broadest scope possible for the “natural expansion of his trade” to other lines or fields of enterprise.”).

<sup>419</sup> Schechter, *supra* note 6 at 825.

compulsive purchase on Friday”,<sup>420</sup> as he also believed that “trade symbols may serve as a bridge between advertising and purchase, and that they may themselves be the vehicle of persuasion”.<sup>421</sup> Notwithstanding this, Brown still disagreed that such a function should be protected, as he maintained the traditional doctrine that only the informative function of trademarks should be protected. One reason could be Brown’s criticism of Schechter for exaggerating the importance of a trademark guaranteeing satisfaction.<sup>422</sup> Another reason could be Brown’s disapproval of using trademarks for such a function.<sup>423</sup>

It is important to note that Schechter only advocated for the right against dilution by “blurring”,<sup>424</sup> but did not actually advocate for the rights against dilution by “tarnishing” or “free riding”. Notwithstanding this, his article has resulted in a spectrum running from a restrictive to an expansive framework. In a simple and restrictive framework, the test for confusion is enough to serve the current purpose of trademark law because “the interests of trademark owners and consumers aligned perfectly. Trademark laws benefit both mark owners and consumers when they stop sales of counterfeit goods.”<sup>425</sup> This is true regardless of whether consumers see the trademark as identifying source and giving traders a shortcut to communicate their goods and services, or whether consumers see the trademark as guaranteeing quality and giving traders an

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<sup>420</sup> Ralph Brown, “Advertising and the Public Interest: Legal Protection of Trade Symbols” (1948) 57:7 Yale LJ 1165 at 1186 [Brown].

<sup>421</sup> Brown, *supra* note 420 at 1187.

<sup>422</sup> Brown, *supra* note 420 at 1186, nn 82-83 (“Doubtless most sellers wish to signify to buyers reliability, consistency, and other qualities. The point is that the symbol carries no such legal assurance. The user can “trade up” or “trade down” within a wide range of quality without risking any legal attack on his mark.”).

<sup>423</sup> Brown, *supra* note 420 at 1190 (“From what has been said earlier about the economic waste and distortion of consumer choice growing out of large-scale persuasive advertising, it should be clear that the persuasive function of trade symbols is of dubious social utility. There seems little reason why the courts should recognize or protect interests deriving from it.”).

<sup>424</sup> NG-LOY on Anti-Dilution, *supra* note 409 at para 49 (“Schechter was not explicitly concerned with tarnishment, but it has been said that tarnishment is a subset of blurring.”).

<sup>425</sup> Gerhardt, *supra* note 12 at 429-430.

incentive to provide consistent and desirable standards.<sup>426</sup> Either way, trademarks lower consumer search costs and promote market efficiency.<sup>427</sup> Therefore, both consumers and traders benefit from a Canadian statutory prohibition against trademark infringement. Since Schechter's article, however, the trademark purpose of protecting consumers from confusion seems to have given way to and become disconnected from that of protecting traders from unfair competition,<sup>428</sup> and may have even turned into a disguise for anti-competition. This has resulted in a complex and expansive framework, where "the actual alignment often breaks apart, especially when consumers seek to use marks as information tools. The expansion of trademark law is resulting in trends that ignore or harm consumer interests. The harm is especially apparent when trademark law is used to deny consumers the opportunity to use trademarks to find information."<sup>429</sup> This is because consumer confusion is not required for dilution by "blurring", dilution by "tarnishing", or "free riding". Therefore, the possible consequences flowing from a Canadian statutory prohibition against depreciation of goodwill prioritize traders over consumers. We must ask if such a priority means trademark law is unnecessarily and incorrectly overlapping with tort and contract law.<sup>430</sup>

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<sup>426</sup> *Mattel*, *supra* note 99 at para 21 ("The trademark owner[']s claim rests] ... on serving an important public interest in assuring consumers that they are buying from the source from whom they think they are buying and receiving the quality which they associate with that particular trademark. Trademarks thus operate as a kind of shortcut to get consumers to where they want to go, and in that way perform a key function in a market economy. Trademark law rests on principles of fair dealing. It is sometimes said to hold the balance between free competition and fair competition.").

<sup>427</sup> *Katz*, *supra* note 15.

<sup>428</sup> *NG-LOY*, *supra* note 65 at para [15.1.6] ("It has been argued that modern advertising and marketing strategies have allowed certain trade marks to acquire another function. This relates to a special category of trade marks known in different jurisdictions as 'well-known trade marks' or 'famous marks' or 'marks with a reputation'. These special trade marks have been so successfully promoted by their trade mark proprietors that the public no longer rely upon these trade marks merely as badges of origin and of quality. These trade marks have such a 'selling power' that they have become icons in their own right: people buy goods bearing these trade marks, not really because of the origin or quality of these goods, but because of the trade marks themselves and the image and lifestyle they symbolise.").

<sup>429</sup> *Gerhardt*, *supra* note 12 at 430-431.

<sup>430</sup> *Vaver*, *supra* note 21 at 432 ("Although the tort grew up to protect the interests of traders rather than consumers, the less it works to prevent consumer confusion, the more it becomes merely a law protecting traders from unfair competition.") Although the author is speaking to passing off, the comment is also true for registered trademarks.

### 7.2.2.3 Dilution of Use

The third thing Schechter advocated was the right against dilution of use in commerce. This is clear from his repeated statements that a trademark sells goods,<sup>431</sup> which is why “it would lose in selling power if everyone used it as the designation of his goods,”<sup>432</sup> as well as from the much quoted passage:

“The true functions of the trademark are, then, to identify a product as satisfactory and thereby to *stimulate further purchases* by the consuming public.”<sup>433</sup>

[*emphasis added*]

Lemley disagreed with Schechter. Instead, he agreed with Brown by maintaining the traditional doctrine that the only function of a trademark is to identify source, as treating trademarks like property defeats the requirement that they be distinctive of the goods and services with which they are associated.<sup>434</sup> He even repeated Brown’s disapproval of having a trademark as an end in itself when consumers would be better off “with fewer brands clamoring for [their] scarce attention.”<sup>435</sup> Beebe would agree with them because he documented how Schechter’s 1927 article on the rational basis of trademark protection – “the most cited law

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And see *Imperial Tobacco Co of India Ltd v Albert Bonnan*, [1924] UKPC 38 (“The respondents, being unhampered by covenant, are selling goods manufactured by the British American Company as being what they are – namely, Will’s Gold Flake cigarettes manufactured by that company. There is no untruth and no attempt to deceive. ... There is nothing to prevent a tradesman acquiring goods from a manufacturer and selling them in competition with him, even in a country into which hitherto the manufacturer or his agent has been the sole importer.”).

