

AIPPI Questionnaire on Geographical Indications - CANADA

1) *Are GIs and/or AOs protected under your Group's current law?*

Canadian law protects GIs and/or AOs in a variety of ways:

1. GIs in respect of wines and spirits are protected under the *Trade-Marks Act*:

“Geographical indications” are protected under the *Trade-Marks Act*, RSC 1985, c T-13, but only those GIs for wines and spirits. Although not explicitly mentioned in the Canadian statute, it is believed that Appellations of Origin and Denominations of Origin fall within the broad understanding of Geographic Indications.

2. Certification marks under the *Trade-Marks Act* protect goods of a certain standard:

A “certification mark” is a “mark that is used for the purpose of distinguishing... goods or services that are of a define standard” (per the definition under section 2 of the *Trade-marks Act*). A certification mark’s standard may be defined in respect of “the area within which the goods have been produced or the services performed”.

A certification mark may be descriptive of the place of origin of the goods in question so long as the registrant is an administrative authority of a country, state, province or municipality including or forming part of the area indicated by the mark, or is a commercial association having an office or representative in that area.

3. The doctrine of “shared goodwill” protects marks held by a group of persons:

At common law, the doctrine of “shared goodwill” provides a shared right in a name or symbol to all those goods or services that conform to the standards of production or geographical region which the term at issue has become associated. This right creates a common, several cause of action in passing off for each producer of goods of that named method of production or geographical region.

“Shared goodwill” was adopted in Canadian law in *Institut National des Appellation d’Origine des Vines et Eaux-de-Vie v Andres Wines Ltd*, [1987] OJ No 644, 16 CPR (3d) 385 (Ont HCJ). In that case, producers of Canadian sparkling wine who called their product “Canadian champagne” were sued by French champagne producers over the use of the word “champagne”. However, no element of confusion was found due to the equal prominence of the word “Canadian”.

4. False and misleading advertising is prohibited under the *Competition Act*.

Part VII.1 of the *Competition Act*, 1985, c C-34 comprises its “Deceptive Marketing Practices” provisions. These prohibit false and misleading misrepresentations to the public. Under section 74.01(1), any person “for the purpose of promoting, directly or indirectly, the supply or use of a product or... any business interest, by any means whatever” must not make representations to the public that are either “false or misleading in a material respect” (74.01(1)(a)).

Such misrepresentations constitute “reviewable conduct” pursuant to which the Commissioner of Competition may apply for an order to stop the representations, publish a corrective notice, pay and administrative monetary penalty, costs, and possibly restitution to deceived customers.

AIPPI Questionnaire on Geographical Indications - CANADA

The *Competition Act*, 1985, c C-34 prohibits false and misleading representations to the public through a dual criminal and civil scheme.

Section 52 of the *Act* is a criminal provision. It prohibits knowingly or recklessly making, or permitting the making of, a representation to the public, in any form whatever, that is false or misleading in a material respect. Under this provision, it is not necessary to demonstrate that any person was deceived or misled; that any member of the public to whom the representation was made was within Canada; or that the representation was made in a place to which the public had access. Subsection 52(4) directs that the general impression conveyed by a representation, as well as its literal meaning, be taken into account when determining whether or not the representation is false or misleading in a material respect.

Any person who contravenes section 52 is guilty of an offence and liable to a fine of up to \$200,000 and/or imprisonment up to one year on summary conviction, or to fines in the discretion of the court and/or imprisonment up to 14 years upon indictment.

Paragraph 74.01(1)(a) of the *Act* is a civil provision. It prohibits the making, or the permitting of the making, of a representation to the public, in any form whatever, that is false or misleading in a material respect. Under this provision, it is not necessary to demonstrate that any person was deceived or misled; that any member of the public to whom the representation was made was within Canada; or that the representation was made in a place to which the public had access. Subsection 74.03(5) directs that the general impression conveyed by a representation, as well as its literal meaning, be taken into account when determining whether or not the representation is false or misleading in a material respect.

2) If yes, please briefly describe the following:

a) How AOs and GIs are defined and the prerequisites (in particular the type, nature and intensity of link with a territory).

Currently, GIs are only recognized in respect of wine and spirits. They are defined as an indication that “identifies the wine or spirit as originating in the territory of a WTO Member, or a region or locality of that territory, where a quality reputation or other characteristic of the wine or spirit is essentially attributable to its geographical origin” (section 2). If the GI does not originate within Canada, it must be protected under the WTO Member’s laws.

N.B. The amendments resulting from the implementation of the Comprehensive European Trade Agreement between Canada and the EU (“CETA”) will expand the definition of GIs to include certain categories of agricultural and food products. All CETA amendments are not in force, however the government had provisionally set a date for July 1.)

b) Whether that protection is provided by sui generis laws; solely as aspects of other laws, such as by registration as collective or certification marks; or by other (and if so, what) means.

Sui generis laws exist under the *Trade-marks Act* for GIs in respect of wines and spirits. However, protections for other kinds of GIs are provided by (a) registration as

AIPPI Questionnaire on Geographical Indications - CANADA

certification marks, (b) the common law doctrine of shared goodwill, and (c) the general prohibition on false or misleading advertising under the *Competition Act*.

N.B. The amendments resulting from the implementation of CETA will expand the sui generis system of protection of GIs to certain categories of agricultural and food products.

c) If GIs and/or AOs are protected by sui generis laws, whether your Group's laws provide for a system of registration. If so, what are the steps of this procedure including the content of the application and the possibility of opposition by third parties.

