Intellectual Property Weekly Abstracts Bulletin — Week Of January 11

January 13, 2016

Trademark Decisions

Venngo Inc. v. Concierge Connection Inc. (Perkopolis, Morgan C. Marlowe and Richard Thomas Joynt), 2015 FC 1338

In this action for trademark infringement, Venngo alleged that Concierge and its directors infringed its rights in a family of registered Canadian trademarks ending in "PERKS", by using the registered trademark "PERKOPOLIS", pursuant to sections 19 and 20 of the *Trade-marks Act*. Venngo further alleged that the Defendants have made false and misleading statements discrediting Venngo's business, committed the tort of passing off and depreciated their goodwill, contrary to subsections 7(a), 7(b), 7(c) and 22 of the *Trade-marks Act*.

These claims were dismissed by the Court.

The companies to this litigation were described as "Commercial Program Providers", a term used to describe their business of offering discount, benefit and incentive programs to Canadian companies and professional organizations. The customers of Venngo and CCI sign contracts so they can offer these discounts on various products and services, including entertainment tickets, car rentals, fitness clubs, hotels, spas and more, to their employees as membership or employment benefits above and beyond salary or wages.

The personal claim against Mr. Joynt and the claim under subsection 7(c) were withdrawn at the trial, and personal liability against Ms. Marlowe was not made out. The claims pursuant to subsections 7(a), 7(b), sections 19 and 22, were dismissed by the Court with short reasons.

The claim pursuant to section 20 was also ultimately dismissed, with the Court finding there was little resemblance in the Venngo family of marks (WORKPERKS, ADPERKS, MEMBERPERKS and CUSTOMERPERKS) with the use of PERKOPOLIS in either appearance or sound or in the ideas suggested by the marks. The Court held that each of the Venngo marks suggests that perks are being offered to a specific group or in a specific circumstance. In contrast, the Court held that PERKOPOLIS suggests a type of

benefit program, but otherwise has little obvious suggestion as to whom or for what the perks are offered, and does not suggest any of the ideas associated with Venngo's trademarks.

The Court further held the marks had little inherent distinctiveness; the services and business of CCI and Venngo substantially overlap, as do their customers and clients; Venngo used its marks longer than the Defendants; and the evidence of confusion was not sufficient to override the other factors.

The counterclaim for invalidity was not fully considered due to the earlier holdings, but the Court did not find on the state of the register evidence provided by the Defendants nor in light of the Defendants' use of the PERKOPOLIS trademark or Perkopolis trade name that Venngo's registered trademarks are invalid.

Other Cases of Interest

Import Ban Quashed, and Health Canada Ordered to Retract Its Statements re Same
Apotex Inc. v. Canada (Health), 2015 FC 1161

Apotex *et al* brought a judicial review of the Minister of Health's (the Minister) decision to impose an import ban on products from two of Apotex' manufacturing facilities in India in September 2014. The Federal Court ordered that the import ban be quashed, and that the Minister and Health Canada retract their public statements relating to the import ban.

After a lengthy review of the facts, the Court held that the standard of review is correctness for allegations of procedural fairness and the issue of whether the correct statutory mechanisms were employed to carry out the import ban. However, the actual decision of whether to implement the import ban should be reviewed on a standard of reasonableness.

The Court held that the Minister acted for an improper purpose and did not act in accordance with the duty of procedural fairness. Thus, the import ban should be quashed. The Court held that the proper statutory provisions were used to add conditions to Apotex' Establishment Licences, but that procedural fairness required at least notice and reasons for the additions. The Court also held that paragraph 2(e) of the *Canadian Bill of Rights* does not apply. The Court held that Apotex had not met its burden of establishing that the Minister demonstrated a reasonable apprehension of bias. As the Customs Target had expired, there was no further remedy for the Court to grant.

Cases Pursuant to S. 8 of the *NOC Regulations*

Supreme Court to Issue Decision in Leave Application Re Claim for Unjust Enrichment in S. 8 Proceeding
Apotex Inc. v. Eli Lilly and Company, 36538

The Supreme Court of Canada has announced that on Thursday, January 14, 2016 it will issue its decision in Apotex' application for leave to appeal. In the case on appeal, the Ontario Court of Appeal (OCA) struck Apotex' claims for unjust enrichment from an

action relating to damages pursuant to section 8 of the *NOC Regulations*. Our summary of the decision can be found here.

Other Industry News

Health Canada published the Release of Draft (Step 2) ICH Guidance Document: E18: Genomic Sampling and Management of Genomic Data. The consultation is stated to end on April 7, 2016.

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