<sup>431</sup> Schechter, *supra* note 6 at 815, 819, 830, 831, 832.

<sup>432</sup> Schechter, *supra* note 6 at 832.

<sup>433</sup> Schechter, *supra* note 6 at 818.

<sup>434</sup> Lemley, *supra* note 405 at 1695-1696 (“We give protection to trademarks for one basic reason: to enable the public to identify easily a particular product from a particular source. ... Vesting trademarks with the mantle of property – and giving them some of the indicia of real property, such as free transferability – defeats the purpose of linking trademarks to goods in the first place.”).

<sup>435</sup> Lemley, *supra* note 405 at 1695.

review article ever written on trademark law”<sup>436</sup> – is actually misappropriation in disguise,<sup>437</sup> which is why “[i]t has managed over the years to mean many different things to many different people, all seeking some theoretical means to fill the void left in the absence of misappropriation.”<sup>438</sup>

The analysis above is relevant to foreign-language marks because the approach of Schechter’s dissenters suggests that a claim for a foreign-language mark should not include automatic claims for its translations. This is important because what is true for a trademark may not be true for its foreign-language equivalents. For example, subsection 5.1.2 on “Comparing for Confusion” explained that although PEPSI-COLA was found to be not confusing with COCA-COLA in English,<sup>439</sup> 百事可樂 would have been confusing with and should have been stopped by the previous use of 可口可樂 in Chinese. Likewise, the same explanation applied in subsection 6.3.2 on “Example of JORDAN” for why Michael Jordan can only claim the Chinese translation for JORDAN with respect to the writing (乔丹) but not with respect to the pronunciation (QIAO2 DAN1). This means that although dilution does not require confusion and only assesses distinctiveness, the general recommendation to assume linguistic knowledge should still apply to dilution, and the specific recommendation to translate foreign-language marks into the official language(s) of the country assessing for distinctiveness should not apply to dilution.

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<sup>436</sup> Beebe on Schechter, *supra* note 405 at 61.

<sup>437</sup> Beebe on Schechter, *supra* note 405 at 63 (“What Schechter sought to obscure in ‘Rational Basis’ is that the *Odol* case was not, strictly speaking, a trademark case. Rather, it was a misappropriation case that happened to involve a trademark. Schechter sought to suppress this basic truth – that the concept of trademark dilution is essentially a misappropriation concept – in order to sell his proposed doctrinal reforms to an American audience altogether suspicious of misappropriation doctrine and increasingly under the sway of American Legal Realism.”).

<sup>438</sup> Beebe on Schechter, *supra* note 405 at 63.

<sup>439</sup> *Pepsi-Cola*, *supra* note 102 at 617-618.



It is important to note that Schechter did not actually advocate for the right against dilution of other uses such as non-commercial or expressive uses. While it may seem fastidious to say that Schechter objected to using a trademark for its “uniqueness and singularity” or with “non-competing goods”, but not to using a trademark in a protest or a parody, the fact remains that every case he cited was an example of use in commerce.<sup>440</sup> Although not writing about Schechter, Dreyfuss revealed what would happen if trader rights were expanded even more to prohibit expressive activities without a reciprocal expansion of user rights.<sup>441</sup> She began by identifying how a trademark can have a signaling function that “stimulates further purchases by the consuming public” – as Schechter would say – and an expressive function that does not do so.<sup>442</sup> While the former function is now prohibited, the latter function generally is still not.<sup>443</sup> But this could change because hybrid uses of trademarks often invoke both functions,<sup>444</sup> and traders are repeatedly litigating to prohibit the latter function, such as when the United States Olympic Committee persuaded the Supreme Court of the United States to prohibit a non-profit

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<sup>440</sup> Schechter, *supra* note 6 at 829 (“Should the rule, still broadly enunciated by the Supreme Court, that a trademark may be used on different classes of goods, be literally adhered to, there is not a single one of these fanciful marks which will not, if used on different classes of goods, or to advertise different services, gradually but surely lose its effectiveness and unique distinctiveness in the same way as has STAR, BLUE RIBBON, or GOLD MEDAL. If KODAK may be used for bath tubs and cakes, MAZDA for cameras and shoes, or RITZ-CARLTON for coffee, these marks must inevitably be lost in the commonplace words of the language, despite the originality and ingenuity in their contrivance, and the vast expenditures in advertising them which the courts concede should be protected to the same extent as plant and machinery.”).

<sup>441</sup> Dreyfuss, *supra* note 354.

<sup>442</sup> Dreyfuss, *supra* note 354 at 400 (“... its central role to be that of identifying goods and services and distinguishing them from those manufactured or sold by others. I call this the “signaling” function of the mark. ... In referring to BARBIE in order to indicate that she was treated like a beautiful by empty-headed accessory, Kennedy exploited a set of meanings that are quite different from the ones invoked by Mattel, and I label this use of the trademark “expressive”.”).

<sup>443</sup> Dreyfuss, *supra* note 354 at 400, 401 (“The first use would be protected – and, indeed, is protected by both federal and state law – because exclusivity is essential to an efficient marketplace. ... Expressive uses of marks do not usually involve purchasing decisions. Accordingly, no prohibitions on such usages are generally necessary.”).

<sup>444</sup> Dreyfuss, *supra* note 354 at 401, 402 (“On the expressive side, these are cases like *Prestonettes, Inc. v. Coty*, and *Champion Spark Plug Co. v. Sanders*, in which marks are utilized commercially, but not in the signaling sense. In *Prestonettes*, a reference to the trademark owner’s business was made in connection with the sale of scented face powder in order to fully describe the product’s ingredients; in *Sanders*, the original labels on rebuilt spark plugs were left in place to denote their history. ... The easy cases on the opposite pole are ones that involve signaling uses of the mark, but not in the commerce of the trademark owner. ... In *Polaroid Corp. v. Polarad Electronics Corp.*, for example, the Second Circuit announced a series of factors that quantify the likelihood that consumers will be confused into thinking that Polaroid was the source of electronic devices manufactured by Polarad.”).