1. Registration of "Geographical Indications"

The *Trade-marks Act* contains a fairly detailed system of registration for geographical indications. Sections 11.11 to 11.2 govern this system.

Section 11.12(1) provides for the establishment of a list under the supervision of the Registrar of trademarks of GIs (for wines and spirits). A request for a GI to be entered onto the list must be submitted to Agriculture and Agri-Food Canada care of the Trademarks Office.

A request for protection of a GI must be submitted by a responsible authority for the wine or spirit in question. The responsible authority is "the person, firm, or other entity that, in the opinion of the Minister of Industry Canada, is, by reason of state or commercial interest, sufficiently connected with and knowledgeable of that wine or spirit to be party to any proceedings in respect of an objection filed under section 11.13(1) of the *Trade-marks Act*" (11.11). The responsible authority is responsible for providing the information required for a GI request and responding to any related objections and/or questions. Agriculture and Agri-Food Canada will review and recommend publication of a geographical indication, but the Ministry of Industry manages the list.

Section 11.12(2) provides that names are added to this list by statement of the Minister of Industry, which is published in the *Canada Gazette*, and which is subject to objection under the provisions of section 11.13.

Section 11.12(3) provides that the Minister's statement must include the indication, whether it identifies a wine or a spirit, the territory, region or locality of a territory in which the wine or spirit is identified as originating, the name of the responsible authority in relation to that wine or spirit, and the "quality, reputation, or other characteristic of the wine or spirit that, in the opinion of the Minister, qualifies the indication as a geographical indication".

(N.B. CETA amendments will require that the statement include a translation of the GI.)

Section 11.12(4) provides that GIs may also be removed from the list by the Registrar following the publication of a statement by the Minister that the indication should be removed.

(N.B. CETA amendments will also allow registrar to correct any obvious error to the entry or its translation apparent from the documents on file.)

AIPPI Questionnaire on Geographical Indications - CANADA

After publication, provision is made for third parties to object. Section 11.13(1) provides that objections to any proposed addition to the list must be made within three months of the publication of the Minister's statement in the *Canada Gazette*.

(N.B. CETA amendments will shorten the period for objection from three to two months.)

Per 11.13(2), the only allowable basis for objection is that the proposed indication is not a geographical indication.

(N.B. CETA amendments will expand the grounds of objection to include: (a) the proposed GI or its translation is identical to a term customary in common language; (b) the proposed GI or its translation is not protected under the law of the country of origin; (c) the proposed GI or its translation is confusing with a registered, applied-for, or common law trade-mark at the time the Minister proposes to add it to the list; (d) the proposed translation is not a faithful one. (Subsections 11.13(2)-(2.1)).

The CETA amendments will add factors to consider when determining whether an indication is confusing with a trademark. While the Registrar or the Federal Court must have regard to all the surrounding circumstances, they are specifically instructed to consider:

- a. The length of time that the indication has been used to identify the product with which it is associated as originating in the territory, and the extent to which it has become known;*
- b. The degree of resemblance between the indication and the trade-mark, including in appearance or sound or in the ideas suggested by them; and*
- c. With respect to the trade-mark, its inherent distinctiveness and the extent to which it has become known, the length of time of its use and the nature of the goods, services or business associated with it (s 11.11(3)-(4))*

Also, the amendments provide greater power to the Registrar to reject a statement of objection at its own discretion if it considers that the statement of objection does not raise a substantial issue for decision (s 11.11(3.1)).

Section 11.13(4) provides that the authority responsible for the GI must respond within three months after a statement of objection has been served, and must respond in the form of a counter-statement filed with the Registrar and served on the objector. If there is no response to the objection, the geographical indication is not entered on the list.

Section 11.13(5) provides that each the objector and the responsible authority may submit evidence and make representations to the Registrar.

Section 11.13(7) provides that the Registrar is ultimately charged to decide whether the indication is a GI and to communicate this decision to the parties.

If no objection is brought or if none is successful, a geographical indication may be entered on the list.

AIPPI Questionnaire on Geographical Indications - CANADA

2. Registration of Certification Marks

A certification mark is a trademark, and thus subject to the same application requirements as trademarks, with some variations. According to paragraph 30(f) and subsection 23(1), an applicant may file an application to register a certification mark as long as he/she is not engaged in the manufacture or sale of goods or the performance of services such as those covered by the mark.

As explained in the CIPO's *Examination Manual*, the owner of a certification mark may be engaged in activities other than certification, such as the sale of goods or the performance of services other than those covered by the certification mark. The owner may use the same mark as a certification mark on goods and as an ordinary trademark on services, or vice versa. However, the applicant cannot use the same trademark to both indicate defined standards for goods or services and use it as an ordinary trademark to distinguish those same goods or services from the goods or services of others, as the co-existence thereof would directly contradict the claims to use made in each application.

A certification mark which is descriptive of the place of origin of the goods or services is registrable if:

- a. the applicant is the administrative authority of a country, state, province, or municipality, including or forming part of the area indicated by the mark; or
- b. is a commercial association having an office or representative in such area.

The owner of any certification mark registered under section 25 shall permit the use of the mark in association with any goods or services produced or performed in the area of which the mark is descriptive.

