Intellectual Property Weekly Abstracts Bulletin — Week of September 12

September 14, 2016

Trademark Decisions

Appeal allowed in part where opposed services were an extension of Applicant's earlier registration
Caesarstone Sdot-Yam Ltd v. Ceramiche Caesar S.P.A, 2016 FC 895

This was an appeal of the decision of the Trademarks Opposition Board ("TMOB"), refusing in part the Applicant's registration of the trademark CAESARSTONE & Design.

The central issue raised by the Applicant against the TMOB's Decision was an alleged unreasonable finding of a likelihood of confusion between the Applicant's CAESARSTONE Mark proposed to be used for the Opposed Services relating to flooring and similar applications, and the Opponent's CAESAR Mark.

On the issue of the appropriate standard of review, the Court held that the TMOB's decision was to be reviewed on a standard of reasonableness. While the Applicant had submitted new evidence, the Court did not find that this new evidence would have materially affected the TMOB's findings of fact or its exercise of discretion. The new evidence was found to be supplemental to, and simply more of the same of, that which was before the TMOB when it rendered its decision.

The Court allowed the appeal with respect to the TMOB's consideration of the likelihood of confusion in relation to certain Opposed Services (tiles, slabs and tiles formed of composite stone, and wall cladding and walls), and the matter was referred to a different member of the TMOB for redetermination. The Court found that the TMOB's conclusion that the certain of the Opposed Services were a departure from, rather than an extension of, certain of the goods covered by the Applicant's earlier CAESARSTONE registration, was unreasonable. The Court also noted that this unreasonable conclusion may have affected the TMOB's assessment of the likelihood of confusion.

While this was but one factor, and a surrounding circumstance to be considered in assessing likelihood of confusion, this unreasonable conclusion impacted the outcome and the reasonableness of the TMOB's assessment of other factors, including the weight afforded to the lack of actual confusion in the marketplace where both have

coexisted, at least with respect to the Opposed Services relating to tiles, slabs and tiles formed of composite stone and wall cladding and walls.

The appeal of the TMOB's decision in relation to the remaining Opposed Services was dismissed.

Supreme Court Update
Sandoz Canada Inc., et al. v. Attorney General of Canada, et al., (SCC #36798) — appeal discontinued

Sandoz Canada Inc. has discontinued its application for leave to appeal from the Federal Court of Appeal's decision, where the Court of Appeal reinstated the PMPRB's jurisdiction over generic companies considered to be “patentees” within the meaning of subsection 79(1) of the *Patent Act* (2015 FCA 249 and summarized the week of November 9, 2015; granting the appeal from two decisions reported at 2014 FC 501 & 2014 FC 502 and summarized the week of June 2, 2014).

Other Industry News

Health Canada has published a Guidance Document Questions and Answers: Plain Language Labelling Regulations.

Health Canada has published an External Consultation Report — What we heard Health Products and Food Branch Transparency Initiatives .

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