organization from raising public awareness through a sporting event called the GAY OLYMPIC GAMES.<sup>445</sup> Contrast that with a South African court permitting a for-profit clothing company to parody trademark owners.<sup>446</sup> Canadian courts might be in between because even though they prohibited a water bottler from depreciating the goodwill of a registered trademark to spoof then Prime Minister Pierre Elliot Trudeau,<sup>447</sup> they might have permitted labour union use of an employer's trademarks.<sup>448</sup> Dreyfuss used such situations to reveal the inconsistency of using competitive rights to evaluate expressive activities:

“But [the non-profit organization's] failure to convince the Court of the genericity of OLYMPIC may hold the key to resolving the problem of public access to marks in a legal regime intent on expanding proprietary rights. Thus, the explanation for the Court's willingness to accept GAMES as a substitute for OLYMPIC may lie in the fact that it compartmentalized the vocabulary into expressive and competitive components. Since it took the genericity defense solely in its traditional form, as a claim about the competitive vocabulary, it evaluated the word in only the competitive context, as a word denoting athletic tournaments, and came to the conclusion that ample synonyms were readily available. Had it instead focused on the expressive significance of OLYMPIC, and looked for replacements that would evoke the tenets of the ancient Greeks, it might have reached a different result on the genericity issue.”<sup>449</sup>

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<sup>445</sup> *San Francisco Arts & Athletics, Inc v United States Olympic Committee*, 483 US 522 (1987).

<sup>446</sup> *Laugh It Off Promotions CC v Sabmark International et al* (2006) 1 SA 144 (CC).

<sup>447</sup> *Source Perrier SA v Fira-Less Marketing Co*, (1983) 70 CPR 2d 61 (FCTD).

<sup>448</sup> *Compagnie Générale des Établissements Michelin*, *supra* note 366.

<sup>449</sup> Dreyfuss, *supra* note 354 at 417.

In this regard, Schechter's rational basis for trademark protection can only be maintained if traditional intellectual property justifications for trademarks are kept for competitive uses, and expanded trademark rights are accompanied by an expanded analysis for expressive uses. How should this be done? Dreyfuss suggests "build[ing] upon the defenses that trademark has constructed for the competitive vocabulary a parallel set of principles to protect expressive speech."<sup>450</sup>

The analysis above is relevant to foreign-language marks, as they can also have expressive uses. For example, China's poor is reacting increasingly to the wasteful consumption of China's elite by co-opting luxury brands. These expressive activities threaten social stability because they highlight discontentment with and encourage discussion of the immense wealth gap (presumably from government corruption) in China.<sup>451</sup> As the West celebrates China's increasing enforcement of trademark law,<sup>452</sup> it must beware that China's reasons for enforcement may sometimes have nothing to do with trademark law or that such enforcement can have life-and-death consequences in China. For example, China executed at least 14 infringers for counterfeiting trademarked goods in the 1990's.<sup>453</sup> The inclusion of linguistic knowledge – along with the expansion of trademark rights – will only increase the value of Chinese-language marks here and abroad. We must reconsider our desire to litigate such rights in light of the fact that

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<sup>450</sup> Dreyfuss, *supra* note 354 at 418.

<sup>451</sup> Barton Beebe, "Shanzhai, Sumptuary Law, and Intellectual Property Law in Contemporary China" (2014) 47 UC Davis L Rev 849 at 855 ("The important difference, of course, is that [the Chinese laws] are a reaction by social elites seeking to preserve social stability, while [the Chinese expressive activities] are a reaction primarily by the non-elite that is at least symptomatic of, if not an incitement to, social instability. The former attacks competitive consumption through top-down controls on consumption; the latter attacks competitive consumption through bottom-up appropriation and recoding.").

<sup>452</sup> *Ibid* at 854 ("A third recent development in China is the increasing number and effectiveness of intellectual property lawsuits and administrative enforcement actions brought by foreign luxury goods producers against Chinese defendants. ... Hermes, Burberry, Cartier, and Coach have each recently won significant cases against infringers, with Coach making headlines for its award of \$257 million in damages. Meanwhile, in a first for the two countries, the United States and China recently collaborated to shut down a massive counterfeiting operation in Guangdong province valued at \$802 million.").

<sup>453</sup> Connie Carter, *Fighting Fakes in China: The Legal Protection of Trade Marks and Brands in the People's Republic of China* (London: The Intellectual Property Institute, 1996) at 63.

China is “persuaded by the West to use a criminal system which is characterized by political interference and which in practice lacks even basic procedural safeguards. ... In the two cases that have been reported in the West the defendants were sentenced under the provision of the Criminal Code prohibiting speculation, rather than under the specific offences relating to trademarks. ... Such a sentence in China often means public humiliation or public execution, execution to order (so that the requirements of organ donors can be met) and a host of other well-documented abuses.”<sup>454</sup> Bently and Maniatis commented that “while economic motives explain such legal imperialism, the ethical dimensions of such strategies demand reflection ... that the United States’ refusal to engage with the existing structures of Chinese administration have caused the United States to advocate changes in China’s law which are ethically objectionable.”<sup>455</sup>

Ethical objections to the United States influencing China’s law may increase if we remember that both the United States and China started as net importers of intellectual property which refused to sign international trade agreements recognizing foreign rights. For example, the United States neither protected British copyright owners in the 19<sup>th</sup> Century nor joined the Berne Convention for the Protection of Literary and Artistic Works until 1988.<sup>456</sup> Only a reversal in its economic motives led to the United States influencing Singapore’s copyright legislation in 1987 with the promise of trade benefits (which were terminated soon after the copyright legislation was enacted).<sup>457</sup> And these economic motives resulted in the United States using trade sanctions in 1994 “to persuade more than 100 other countries that they, as net importers of technological

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<sup>454</sup> Robert Burrell, “A Case Study in Cultural Imperialism: The Imposition of Copyright on China by the West” in Lionel Bently & Spyros Maniatis, eds, *Perspectives on Intellectual Property: Intellectual Property and Ethics* (London: Sweet & Maxwell, 1998) 197 at 219-220 [Bently & Maniatis].

<sup>455</sup> Bently & Maniatis, *supra* note 454 at ix of its Introduction.

<sup>456</sup> Bently & Sherman, *supra* note 32 at 6.

<sup>457</sup> NG-LOY, *supra* note 65 at paras [4.1.13]-[4.1.16].

and cultural information, should pay more for the importation of that information.”<sup>458</sup> But should intellectual property be limited to economic and international trade concerns? What of social and human rights causes?