An application for a certification mark must be in conformity with section 30. Currently, section 30 reads:

30 An applicant for the registration of a trade-mark shall file with the Registrar an application containing

- (a) a statement in ordinary commercial terms of the specific goods or services in association with which the mark has been or is proposed to be used;
- (b) in the case of a trade-mark that has been used in Canada, the date from which the applicant or his named predecessors in title, if any, have so used the trade-mark in association with each of the general classes of goods or services described in the application;
- (c) in the case of a trade-mark that has not been used in Canada but is made known in Canada, the name of a country of the Union in which it has been used by the applicant or his named predecessors in title, if any, and the date from and the manner in which the applicant or named predecessors in title have made it known in Canada in association with each of the general classes of goods or services described in the application;

AIPPI Questionnaire on Geographical Indications - CANADA

(d) in the case of a trade-mark that is the subject in or for another country of the Union of a registration or an application for registration by the applicant or the applicant's named predecessor in title on which the applicant bases the applicant's right to registration, particulars of the application or registration and, if the trade-mark has neither been used in Canada nor made known in Canada, the name of a country in which the trade-mark has been used by the applicant or the applicant's named predecessor in title, if any, in association with each of the general classes of goods or services described in the application;

...

(f) in the case of a certification mark, particulars of the defined standard that the use of the mark is intended to indicate and a statement that the applicant is not engaged in the manufacture, sale, leasing or hiring of goods or the performance of services such as those in association with which the certification mark is used;

(g) the address of the applicant's principal office or place of business in Canada, if any, and if the applicant has no office or place of business in Canada, the address of his principal office or place of business abroad and the name and address in Canada of a person or firm to whom any notice in respect of the application or registration may be sent, and on whom service of any proceedings in respect of the application or registration may be given or served with the same effect as if they had been given to or served on the applicant or registrant himself;

(h) unless the application is for the registration only of a word or words not depicted in a special form, a drawing of the trade-mark and such number of accurate representations of the trade-mark as may be prescribed; and

(i) a statement that the applicant is satisfied that he is entitled to use the trade-mark in Canada in association with the goods or services described in the application.

3) *If your country does not protect GIs and/or AOs, was this a deliberate decision and, if so, why?*

The lack of more robust protection for GIs and for any protection of AOs under sui generis laws is not the result of a deliberate decision. In fact, any protections that do exist are the result of international treaties. Sections 11.11 and 11.12 were only added to the *Trade-marks Act* in 1994 in order to satisfy Canada's international trade obligations under the TRIPs Agreement.

The lack of more robust protection for GIs in Canada may be due to its "lack of enduring traditions that link particular peoples with the production of certain goods linked to specific geographical territories" (Teresa Scassa, *Canadian Trademark Law* (Toronto: LexisNexis Canada, 2015). (In contrast to the many such enduring traditions that exist in European nations.)

AIPPI Questionnaire on Geographical Indications - CANADA

At common law, a mark that is “clearly descriptive or deceptively misdescriptive” of the place of origin of goods (or services) is not registrable as a trademark, nor is one that designates the place of origin of goods (or services). This prevents a single trade from obtaining a monopoly over the use of a geographic term that should be available for use by others.

So, the concept of “shared goodwill” can address issues related to geographical origin. Under this doctrine, the shared goodwill associated with a particular mark does not belong to any one trade—it is shared by all those whose goods or services genuinely conform to the standards of production or geographical region which the term at issue has become associated. In this view, the mark is not distinctive of a particular trade source, but it is considered distinctive of a particular kind of product that is associated with a particular region and/or method of production.

The *Trade-marks Act* also provides for the registration of certification marks where they are used “for the purposes of distinguishing or so as to distinguish goods or services that are of a defined standard” with respect to their character or quality, the working conditions under which they are produced, the class of persons by whom the goods have been produced or the area within which they are produced.

- 4) *What are the grounds of invalidity/loss of rights for GIs and/or AOs under your Group’s law (e.g. becoming generic, lack of use, not paying fees) and where can such be invoked (which court, office etc.)? Please specify the applicable test, how such is proven (e.g. consumer surveys, expert advice, dictionaries, etc.) and who bears the burden of proof.***

Grounds of Invalidity for Registered Geographical Indications

Section 11.12(4) provides that GIs may be removed from the list by the Registrar following the publication of a statement by the Minister that the indication should be removed.

(N.B. Currently, the Act only provides for removal at the discretion of the Minister. However, under the CETA amendments, a new section 11.21 provides any interested person with the opportunity to challenge the presence of an indication on the Registrar’s List of protected GIs.)

Under subsection 11.21 (1), on the application of any person interested, the Federal Court has exclusive jurisdiction to order the Registrar to remove an indication or a translation from the list of geographical indications kept under subsection 11.21(1) on any of the grounds set out in subsection (2) or (3), as the case may be.

Under subsection 11.21(2), the grounds for rejection include: the indication is not a GI; the indication is identical to customary term for the wine, spirit, or the agricultural product or food; the wine or spirit is not protected by the laws of the territory from which it originates; the agricultural product or food is confusing with a registered trademark or a previously used mark that has not been abandoned.

Interested parties cannot, however, apply for the removal of the protected EU GIs listed in Part A of the Annex 20-A of CETA, or for the protected Korean GIs also enumerated in section 11.23. Well known examples of GIs that cannot be removed include the European indicators “Prosciutto di Parma”, “Parmigiano Reggiano”, “Brie de Meaux”, “Aceto balsamico di Modena”

AIPPI Questionnaire on Geographical Indications - CANADA

and “Mortadella Bologna”, and Korean indicators such as “Korean Red Ginseng” and “Icheon Rice”.

