

Federal Court



Cour fédérale

Date: 20121210

Docket: T-1240-09

Citation: 2012 FC 1450

Ottawa, Ontario, December 10, 2012

PRESENT: The Honourable Mr. Justice Mosley

BETWEEN:

**BODUM USA, INC.
AND
PI DESIGN AG**

Plaintiffs

and

MEYER HOUSEWARES CANADA INC.

Defendant

REASONS FOR JUDGMENT AND JUDGMENT

OVERVIEW:

[1] Bodum is well-known in Canada for its line of non-electric coffee makers. But are the words “French Press” which appear on its packaging and promotional materials a distinctive trade-mark, as it claims, or a generic term like “toaster” or “pepper grinder”?

[2] The type of non-electric coffee maker in question in this action typically consists of a narrow cylindrical beaker, made of glass or plastic, equipped with a lid and a plunger with an attached fine wire or nylon mesh filter that fits tightly in the cylinder. Hot water is mixed with coffee grains in the beaker. When pushed through the water, the plunger and filter separate the grounds from the beverage. The design was invented and patented in Europe and later gained a significant following among coffee-lovers in Canada.

[3] The plaintiffs, and their associated companies, collectively referred to as “Bodum” in these reasons, manufacture and distribute housewares. Pi Design AG, a corporation based in Switzerland, is the registered owner of the impugned mark. Bodum USA, Inc, formerly Bodum, Inc, a corporation registered in the State of Delaware with offices in New York City, has the exclusive license to use the mark in Canada. The principal business of Bodum USA, Inc, is the importation, sale and distribution of kitchenware products.

[4] Bodum’s application to register “FRENCH PRESS” as a trade-mark was accepted in 1997 by the Canadian Intellectual Property Office (Registration No TMA475,721).

[5] The defendant, Meyer Housewares Canada Inc., is a Canadian corporation with offices in Saint-Laurent, Quebec. It is part of a US based group of companies (hereafter collectively “Meyer” or the defendant) engaged in the importation, sale and distribution of kitchenware products. At material times, either the US companies or the Canadian subsidiary sold non-electric coffee makers to Canadian distributors and retailers. Packaging and product inserts for these coffee makers bore the term “French Press”.

[6] Twelve years after the registration in Canada, and without prior notice or other enforcement efforts, the plaintiffs brought this action against the defendant for trade-mark infringement, passing off and depreciation of goodwill contrary to the *Trade-marks Act* (RSC 1985, c T-13).

[7] The action was commenced by a Statement of Claim dated December 4, 2009 which asserted that the defendant used the trade-mark FRENCH PRESS without authorization in association with its Prestige line of coffee presses. The plaintiffs sought declaratory relief, an injunction to restrain further breaches, damages and/or an accounting of profits together with costs and interest.

[8] The plaintiffs filed an Amended Statement of Claim on January 11, 2010 and, with leave of the Court, filed a Further Amended Statement of Claim on May 7, 2012, a month prior to trial, to add the defendant's distribution of its "BonJour" line of products as an allegedly infringing use of their trade-mark. The ground asserted in support of this late amendment was that the plaintiffs had only lately become aware of the additional allegedly infringing use through the discoveries in these proceedings.

[9] In its several Statements of Defence the defendant denied that the plaintiffs had acquired any significant reputation or goodwill in Canada in association with the mark or used it as a trade-mark. It contends that the term was used by the plaintiffs as a description of the type of wares being offered for sale. The defendant acknowledged selling non-electric coffee makers in Canada in association with the name Prestige and that the term "French Press" appeared on its packaging. It denied using the term as a trade-mark or trade name and asserted legitimate use as an accurate

description of the product. It denied directly selling the BonJour line in Canada but acknowledged selling coffee makers with “French press” used on the packaging to independent third parties who imported them into Canada. By counterclaim, the defendant sought a declaration of invalidity of the mark and expungement of its registration.

[10] On the joint request of the parties, the Court ordered that the matter proceed to trial solely on the merits of the claim and counterclaim. If necessary, the quantum of the damages or profits claimed by the plaintiffs would be subsequently determined by way of further trial or reference.

[11] On the evidence heard at trial, it is clear that Bodum popularized this type of coffee maker and dominates the market for such appliances in Canada. However, other manufacturers, distributors and retailers have and continue to market similar coffee makers employing the term “French Press” and it has long been used as a generic term in the coffee industry across North America to reference both the type of maker and the preferred grind of the coffee used in such devices. For that reason, Bodum’s efforts to register the term as a trade-mark in the United States were unsuccessful.

[12] For the reasons set out below, I find that the trade-mark registration is not valid and order that it be expunged from the Trade-Marks Register. The plaintiffs’ action against the defendant is dismissed in all respects and the defendant’s counterclaim succeeds.