#### **7.2.2.4 Dilution of Territory**

The fourth thing Schechter advocated was the right against dilution of territory. He stated his position in one long but much overlooked passage:

“An equally apparent failure of the courts to keep pace with the necessities of trade and the functional development of trademarks, and a corollary to the principle that ‘if there is no competition, there can be no unfair competition,’ is the rule that a trademark or trade name is only coextensive with its use and may be used by different firms in *different localities*. ... Furthermore, such decisions, based upon an antiquated *neighborhood theory of trade*, fail to recognize the fact that through the existence of the telephone, the automobile, the motor bus, the high-speed interurban trolley, and the railroad, the consumer now projects his shopping *far from home* ... ”<sup>459</sup> [*emphasis added*]

The Supreme Court of the United States disagreed with Schechter.<sup>460</sup> The passage of time, however, has vindicated Schechter with Dinwoodie’s observation that the “geographic limit

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<sup>458</sup> Peter Drahos, “Global Property Rights in Information: The Story of TRIPS at the GATT” (1995) 13:1 *Prometheus* 6 at 7.

<sup>459</sup> Schechter, *supra* note 6 at 824.

<sup>460</sup> *Hanover Star Milling Co v Metcalf*, 240 US 403 (1916) at 415-416 (“But this is not to say that the proprietor of a trademark ... can monopolize markets that his trade has never reached.”). And see *United Drug Co v Theodore Rectanus Co*, 248 US 90, 100 (1918) at 98 (“[T]he adoption of a trademark does not, *at least in the absence of some valid legislation enacted for the purpose*, project the right of projection in advance of the extension of the trade, or operate as a claim of territorial rights over areas into which it thereafter may be deemed desirable to extend the

became much less significant with the advent of federal trademark registration under the Lanham Act in 1946 because an application for federal trademark registration is, if successful, treated as nationwide constructive use.”<sup>461</sup>

It is important to note that Schechter only advocated for the right against dilution within the United States, but did not actually advocate for the right against dilution beyond national borders. Does expanding trademark rights internationally include the responsibility to meet consumer expectations that the trademark functions to identify the source (and quality) of goods and services?<sup>462</sup> For example, a Western consumer of KFC will be surprised to discover that its Chinese counterpart serves smaller chicken pieces and replaces fries with corn cobs. Likewise, an Asian consumer of 7-11 will be surprised to discover that its Canadian counterpart is not a place to pay utility bills, order train tickets, collect mail packages, send mail and faxes, or buy cellphones and SIM cards. We can only imagine what Schechter would think now that the Internet, planes, and televisions have produced “a new breed of global consumer called into existence by online shopping or international travel, or ... global brands brought about by free trade”.<sup>463</sup> Although ignored by most other academics, Schechter’s passage above is relevant to foreign-language marks because of the discussions below on the right to license, the export of products, and the policy of international comity.

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trade.”) [*emphasis added*]. This attempt to reap beyond the geographic limit where traders sow is similar to the attempt to reap beyond the goods and services where traders sow in *Mattel*, *supra* note 358.

<sup>461</sup> Dinwoodie on Domain Name, *supra* note 394 at 508. Although Dinwoodie notes the exception to the rule for a good faith junior user, he repeats that the importance of geographic limit decreases as the national nature of trade increases in Graeme Dinwoodie, “Trademarks and Territory: Detaching Trademark Law from the Nation-State” (2004) 41:3 Hous L Rev 885 at 895 [Dinwoodie on Territory].

<sup>462</sup> Consider how traders once used consumer expectations to “halt parallel imports, exports, or resales of genuinely branded goods” and continue to use consumer expectations to “promote brands internationally and suggest identity of trade source, while simultaneously claiming in national courts that the brand is in fact locally produced by a different trade source” according to *Vaver*, *supra* note 21 at 523. Since traders are so cognizant of consumer expectations, they should “be held responsible for clarifying a confusion of its own making” and “[t]rademark law should not support such strategies where steps can be taken to prevent buyer confusion”.

<sup>463</sup> Dinwoodie on Territory, *supra* note 461 at 900.

### **7.2.3 Right to License**

Although a trademark need not be registered in order to be licensed, a registered trademark is easier to license when there is a government certificate documenting the specifics of (1) the trademark, (2) the goods and services, and (3) the territory – as registered trademarks are valid throughout the entire country.

Licensing a trademark used to be prohibited because “[t]he object of the (trademarks) law is to preserve for a trader the reputation he has made for himself, not to help him in disposing of that reputation as of itself a marketable commodity, independent of his goodwill, to some other trader.”<sup>464</sup> In fact, it was so frowned upon that even a recent case remembers how it used to be characterized as “trafficking”:

“[T]rafficking in a trade mark has from the outset been one of the cardinal sins of trade mark law ... The objection, the reason why it was a sin, was that it would, or might, lead to deception of the public ... If Rolls-Royce decided to market the well-known Rolls-Royce badge of quality by granting licences for money to use the mark to a wide range of independent manufacturers of e.g. lawn mowers, motor boats, wristwatches, bicycles, transistors and other equipment, that would plainly, in my judgment, be trafficking in the mark, and might well lead to the confusion of the public ...”<sup>465</sup>

Or so it did until 1953.

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<sup>464</sup> *Bowden Wire Ltd v Bowden Brake Co Ltd* (1913), 30 RPC 45.

<sup>465</sup> *Re American Greetings Corp's Application, (sub nom Holly Hobbie Trade Mark)* [1984] RPC 329 at 342-343, 345.

Again, that was the year in which section 50 of Canada's *Trademarks Act* first permitted trademark licensing with a registered user regime,<sup>466</sup> which was replaced in 1993 with a quality control regime:

“For the purposes of this Act, if an entity is licensed by or with the authority of the owner of a trademark to use the trademark in a country and the owner has, under the licence, direct or indirect control of the character or quality of the goods or services, then the use, advertisement or display of the trademark in that country as or in a trademark, trade name or otherwise by that entity has, and is deemed always to have had, the same effect as such a use, advertisement or display of the trademark in that country by the owner.”<sup>467</sup>

The concept of licensing is important because it allows traders to claim ownership over another's use of a trademark, use in association with a good or services, and use in a territory. Doing so is a quick and profitable<sup>468</sup> way for traders to expand their family of trademarks, collection of goods or services, and scope of territory. The corollary of licensing is that traders should be liable for their licensee's wrongdoing in connection to its trademark or – at the very least – traders who are either ignorant of their licensee's activities or unaware of outsourcing to sub-licensees should be deemed to have lost control over the trademark.<sup>469</sup> This idea of

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<sup>466</sup> *Trademarks Act*, SC 1953, 1-2 Eliz II, c 49. The United States already permitted trademark licensing in 1946, as did the United Kingdom in 1938.