The federal Court is given exclusive jurisdiction to summarily hear an application for such a challenge and to order the Registrar to remove an indication or translation from the Registrar’s List on any valid grounds (s 11.21(1)).

Grounds of Invalidity for Registered Certification Marks

Subsection 18(1) of the *Trade-marks Act* sets out the grounds on which the registration of a trademark may be invalidated:

18 (1) The registration of a trade-mark is invalid if

- (a) the trade-mark was not registrable at the date of registration;
- (b) the trade-mark is not distinctive at the time proceedings bringing the validity of the registration into question are commenced;
- (c) the trade-mark has been abandoned; or
- (d) subject to section 17, the applicant for registration was not the person entitled to secure the registration.

This sets out a total of four grounds for invalidity. A registration may also be expunged on the basis that “the registration is likely to unreasonably limit the development of any art or industry” (subsection 13(3)).

There also exist a few additional, non-statutory grounds for invalidity. For example, a registration may be invalidated if it was obtained based on an incomplete or misleading evidence, or based on false declarations of use. In *General Motors du Canada v Decarie Motors Inc*, Justice Desjardins of the Federal Court of Appeal stated:

[R]egistration can be invalidated by two kinds of mis-statements: (i) fraudulent, intentional mis-statements, and (ii) those that may be innocent but that are material in the sense that, without them, the section 12 barriers to registration would have been insurmountable.”

In *Remo Imports Ltd v Jaguar Cars Ltd*, the FCA indicated that a registration might also be invalidated if the trademark had been adopted for the purpose of deceiving or misleading the public. Any such mark would not qualify as a trademark because it would not be “adapted to distinguish the wares of the registrant because the trade-mark and its use are calculated to deceive and mislead the public.”

Where can such be invoked

While challenging the validity of a mark can be raised as a defence to an infringement action in any court of relevant jurisdiction, only the Federal Court has jurisdiction to actually cancel a registration (subsection 57(1)).

AIPPI Questionnaire on Geographical Indications - CANADA

Applicable Test

Trademark Not Registrable: Paragraph 18(1)(a)

Subsection 12(1) sets out the grounds for a trade-mark being not registrable:

12 (1) Subject to section 13, a trade-mark is registrable if it is not

(a) 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;

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

(d) confusing with a registered trade-mark;

(e) a mark of which the adoption is prohibited by section 9 or 10;

(f) a denomination the adoption of which is prohibited by section 10.1;

(g) in whole or in part a protected geographical indication, where the trade-mark is to be registered in association with a wine not originating in a territory indicated by the geographical indication;

(h) in whole or in part a protected geographical indication, where the trade-mark is to be registered in association with a spirit not originating in a territory indicated by the geographical indication; and

(i) 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.

A mark that is not registrable for any of the grounds listed in subsection 12(1) at the date of its registration is thus liable to be expunged.

Trademark Not Distinctive: Paragraph 18(1)(b)

The essence of a trademark is its capacity to distinguish the goods or services of one trader from those of another. Under the *Trade-marks Act*, “distinctive” when used in relation to a trademark, “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”. The definition of “trade-mark” also incorporates the requirement of distinctiveness. It provides that a trademark is:

AIPPI Questionnaire on Geographical Indications - CANADA

(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.

A mark that is not distinctive cannot function as a trademark. Thus, any registered trademark that is not distinctive is liable to be invalidated.

In *Labatt Brewing Co v Molson Breweries*, the Court articulated a test for distinctiveness in relation to goods. Distinctiveness requires that:

1. a mark and product be associated;
2. the owner uses this association between the mark and its product and is manufacturing and selling this product; and
3. this association enables the owner to distinguish its product from that of others.

The distinctiveness of a mark may be either inherent, acquired or both. Whether a mark is distinctive is a question of fact. The test is “whether a clear message has been given to the public that the wares with which the trade-mark is associated and used are the wares of the trade-mark owner and not those of another party” (*Tommy Hilfiger Licensing Inc v Produit de Qualite IMD Inc*, 2004 FCA 252, [2005] 1 FCR 148). Distinctiveness is assessed with regard to the “relevant universe”, in other words, the purchasing or consuming public, for the product or service.

Trademark Abandoned: Paragraph 18(1)(c)

The test for abandonment requires the applicant for expungement to demonstrate a period of non-use of the mark, as well as intent on the part of the owner of the mark to abandon it (*Promafil Canada Ltee v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)). Proof of non-use alone is insufficient to establish abandonment (*Tommy Hilfiger, supra*). However, courts have been prepared to infer an intent to abandon a mark from a long period of non-use (*Omega Engineering Inc v Omega SA* (2006), 56 CPR (4th) 210, [2006] FCJ No 1855 (QL)). Abandonment is determined with respect to Canada; it is not relevant that the mark may continue to be used in another jurisdiction (*Borden Inc v Hostess Food Products* (1989) 28 CPR (3d) 45 (FCTD)). Abandonment is a question of fact “that must be determined according to the circumstances of the case” (*Omega, supra*).

Registrant Was Not the Person Entitled: Paragraph 18(1)(d)

Because rights to a trademark can be acquired by use without registration (and the same is the case for marks that are “made known” in Canada), a party applying to register a trademark may simply be unaware of the existence of the prior use or making known, and the party otherwise entitled to register the mark may be unaware of the existence of the application. The *Trade-Marks Act* therefore provides that a registered trademark can be invalidated on the grounds that the party who registered it was not the party entitled to the registration.

Burden of Proof

Once registered, a trademark is presumed to be valid. (Section 19 of the *Trade-marks Act* gives the owner the exclusive right to its use “unless shown to be invalid”. Because the right exists

AIPPI Questionnaire on Geographical Indications - CANADA

unless the mark is shown to be invalid, section 19 is considered to create a presumption of invalidity (*Veuve Cliquot Ponsardin v Boutiques Cliquot Ltee*, 2006 SCC 23 at para 5, [2006] 1 SCR 824.) A party who wishes to challenge the validity of a registered trademark therefore bears the onus of establishing invalidity on a balance of probabilities (*JC Penney Co v Gaberdine Clothing Co*, [2001] FCJ No 1845 at para 6, 16 CPR (4th) 151 (FCTD)).

5) *What is the scope of protection of GIs/AOs under your Group's current law?*

The scope of protection of a GI differs depending on whether it is a registered GI, a registered certification mark, or an unregistered mark.

1. Registered GIs

Once on the Registrar's list, the GI becomes protected. The GI, or a translation of it into any language, may not be *adopted* for use "in connection with a business, as a trade-mark or otherwise" to identify a wine other than one originating in the territory indicated by the geographical indication, or a translation in any language of that GI (per section 11.14). The same prohibitions apply to GIs for spirits (section 11.15). (*N.B. And pursuant to CETA, the same prohibitions will apply to GIs in respect of certain categories of agricultural products and food. Also, there will be a further prohibition on using (in addition to adopting) GIs in respect of wines, spirits, or certain categories of agricultural products or foods.*)

However, there are several exceptions to these prohibitions.

First, a person may still use, in the course of trade, that person's name or the name of the person's predecessor-in-title, except where the name is used in such a manner as to mislead the public (subsection 11.16(1)).

Second, a person may still use a protected GI in comparative advertising unless such advertising appears on labels or packaging of the wine or spirit (subsections 11.16(2) and (3)).

Third, a person that made use of a GI in a continuous manner in good faith prior to April 15, 1994, the date that these provisions were added via amendment of the *Trade-marks Act*, may still do so. This right also extends to any use, whether in good faith or not, that has been continuous for at least 10 years prior to April 15, 1994. This third exception is limited only to use by "Canadians", which is defined to mean citizens or permanent residents of Canada. This foregoing exception is set out in section 11.17.

Fourth, the protection of a GI continues in Canada for only so long as that indication is protected by "laws applicable to the WTO Member for which the indication is protected" (subsection 11.18(1)). Protection will also cease in Canada if the GI has fallen into disuse in that member country.

Fifth, protection of GIs is limited by the extent to which the GI has become the customary name in Canada either for the wine or spirit itself (subsection 11.18(2)). For example, with the CETA amendments, this common names would include "Valencia Orange", "Parmesan", "Black Forest Ham", and "St George Cheese". A similar exception exists for a name of a grape variety that exists in Canada and that is used to produce the wine or spirit, if it was the customary name for that variety in Canada on or before the date on which the TRIPs Agreement came into force.

AIPPI Questionnaire on Geographical Indications - CANADA

More specifically, subsections 11.18(3) and (4) each contain a list of names of wines and spirits respectively that have become generic in Canada. Some examples listed are “Valencia Orange”; “Black Forest Ham”; “Parmesan”; and “St George Cheese”. The lists can be amended, with additions or deletions, by Order of the Governor-in-Council.

Sixth, the prohibitions on the adoption or use of GIs for wines or spirits do not apply where a person has adopted and used a GI as a trademark with no knowledge of the protected GI, and that person’s use of the mark has continued for five years or more with no proceedings brought against him (subsection 11.19(1)). The same exception also applies in where the mark has been registered in Canada and has been used with impunity for five years or more (subsection 11.19(2)).

Seventh, a final exception exists where a party has filed an application for or secured the registration of a trademark identical or similar to a geographical indication, or acquired trademark rights through use, prior to the coming into force of the amendments to the *Trade-marks Act* relating to geographical indications, or prior to the date on which the wine or spirit received protection in its own country, whichever date is later (subsection 11.2).

Lastly, GIs are protected by the provisions which deem a trademark non registrable if it is “in whole or in part a protected geographical indication”, and registration is being sought in relation to wines or spirits not originating in the territory indicated by the GI (subsection 12(1)(g) and (h)).

(N.B.: All of these protections will be extended to certain categories of agricultural and food products with the CETA amendments. Furthermore, the protections do not apply for the indications for “Jambon de Bayonne”, and “Beaufort” if their use has been maintained for at least 10 years prior to October 18, 2013, and “Nurnberger Bratwurst” if their use has been maintained for at least 5 years prior.)

2. Registered Certification Marks

Certain exclusive rights are attached to registered trademarks under section 19, 20, 22 of the *Trade-marks Act*. Section 19 gives the trademark owner the exclusive right to use his or her registered trademark; section 20 deems that the exclusive right to use a mark is infringed by the use or other dealing with a confusing trademark or trade name; and section 22 prevents anyone from using a registered trademark in such a way as to depreciate the value of the goodwill associated with the mark.