<sup>467</sup> *Trademarks Act*, *supra* note 19, s 50(1).

<sup>468</sup> Naomi Klein, *No Logo: Taking Aim at the Brand Bullies* (Great Britain: Flamingo, 2000) at 7-8 (“It took several decades for the manufacturing world to adjust to this shift. It clung to the idea that its core business was still production and that branding was an important add-on. Then came the brand equity mania of the eighties, the defining moment of which arrived in 1988 when Philip Morris purchased Kraft for \$12.6 billion-six times what the company was worth on paper. The price difference, apparently, was the cost of the word KRAFT.”) [Klein].

<sup>469</sup> Vaver, *supra* note 21 at 466 (“Still, sloppy practices can cause non-distinctiveness. Bell Canada's registrations of WATS, CALLING CARD, and 900 SERVICE for telephone services were expunged because Bell had not exercised control over the way regional telephone companies used the marks Bell had licensed to them.”).



trademark liability is not new, as trademarks historically was a basis for punishing craftsmen for defective work and confiscating foreign goods.<sup>470</sup> Although Schechter would disagree, this ideal is consistent with the Supreme Court of Canada’s current position that a trademark “allows consumers to know, when they are considering a purchase, who stands behind those goods or services.”<sup>471</sup>

The first question is whether the liability extends beyond the license to the benefit of third parties. Opponents could argue that there is neither statutory nor judicial authority for this position because “[Canada’s *Trademarks Act*] does not provide for the liability of a trademark licensor ... [and] Canadian courts have not imposed an affirmative obligation on a trademark owner in favor of a third party.”<sup>472</sup> Supporters could counter that “[the statutory] requirement for control by a trademark owner of the activity by a licensee in association with a licensed mark ... [and] Canadian decisions that have imposed liability on a trademark licensor for acts or omissions of its licensee.”<sup>473</sup> For example, Canadian and American courts held traders liable for a consumer injured by a franchisee’s hot soup,<sup>474</sup> a house fire due to a lawnmower,<sup>475</sup> a broken nose due to an umbrella,<sup>476</sup> and a consumer injured by a licensee’s taxi door.<sup>477</sup> Although *Singh v Trump*<sup>478</sup> recently contradicted the possibility of such liability, the summary judgment motions only stated that traders are not liable for a licensee’s egregious negligence without actually discussing either the statutory requirement for a licensor to control or the licensor’s duty to vet licensees. We must ask why traders should not be liable for their licensees’ wrongdoing in

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<sup>470</sup> Schechter, *supra* note 6 at 814.

<sup>471</sup> *Masterpiece*, *supra* note 99 at para 1.

<sup>472</sup> Sheldon Burshtein, “‘The Donald’ Trumps Claim for Misrepresentations by Licensee” (2016) 106:4 INTA Trademark Reporter 783 at 785 [Burshtein].

<sup>473</sup> Burshtein, *supra* note 472 at 788.

<sup>474</sup> *LaFlamme v Group TDL Ltée*, 2014 QCCS 312.

<sup>475</sup> *Automobile Insurance Co of Hartford v Murray, Inc.*, 571 F Supp (2d) 408 (WDNY 2008).

<sup>476</sup> *Kennedy v Guess, Inc.*, 806 NE (2d) 776 (Ind Sup Ct 2004).

<sup>477</sup> *Fraser v U-Need-A-Cab Ltd* (1983) 43 OR (2d) 389 (Ont HCJ), *aff’d* (1985) 50 OR (2d) 281 (Ont CA).

<sup>478</sup> *Singh v Trump*, 2015 ONSC 4461, *rev’d* 2016 ONCA 747.

connection to their trademarks when a licensor can be liable for a licensee's wrongdoing for infringement.<sup>479</sup> A couple of scholars have suggested that consumers should be able to sue traders for false or deceptive advertising, for goods or services that fall short of the promised quality, and not controlling licensees.<sup>480</sup>

The second question is whether the liability extends beyond defects in a product to the employment conditions and environmental standards of its production. Opponents could argue that there is no statutory authority for this position by contrasting section 50(1) on licensing with section 12(1)(b) on descriptiveness. The former was limited to the character or quality "of the goods or services" while the latter included the character or quality "of the goods or services in association with which it is used or proposed to be used or of the conditions or the persons employed in their production or of their place of origin", which show that the drafters did not intend for the term "character or quality" to include circumstances. Supporters could counter that the employment conditions and environment standards under which the goods or services are produced form a part of the character or quality.<sup>481</sup> Ask any Canadian who boycotts JOE FRESH's cheap clothing for exploiting child labour, and buys CANADA GOOSE's expensive coats for employing Canadians and supporting scientists (or so it did before selling its majority shares to an American company).

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<sup>479</sup> Gill, *supra* note 367 at 7.2(c)(ii-iii) ("The licensor, even if not using the impugned trading indicia, is nevertheless holding itself out as being able to use it and, whether to do so themselves or induce others, such as licensees, which would bring the licensor properly within the confines of a *quia timet* infringement action.").

<sup>480</sup> Maniat & Sanders, *supra* note 361.

<sup>481</sup> Klein, *supra* note 468 at 198 ("Which is why many companies now bypass production completely. Instead of making the products themselves, in their own factories, they 'source' them, much as corporations in the natural-resource industries source uranium, copper or logs. They close existing factories, shifting to contracted-out, mostly offshore, manufacturing. And as the old jobs fly offshore, something else is flying away with them: the old-fashioned idea that a manufacturer is responsible for its own workforce. Disney spokesman Ken Green gave an indication of the depth of this shift when he became publicly frustrated that his company was being taken to task for the desperate conditions in a Haitian factory that produces Disney clothes. 'We don't employ anyone in Haiti,' he said, referring to the fact that the factory is owned by a contractor. 'With the newsprint you use, do you have any idea of the labour conditions involved to produce it?').

The third question is whether the liability extends beyond Canadian borders to other countries. The statute is clear in its reference to a “country” three times that it anticipates the licensing, use and subsequent enurement of trademark rights by the licensor in any country. This would be consistent with the rationale of joining international trade agreements.<sup>482</sup> There is also American case law to support holding traders liable for an accident in China due to an elevator bearing an American trademark,<sup>483</sup> as well as an accident in the United Kingdom due to a car tire bearing an American trademark.<sup>484</sup> Can or should this be extended to human rights abuses involving trademarks? This question is especially relevant with respect to foreign-language marks because traders are less likely to use every language and more likely to have licensees in every country using the language of that country. Although he was not speaking on trademarks (much less on vicarious liability from its licensing), then Supreme Court of Canada Justice Binnie had given speeches and written articles stating that Canadian businesses in developing countries must beware of human rights abuses even though they have “no body to imprison, no soul to damn and no conscience to trouble.”<sup>485</sup>

#### **7.2.4 Right to Translate**

In his days, Schechter had no success persuading law makers<sup>486</sup> to expand rights and his article was challenged by prominent writers such as Cohen<sup>487</sup> and Brown.<sup>488</sup> Ninety years later,

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<sup>482</sup> For example, the Madrid Protocol extends a trademark registration in one member country to other countries. Likewise, the Paris Convention extends a trademark’s application date in one member country to the other countries where the same applications are filed within six months. Finally, the Paris Convention protects a famous mark in all member countries.

<sup>483</sup> *Lou v Otis Elevator Co*, 933 NE (2d) 140 (Mass App Ct 2010).

<sup>484</sup> *Torres v Goodyear Tire & Rubber Co*, 786 P (2d) 939 (Ariz Sup Ct 1990).

<sup>485</sup> Philip Slayton, *Mighty Judgment: How the Supreme Court of Canada Runs Your Life* (Toronto: Penguin Books Ltd, 2011) at 173.

<sup>486</sup> NG-LOY on Anti-Dilution, *supra* note 409 at paras 7-8 (“Schechter even appeared in 1932 before a US congressional committee to urge the enactment of an anti-dilution law that he had drafted. ... The US Congress,

like wine that aged well or like Mozart's posthumous success, Schechter is celebrated as the Father of Anti-Dilution<sup>489</sup> even as his article continues to be challenged by current scholars such as Beebe<sup>490</sup> and Lemley.<sup>491</sup> How did this change evolve? Was it the creation of corporations and recognition of their "human" rights?<sup>492</sup> Was it the deregulation and privatization of basic services that are lucrative, such as education and healthcare?<sup>493</sup> Was it the commercialization and "proPERTIZATION" of words?<sup>494</sup>

Regardless of how this change evolved, it is adding to the challenge of keeping trademark law from turning into unfair competition law. Ninety years after Schechter's article, we are faced now with a wide gap between traders and consumers as a result of dilution and licensing, and we must beware not to widen it further through foreign-language marks. Recognizing foreign-language marks as meaningful words instead of inarticulate designs opens the door for traders to claim that a foreign-language mark is identical or similar to a registered trademark. This must not be allowed because the translation problems discussed in Chapter 3 – as well as the issues of trademark distinctiveness and likelihood of confusion discussed in Chapter 5 – illustrated that the

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however, did not grant Schechter his wish at that time. It was only much later that the Federal Trademark Dilution Act of 1995 was enacted ...").

<sup>487</sup> Cohen, *supra* note 399.

<sup>488</sup> Brown, *supra* note 420.

<sup>489</sup> NG-LOY on Anti-Dilution, *supra* note 409 at para 4.

<sup>490</sup> Beebe on Schechter, *supra* note 405.

<sup>491</sup> Lemley, *supra* note 405.

<sup>492</sup> *Canada (AG) v JTI-Macdonald Corp*, 2007 SCC 30 at para 34 ("When the *Charter* was adopted, the question arose of whether the free expression guarantee extended to commercial expression by corporations. The Court ruled that it did: *Irwin Toy Ltd v Quebec (AG)*, [1989] 1 SCR 927. ... It noted that commercial speech may be useful in giving consumers information about products and providing a basis for consumer purchasing decisions: *Ford v Quebec (AG)*, [1988] 2 SCR 712, at pp 766-67."). It is important to note that although *Irwin Toy* recognized that corporations have a section 2(b) right to "freedom of thought, belief, opinion and expression, including freedom of the press and other media of communication" under the *Charter*, corporations have no section 7 right to "life, liberty and the security of the person and the right not be deprived thereof except in accordance with the principles of fundamental justice" under the *Charter*.

<sup>493</sup> Maude Barlow, *Profit is not the Cure: A Citizen's Guide to Saving Medicare* (Toronto: McClelland & Stewart Ltd, 2002) at 3 ("An international private service industry, anxious to get its hands on the estimated CAD\$4 to \$5 trillion global health care sector, is seeking out and finding friendly governments – including the Chrétien Liberals in Ottawa – in order to profit from this lucrative sector.").

<sup>494</sup> Klein, *supra* note 468.

courts cannot assume that a foreign-language mark is intended to be translated or what the translation will be. It is only too easy with hindsight for traders to claim that a translation naturally would be associated with a trademark and, therefore, its use infringes or depreciates the goodwill of a registered trademark. Such traders are like over-sensitive claimants of libel and slander: ♪ they're so vain ♪ they think everything is about them ♪.

The comments above do not change the possibility of dilution applying to foreign-language marks in the same manner that it applies to English-language marks. Dilution used to mean little to foreign-language marks. The spectrum running from a restrictive to an expansive framework had limited application when the case law always imagined *the illiterate consumer*. The inclusion of linguistic knowledge in the case law, however, means that foreign-language marks can also range from restrictive to expansive. The subsections below will continue to review the stories of The Coca-Cola Company and the two Chinese bakeries in Canada to illustrate how imagining *the fluent consumer* raises the possibility that traders may use an expansive framework to prohibit dilution by “blurring”, dilution by “tarnishing”, and “free riding”.

#### **7.2.4.1 Dilution by Blurring**

The SAINT HONORE marks were refused registration because they were used in association with similar products to the ANNA marks and were confusing with them. If linguistic knowledge is included in the test for confusion, such linguistic knowledge should eventually become relevant in other tests as well, including the test for dilution. As a result, it may be possible to claim that the SAINT HONORE marks dilute the ANNA marks by blurring them in the mind of *the fluent consumer* in two ways.