3. Unregistered marks

At common law, there is a broad scope of protection under the tort of passing off to those who possess shared goodwill in a mark. The tort of passing off is also codified under section 7 of the *Trade-marks Act*.

6) *Against what kind of conduct are GIs/AOs protected? For example, against use misleading consumers, parasitism and free riding.*

AIPPI Questionnaire on Geographical Indications - CANADA

1. Registered GIs

A protected GI is protected from the commercial adoption by another of the GI, or its translation, as a trademark or otherwise, in respect of a wine or spirit, as the case may be, not originating in the territory indicated by the protected GI (subsections 11.14 and 11.15).

2. Registered Certification Marks

A person is prohibited from: using a registered trademark which he does not own (section 19), using a trademark or trade name that is confusing with a registered trademark (section 20), and using a registered trademark in such a way as to depreciate the value of the goodwill associated with the mark (section 22).

3. Unregistered Marks / Groups Having Shared Goodwill in a Term

The common law tort of passing off protects those groups possessing shared goodwill in a particular term used in association with their goods or services. It is codified in section 7 of the *Trademarks Act*, but also exists at common law. Section 7 reads:

7 No person shall

(a) make a false or misleading statement tending to discredit the business, goods or services of a competitor;

(b) direct public attention to his goods, services or business in such a way as to cause or be likely to cause confusion in Canada, at the time he commenced so to direct attention to them, between his goods, services or business and the goods, services or business of another;

(c) pass off other goods or services as and for those ordered or requested; or

(d) make use, in association with goods or services, of any description that is false in a material respect and likely to mislead the public as to

(i) the character, quality, quantity or composition,

(ii) the geographical origin, or

(iii) the mode of the manufacture, production or performance

of the goods or services.

Furthermore, the concept of “shared goodwill” in passing off was definitively recognized by the House of Lords in *Erven Warnink B.V. and Another v J. Townend & Sons (Hull) Ltd and Another*, [1980] RPC 31. The “classic” form of passing off involves the plaintiff alleging that the defendant has attempted to pass off his or her goods or services as those of the plaintiff. In this form, the plaintiff is the owner of the good will or reputation that is being harmed by the defendant’s conduct. Cases involving “shared goodwill” present a different paradigm. In such cases, one or more plaintiffs allege that they are part of a group of traders who are entitled to sue a particular term in association with their goods or services. The goodwill associated with

AIPPI Questionnaire on Geographical Indications - CANADA

the term does not belong to any particular trader; it is shared by the group which is entitled to its use.

4. False or Misleading Advertising:

Further still, the *Competition Act* prohibits the use of deceptive marketing practices. Section 74.01(1)(a) of the *Competition Act* prohibits the making, or the permitting of the making, of a representation to the public, in any form whatever, that is false or misleading in a material respect. It is a civil provision (unlike its criminal counterpart section 52, *infra.*) Under this provision, it is not necessary to demonstrate that any person was deceived or misled; that any member of the public to whom the representation was made was within Canada; or that the representation was made in a place to which the public had access. Subsection 74.03(5) directs that the general impression conveyed by a representation, as well as its literal meaning, be taken into account when determining whether or not the representation is false or misleading in a material respect.

Section 52, a criminal provision, prohibits knowingly or recklessly making, or permitting the making of, a representation to the public, in any form whatever, that is false or misleading in a material respect. Under this provision, it is not necessary to demonstrate that any person was deceived or misled; that any member of the public to whom the representation was made was within Canada; or that the representation was made in a place to which the public had access. Subsection 52(4) directs that the general impression conveyed by a representation, as well as its literal meaning, be taken into account when determining whether or not the representation is false or misleading in a material respect.

7) Who has legal standing to protect a GI/AO. For example, individual producers, consortiums and associations, public bodies.

For Actions Brought under the Trade-marks Act

Under section 53.2(1) of the *Trade-marks Act*, “any interested person” has a right of action against someone for “any act [that] has been done contrary to this Act”, like using a GI or a Certification mark without right.

An “interested person” is defined in section 2 as “any person who is affected or reasonably apprehends that he may be affected by any entry in the register, or by any act or omission or contemplated act or omission under or contrary to this Act, and includes the Attorney General of Canada”.

For Actions Brought at Common Law

The right to an action in passing off lies with each in a group of producers who together own the shared goodwill in a GI. Each plaintiff would claim on its own behalf, in contrast with a class action.

For Actions Brought under the Competition Act

Under section 74.1, only the Commissioner of Competition may apply for an order from a court for various remedies addressing “reviewable conduct” under section 74.01(1)(a). However,

AIPPI Questionnaire on Geographical Indications - CANADA

under section 9, any six persons resident in Canada may apply to the Commissioner to inquire into a reviewable matter if they believe grounds exist for making an order under section 74.1. The Commissioner will ultimately decide whether an application should be made.

8) *What remedies are available in the case of violation of rights in a GI/AO?*

Several remedies exist in cases where there has been a violation of rights in both registered GIs and Certification Marks and unregistered GIs.

Under the Trade-marks Act:

Subsection 53.2(1) provides that a court “may make any order that it considers appropriate in the circumstances.” This includes “relief by way of injunction and the recovery of damages or profits, for punitive damages and for the destruction or other disposition of any offending goods, packaging, labels and advertising material of any equipment used to produce [such].”

At Common Law:

Remedies for the tort of passing off at common law include: an award of damages or the disgorgement of profits; a permanent injunction (to cease complained of activity); the delivery up or destruction of offending items; declaratory relief regarding the ownership of disputed mark; and punitive damages in cases where the defendant’s conduct warrants punishment.