First, the SAINT HONORE marks may dilute the ANNA marks by blurring their meaning. The Chinese characters 安娜 used to mean only ANNA, as arbitrarily chosen by the owners of the ANNA marks. Then they were given the new meaning HONORE, as arbitrarily translated by the owners of the SAINT HONORE marks. Support for this position comes from *Visa International Service Ass'n v JSL Corp.*<sup>495</sup> The word “visa” used to be only a word in the English dictionary. The plaintiff made it famous as the VISA mark in association with credit card and financial services. The defendant used it as the EVISA mark in association with multilingual education and information services. Although the defendant was only doing what the plaintiff had done by using the word for a new purpose, the plaintiff still sued and won for dilution because the meaning of the VISA mark had been blurred:

“This multiplication of meanings is the essence of dilution by blurring. Use of the word “visa” to refer to travel visas is permissible because it doesn’t have this effect; the word elicits only the standard dictionary definition. Use of the word visa in a trademark to refer to a good or service other than a travel visa, as in this case, undoubtedly does have this effect; the word becomes associated with two products, rather than one. This is true even when use of the word also gestures at the word’s dictionary definition.”<sup>496</sup>

Second, the SAINT HONORE marks may dilute the ANNA marks by blurring their source. The Chinese characters 安娜 used to refer only to the bakery owned by Cheung’s Bakery. Then the variation 聖安娜 came to refer also to the bakery owned by Saint Honore

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<sup>495</sup> *Visa Int’l Service Ass’n v JSL Corp.*, 610 F (3d) 1088 (9th Cir 2010) [*Visa*].

<sup>496</sup> *Visa*, *supra* note 495 at 1092.

Cake Shop. Support for this position comes from *Coca-Cola v Busch*.<sup>497</sup> The plaintiff advertised its products in association with the COCA-COLA mark, which the public abbreviated as COKE. Since the plaintiff never used the abbreviation, the defendant started using the variation KOKE to sell similar products. After persuading a court that use by others of the COKE abbreviation should enure to it as the owner of the COCA-COLA mark, the plaintiff then argued that the source of the abbreviation had been blurred by the variation.

#### **7.2.4.2 Dilution by Tarnishing**

It may also be possible to claim that the SAINT HONORE marks dilute the ANNA marks by tarnishing them in the mind of *the fluent consumer*. Comparing the Chinese characters 聖安娜 in one party's marks and the same Chinese characters 安娜 in the other party's marks indicates a difference of only one Chinese character: 聖. The *fluent consumer* would know that the Chinese character 聖 means "holy" and is the root word of multiple Christian and Catholic terms in Chinese.<sup>498</sup> If a trader is anti-religious, or strongly religious in a faith other than Christianity or Catholicism, then attaching the Chinese character 聖 to its trademark could be considered tarnishing.

The same thing could easily happen to COCA-COLA's translation 可口可樂 because the last character for "happy" can also mean "music". A savvy karaoke bar could use the same four characters to suggest "happy mouth" or "music in the mouth", or emphasize both food and entertainment with the translation "delicious music". The Coca-Cola Company could claim dilution by tarnishing of its happy and wholesome reputation with evidence that karaoke bars are

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<sup>497</sup> *Coca-Cola v Busch*, supra note 174.

<sup>498</sup> For example: 聖餐 means Holy Meal (Communion); 聖誕 means Christmas; 聖地 means Holy Land; 聖父 means Holy Father (Pope); 聖經 means Holy Text (Bible); 聖靈 means Holy Spirit; 聖母 means Holy Mother (Madonna).

frequented by jilted lovers and gangster wannabes. It may also claim blurring or confusion if the karaoke bar also sells COCA-COLA products, as such bars often do. The argument for blurring becomes even stronger once we realize that the last Chinese character for “happy” changes its pronunciation when it means “music”, so that COCA-COLA’s priceless pronunciation KE3 KOU3 KE3 *LE4* would become the awkwardly pronounced KE3 KOU3 KE3 *YUE4*.

### **7.2.4.3 Free Riding**

American anti-dilution law is limited to blurring and tarnishing, as it does not protect against free riding like European anti-dilution law.<sup>499</sup> Canada’s depreciation of goodwill is more expansive than the American anti-dilution law because it may possibly go beyond blurring and tarnishing, in addition to not requiring fame and not having any limits as defences. As a result, it may also be possible to claim that a Chinese-language mark is free-riding on the Chinese translation for COCA-COLA in the mind of *the fluent consumer* in three ways.

First, initial interest confusion may prohibit the savvy karaoke bar described above from using its Chinese-language mark in order to attract Chinese clients. Although initial interest confusion is used to catch a consumer’s attention, the confusion is only temporary in that there is no actual confusion by the point of purchase.<sup>500</sup> The hybrid nature of initial-interest-confusion but no-actual-confusion raises uncertainty as to whether this is infringement or depreciation (or both). Although the United States accepts this to be infringement,<sup>501</sup> Canada’s Federal Court of

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<sup>499</sup> This is explained by NG-LOY on Anti-Dilution, *supra* note 409 at paras 67-68 (“According to Posner J, there is no justification from an economics (cost-benefit) analysis to provide protection against free riding. ... To put his argument in another way, a right against free riding does not further the economic aim of trade mark law, which is to provide an incentive to trade mark proprietors to create and develop a trade mark with a strong reputation.”).

<sup>500</sup> *Hearts on Fire Co v Blue Nile, Inc*, 603 F Supp (2d) 274 (D Mass 2009) at 283.

<sup>501</sup> Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, 4th ed (USA: Thomson Reuters, 2010) at § 23:6 (“Infringement can be based upon confusion that creates initial customer interest, even though no actual sale is finally completed as a result of the confusion.”).



Appeal seems to reject this as an example of infringement and left open the possibility of this being an example of trademark depreciation.<sup>502</sup>

Second, cybersquatting may prevent users such as competitors, consumers, or citizens from having websites that compare, comment on, or criticize COCA-COLA products.<sup>503</sup> The Coca-Cola Company could claim free-riding even if there is no confusion with respect to the Chinese equivalents of [www.Coca-ColaHasMoreCaloriesThanPepsi-Cola.com](http://www.Coca-ColaHasMoreCaloriesThanPepsi-Cola.com), [www.Coca-ColaSucks.com](http://www.Coca-ColaSucks.com), or [www.Coca-ColaViolatesLabourStandards.com](http://www.Coca-ColaViolatesLabourStandards.com). The users could counter-argue that the websites are an exercise of their constitutional right to free speech. Such a defence would be unsuccessful, however, for the owner of [www.kekoukele.com](http://www.kekoukele.com). This website is not owned by The Coca-Cola Company, and its only purpose is to redirect searchers to WeChat (the Chinese equivalent of Facebook & WhatsApp combined).