Under the Competition Act:

If a court determines that a person has engaged in conduct contrary to paragraph 74.01(1)(a), it may order the person not to engage in such conduct, to publish a corrective notice, to pay an administrative monetary penalty and/or to pay restitution to purchasers. When the court orders the payment of administrative monetary penalties, on first occurrence, individuals are subject to penalties of up to \$750,000 and corporations, to penalties of up to \$10,000,000. For subsequent orders, the penalties increase to a maximum of \$1,000,000 in the case of an individual and \$15,000,000 in the case of a corporation. The court also has the power to order interim injunctions to freeze assets in certain cases.

9) *How does your Group's law regulate the conflict between a GI/AO and a prior trademark? Does the GI/AO or the trademark prevail or do they coexist? Under what conditions?*

Prior trade-marks will prevail over GIs. Under subsection 11.19(1), the GI protections do not apply to those GIs that are confusing with respect to a registered trade-mark in Canada, a Canadian trade-mark previously used but as yet not abandoned, or one in respect of which an application has been filed with the appropriate authorities and remains pending (i.e. use of both the GI and the trade-mark in the same area would likely lead to the inference that the product associated with the GI originates from the same source as goods associated with the trade-mark). However, use of that trademark must be in good faith (subsection 11.19(2)). Bad faith

AIPPI Questionnaire on Geographical Indications - CANADA

requires that “the person who filed the application for registration of the trade-mark did so with knowledge that the trade-mark was in whole or in part a protected geographical indication”.

Subsections 12(1)(g) and 12(1)(h) of the *Trade-marks Act* operate to bar the registration of any trademark that consists in whole or in part of a geographical indication protected under sections 11.11 to 11.2, although the bar only applies where the mark is sought to be registered in association with a wine (paragraph 12(1)(g)) or a spirit (paragraph 12(1)(h)) that does not originate in a territory indicated by the geographical indication. *(N.B. CETA amendments will extend the bar to GIs in respect of certain categories of agricultural products or food.)*

10) Is there any specific provision or practice concerning the inclusion of a GI/AO in a domain name?

In Canada, the Canadian Internet Registration Authority (“CIRA”) requires that the registrant of a domain name in the .ca domain meet the Canadian Presence Requirements for Registrants. These requirements are designed to ensure that the .ca domain is a “key public resource for the social and economic development of all Canadians.”

The CIRA certifies domain name registrars, who receive applications for domain name registrations and then submit them to the CIRA who approves and ultimately registers it.

The .ca domain name is administered by the CIRA. Disputes are resolved according to the CIRA’s Domain Name Dispute Resolution Policy. A complainant must establish that:

- (a) the Registrant’s dot-ca domain name is Confusingly Similar to a Mark in which the complainant had Rights prior to the date of registration of the domain name and continues to have such rights;
- (b) the Registrant has no legitimate interest in the domain name as described in paragraph 3.6; and
- (c) the Registrant has registered the domain name in bad faith as described in paragraph 3.7.

The Dispute Resolution Policy defines a “Mark” as:

- (a) a trade-mark, including the word elements of a design mark, or a trade name that has been used in Canada by a person, or the person’s predecessor in title, for the purpose of distinguishing the wares, services or business of that person or predecessor or a licensor of that person or predecessor from the wares, services or business of another person;
- (b) a certification mark, including the word elements of a design mark, that has been used in Canada by a person or the person’s predecessor in title, for the purpose of distinguishing wares or services that are of a defined standard;
- (c) a trade-mark, including the word elements of a design mark, that is registered in CIPO; or

AIPPI Questionnaire on Geographical Indications - CANADA

(d) the alphanumeric and punctuation elements of any badge, crest, emblem or mark in respect of which the Registrar of Trade-marks has given public notice of adoption and use pursuant to paragraph 9(1)(n) of the Trade-marks Act (Canada).

11) *Is there anybody that administers GIs/AOs in your country and/or is responsible for the verification of compliance of goods bearing a GI/AO? Please briefly describe the relevant processes, e.g. the process by which compliance with product specifications is verified before such goods are put on the market and/or the subsequent market controls on such goods?*

The owners of a registered GI or Certification Mark are responsible for policing their own trade term and taking legal action in the event of its unauthorized use or its confusion with a similar term. While the Trademarks Office will examine a request to register a GI prior to its registration, there are no further government controls that ensure compliance with the GI's or Certification Mark's standards of production.

The *Trade-marks Act* falls under the purview of the Minister of Industry. However, requests for protection of a GI for a wine or spirit are filed with Agriculture and Agri-Food Canada, who will give their recommendation to the Trademarks Office, who ultimately processes the request.

The Trademarks Office is a branch of the Canadian Intellectual Property Office (CIPO), which is the official government body which receives and processes all applications submitted both by individuals and companies who wish to register their trademarks.

12) *Please describe any other developments in your country in relation to GIs or AOs which you consider relevant, including any proposals for reform. For example, to the extent that your country has been involved in any negotiations or discussions regarding the protection of GIs and AOs in any fora, such as multilateral, regional or bilateral agreements, please specify whether your country is negotiating or has signed any agreement with other countries that includes provisions on AOs/GIs and whether it was necessary to amend domestic legislation as a result of such agreements.*

On October 30, 2016, Canada and the European Union signed the Comprehensive Economic and Trade Agreement ("CETA"). The Government of Canada then implemented changes to Canadian trademark law with Bill C-30, which was given Royal Assent on May 16, 2017 but will not come into force until a day to be fixed by order of the Governor in Council. Bill C-30 is now the *Canada-European Union Comprehensive Economic and Trade Agreement Implementation Act*, SC 2017, c 6 (the "Implementation Act").

As discussed, under Canada's current legislation, protection of GIs extends to only wine and spirits. But in accordance with CETA, the Implementation Act introduced amendments to the Act

AIPPI Questionnaire on Geographical Indications - CANADA

which expand GI protections beyond wines and spirits to *agricultural foods and products*, a category which covers a variety of products such as milk, olives and beer.

Certain existing GIs which are named in Annex 20-A of CETA will receive protection immediately. Further GIs listed in Canada's agreement with Korea (the *Canada-Korean Economic Growth and Prosperity Act*) will also receive protection immediately. Section 116 of the Implementation Act creates a complementary process where new GIs can be fast-tracked and sheltered in future by being added to Annex 20-A of the CETA.

In circumstances where fast-tracking is unavailable, new GIs will have to be approved through the same process that exists for wines and spirits.

Once the Act is amended, those rights holders of GIs in respect to certain categories of agricultural foods and products will have access to the same protections and remedies under the Act as those rights holders of GIs in respect of wines or spirits (listed under question 5 above.)

CETA also provides that products bearing registered GIs on their labels or packaging that either do not originate from the territory indicated, or was not produced or manufactured in accordance with the law applicable to that territory, may not be exported out of or imported into Canada (s 51.03(2.1)-(2.2)).

As part of the Registrar of Trade-Mark's supervision of a list of geographical indications, in the case of agricultural foods and products, translations of those indications must also be included (subsection 11.12(2.1)).

It appears that the procedure for objections may be spelled out via regulations to the Act (s 11.13(5)). Furthermore, the grounds for objections are expanded to include: (a) the proposed GI or its translation is *identical* to a term customary in common language; (b) the proposed GI or its translation is not protected under the law of the country of origin; (c) the proposed GI or its translation is confusing with a registered, applied-for, or common law trade-mark at the time the Minister proposes to add it to the list; (d) the proposed translation is not a faithful one. (Subsections 11.13(2)-(2.1)).

A number of factors must be when determining whether an indication is confusing with a trade-mark. While the Registrar or the Federal Court must have regard to all the surrounding circumstances, they are specifically instructed to consider a number of factors lightly adapted from the mainstream test for confusion under s 6(5) of the Act:

- a. The length of time that the indication has been used to identify the product with which it is associated as originating in the territory, and the extent to which it has become known;
- b. The degree of resemblance between the indication and the trade-mark, including in appearance or sound or in the ideas suggested by them; and
- c. With respect to the trade-mark, its inherent distinctiveness and the extent to which it has become known, the length of time of its use and the nature of the goods, services or business associated with it (s 11.11(3)-(4))

AIPPI Questionnaire on Geographical Indications - CANADA

II. Proposals for improvements and for harmonisation

13) *Should there be harmonised definitions of AOs and GIs? If so, please propose appropriate definitions and prerequisites.*

Yes. A definition for an AO or GI may be an indication that “identifies the [goods] as originating in the territory of a WTO Member, or a region or locality of that territory, where a quality reputation or other characteristic of the [goods] is essentially attributable to its geographical origin”. The AO or GI must be protected under the laws of a member state.

14) *Should there be a registration procedure for AOs and GIs? If so, what should its key features be? For example, content of the application; examination by competent bodies; possibility of opposition by third parties.*

Yes. Please see the answer to question 2c, above, for a detailed example of registration procedures for 1. Geographical Indications and 2. Certification Marks.

15) *What should the grounds of invalidity/loss of rights for GIs and/or AOs be? For example, becoming generic, lack of use, not paying fees. Please specify what the applicable test should be, how such should be proven and who should bear the burden of proof.*

Please see the detailed answer to question 4, above.

16) *How should conflicts between GIs/AOs and prior trademark rights be regulated?*

Prior trade-marks should prevail over GIs. Please see the detailed answer to question 9, above.

17) *What scope of protection should GIs/AOs have and should it matter if these are domestic or foreign? Against which conduct by third parties should they be protected?*

The scope of protection of a GI/AO may differ depending on whether it is registered or unregistered. It should not matter if these are domestic or foreign. Please see the detailed answer to question 5, above.

18) *Who should have legal standing to protect a GI/AO and which remedies are appropriate?*

Any interested person should have legal standing to protect a GI/AO, including any person who

AIPPI Questionnaire on Geographical Indications - CANADA

is affected or reasonably apprehends that he/she may be affected by the improper use of a GI/AO. A government official representing the government of a state may also have legal standing to protect a GI/AO. Remedies may include relief by way of injunction, the recovery of damages or profits, punitive damages and the destruction or other disposition of any offending goods, packaging, labels and advertising material.

19) Should there be a specific provision or practice concerning the inclusion of a GI/AO in a domain name?

Yes. The domain name registration authority should have provisions in place concerning the inclusion of a GI/AO in a domain name. A domain name having a GI/AO should only be owned by the owner of the GI/AO. A dispute resolution policy/practice should also allow complainants to dispute a domain name registration if a GI/AO is included in the domain name.