Third, comparative advertising may prohibit a Chinese company from advertising itself as “the Chinese alternative to 可口可樂” with a chart listing its Asian-flavoured counterparts to COCA-COLA, SPRITE, FANTA, VITAMINWATER, HONEST TEA, *etc.* This may sound implausible until one remembers that Western desserts like ice-cream and snacks like KitKat originally had limited appeal to Asian palettes. That appeal grew exponentially, however, with new Asian flavours such as “black sesame/ ginger/ green tea/ mango/ red bean” ice-cream and “aloe/ matcha/ taro/ sake/ wasabi” KitKats. Although the chart’s information may be truthful and useful to consumers, such comparative advertising would be prohibited according to *Clairol Int’l*

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<sup>502</sup> See the concurring reason in *Red Label Vacations Inc (Redtag.ca) v 411 Travel Buys Limited (411 Travel Buys Limited)*, 2015 FCA 290 at paras 35-36 (“With respect to trademark infringement, ... the use of the plaintiff’s trademarks would not give rise to confusion because their use did not entice a consumer to visit 411 Travel Buys’ website. Rather, a consumer maintains a choice over which website he or she wishes to visit ....”) and at para 40 (“... the judge found the plaintiff had failed to establish the use of its trademarks in a manner likely to have any effect on the goodwill associated with the trademarks.”).

<sup>503</sup> Dinwoodie on Domain Name, *supra* note 394.

*Corp. v. Thomas Supply & Equipment Co.*<sup>504</sup> The plaintiff and the defendant there both sold hair dye. The defendant used colour comparison charts to show which of its hair dye corresponded with the plaintiff's hair dye. Although this was truthful information of use to consumers looking to switch brands but afraid to risk the possibility of an unexpected change in colour, the court still decided that such information depreciated the plaintiff's goodwill:

“Depreciation of that value in my opinion occurs whether it arises through reduction of the esteem in which the mark itself is held or through the direct persuasion and enticing of customers who could otherwise be expected to buy or continue to buy goods bearing the trademark.”<sup>505</sup>

It is clear from this chapter that assuming linguistic knowledge for all foreign-language marks promotes the dual purposes of trademark law, as doing so focuses the evidence on the trademarks as they are and the association between them, which allows their distinctiveness and confusion to be assessed in the same manner as trademarks in the official languages. This stops the expansion of rights by minimizing claims that any and all foreign-language marks infringe or dilute a registered trademark. In this regard, protecting both consumers and traders is impossible nowadays without considering Canada's multicultural heritage. Even now, there are dissatisfied traders who advocate successfully for more recognition of well-known marks or new recognition of unconventional marks – such as scent, sound, colour and shape.<sup>506</sup> The obsession with expanding rights for well-known marks or creating rights for unconventional marks is strange,

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<sup>504</sup> *Clairol Int'l Corp v Thomas Supply & Equipment Co*, 55 CPR 176, 38 Fox Pat C 176 (Can Ex Ct). Further support for such a position comes from an European perfume maker persuading the European Court of Justice to prohibit a competitor from using its registered trademarks on a comparison list in *L'Oreal SA v Bellure NV*, [2009] EUECJ C-487/07 (CA (Civ Div) 2009) [*Clairol*].

<sup>505</sup> *Clairol*, *supra* note 504.

<sup>506</sup> David Vaver, “Unconventional and Well-Known Trade Marks” (2005) *Sing J Legal Stud* 1. And see *Bill C-31*, *supra* note 28.

especially when compared with the lack of attention paid to foreign-language marks that are more numerous and have a greater impact on Canadians. Canada's current trademark reforms continue to ignore foreign-language marks that are registered already or that are more significant by number and value, even as it expands the definition of a trademark to extend rights to unconventional marks.<sup>507</sup> The judicial development of the test for confusion makes up for the legislative neglect. Otherwise, other traders would be expanding their trademark rights while foreign-language traders might not even be able to prove trademark infringement under the test for confusion. That is why the court's recognition of linguistic knowledge is welcomed, not because foreign-language traders wish to expand trademark law, but rather because multicultural consumers are now being acknowledged as relevant members of Canadian society whose languages and cultures matter.

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<sup>507</sup> *Bill C-31*, *supra* note 28.

# CONCLUSION

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The law has developed its legal fictions for the trademark consumer. Now that the social construct no longer ignores linguistic knowledge, the fictitious character of the newly fledged *fluent consumer* raises new challenges.

These challenges are pressing matters administratively and judicially. This is clear from my discussion of the linguistic problems that impact trademark registrations and litigation. The problems highlighted by two Canadian case studies of Chinese-language trademarks give rise to my solutions, the general principles of which can also be applied in other countries and to other foreign languages. The solutions are tested through my application to the criteria for trademark registrability, as well as to the trader's rights against infringement, against depreciation of goodwill, to license, and to translate. This vertical analysis is done in a comparative setting that horizontally canvasses the alternative approaches taken by both Western and Asian countries with official languages that are only Romanized (the United States), both Romanized and not Romanized (the European Union and Singapore), and only not Romanized (China).

These challenges can also be addressed legislatively. This is unlikely to happen since such discussions were absent during and continue to be absent after the 1953 Trade Mark Law Revision Committee. The absence is understandable in light of how little impact the linguistic problems had on trademark registrations and litigation back then. The growing awareness of international businesses and multicultural consumers may influence legislative members to take action now. But should such action be limited to economic and international trade concerns? What of social and human rights causes?

These challenges draw attention to why trademark law exists and, more importantly, whom trademark law benefits. Since one of the beneficiaries – and the focus of the test for confusion – is the consumer, this naturally involves drawing attention to social causes that are important to Canadian consumers: Aboriginal language rights, Constitutional freedom of speech, and safeguards against expanding trademark rights. I avoided using critical legal theory to advance a human rights discourse on how supposedly impartial administrative practices and judicial decisions produce preferential outcomes because I saw no point in preaching to choir members and I had no faith in converting business leaders. This is why I focused on business concerns that would serve as incentives for businesses to litigate or lobby for changes. Although I protested against businesses co-opting social causes, I had no qualms about myself co-opting business concerns because traders need consumers. The current business strategy is to invite, encourage, and depend upon consumers to respond to, participate in, and engage with trademarked mottos, slogans, or taglines. Having invited in the consumer, such businesses cannot keep out consumer causes.

The answers to the new challenges may not be easy but they can affect outcomes on distinctiveness and confusion – with implications for traders investing in businesses, consumers awaiting recognition of their languages and cultures, and a country concerned with issues of international trade and multicultural heritage in a global economy. It is important to develop a workable model now for assessing the consumer in cases involving foreign-language marks to ensure the consistency and credibility of the legal fiction of *the fluent consumer*.

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