THE LEGISLATIVE and JURISPRUDENTIAL FRAMEWORK:

[13] The relevant provisions of the *Trade-marks Act*, RSC 1985, c T-13 are set out in the attached annex. These include the definitions of “distinctive” and “use” in s 2; the provisions relating to when a mark is deemed to be used in ss 4(1); the prohibitions in ss 7, 10 and 11; when a trade-mark is registrable (s12(1)), when a registration is invalid (s 18(1)); rights conferred by registration (s 19); infringement (s 20(1)); depreciation of goodwill (s 22); and licensing (s 50(1)).

[14] The definition of “distinctiveness” in s 2 of the Act requires that three conditions be met:

- (1) that a mark and a product (or ware) be associated;
- (2) that the "owner" uses this association between the mark and his product and is manufacturing and selling his product; and,
- (3) that this association enables the owner of the mark to distinguish his product from that of others.

[15] The question of distinctiveness is a question of fact with the test being whether a clear message has been given to the public that the wares with which the trademark is associated and used are the wares of the trade-mark owner and not those of another party: *Philip Morris Inc v Imperial Tobacco Ltd* [1985] FCJ No 1231 (TD) (QL) at paras 75-78, aff'd [1987] FCJ No 848 (CA). A word may be commonly used in a descriptive sense yet still remain distinctive when used in certain circumstances: *Aladdin Industries Inc v Canadian Thermos Products Ltd*, [1969] 2 Ex CR 80 (QL) [*Thermos*] at para 80; appeal dismissed for delay [1974] SCR 845. Proof of distinctiveness does not require evidence of exclusive use: *John Labatt Ltd et al v Molson Breweries* [2000] 5 CPR (4th) 180, [2000] FCJ No 159 (QL) at para 72.

[16] As set out in *ITV Technologies, Inc v WIC Television Ltd*, 2003 FC 1056 at para 67, aff'd 2005 FCA 96, in order to be "clearly descriptive", and therefore not registrable under s. 12(1)(b) of the Act:

"...in order for a mark to be clearly descriptive, pursuant to paragraph 12(1)(b), it must be more than merely suggestive of the character or quality of the wares or services in association with which it is used or proposed to be used. The descriptive character must go to the material composition of the goods or services or refer to an obvious intrinsic quality of the goods or services which are the subject of the trade mark, such as a feature, trait or characteristic belonging to the product in itself (*Provenzano v. Registrar of Trade-marks* (1977), 37 C.P.R. (2d) 189).

[17] With respect to confusion, the test to be applied is that of the first impression of a "...casual consumer somewhat in a hurry who . . . does not pause to give the matter any detailed consideration or scrutiny...": *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 [*Masterpiece*] at para 40, citing *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20.

[18] The material date for assessing the validity of a registration is the date of registration; in this case May 5, 1997: *Airos Systems Ltd v Windsurfing International Inc* (1983), 75 CPR (2d) 74 (TMOB) at paras 28-29 [*Windsurfing*]. A trade-mark that is not registrable by reason of s 12(1)(b) is registrable if it has been used in Canada so as to have become distinctive as of the date of filing the application (s 12(2)). Here the application was filed on June 28, 1995.

[19] The material date for assessing the validity of a registration under s 18(1)(b) [distinctiveness] of the Act is the date upon which proceedings bringing the validity of the registration into question are commenced: *Thermos* above, at para 12. In this case, that is the date of the filing of the defendant's Statement of Defence and Counterclaim, February 10, 2010.

[20] A presumption of validity applies to the registration with the burden of proving the contrary resting on the opposing party based on the right to exclusive use set out in s 19 of the Act: *General Motors of Canada v Décarie Motors Inc*, [2001] 1 FC 665, 9 CPR (4th) 368 (CA) at para 31. But the presumption is "weakly worded". It means simply that an application for expungement will succeed only if an examination of all of the evidence establishes that the trade-mark was not registrable at the relevant time: *Cheaptickets and Travel Inc v Emall.ca Inc et al*, 2008 FCA 50 at para. 12.

[21] For assessing the likelihood of confusion under ss 19 and 20 of the Act, the date is normally the date of the trial subject to the discretion of the trial judge to fix another date such as where infringement began and ceased at some time prior to trial: *Alticor Inc v Nutravite Pharmaceuticals Inc*, 2005 FCA 269 at paras 12, 16.

[22] As this case involved expert opinion evidence tendered by the defendant, it was necessary to observe the four requirements for the admissibility of such evidence set out by the Supreme Court of Canada in *R v Mohan* [1994] 2 SCR 9 at para 17: (a) relevance; (b) necessity in assisting the trier of fact; (c) the absence of any exclusionary rule; and (d) a properly qualified expert. In considering the opinion evidence, I have also instructed myself in accordance with the caution expressed by Rothstein J. in *Masterpiece*, above, at paras 75-101. I have recognized the danger of distraction by

such evidence and have formed my own opinion on the evidence: *R v Abbey*, [1982] 2 SCR 24 per Dickson J at page 42; *Fraser River Pile and Dredge Ltd v Empire Tug Boats Ltd*. 37 CPC (3d) 119, 95 FTR 43 at paras 12, 17.

ISSUES:

[23] The primary issue raised in this case is whether the registration of the trade-mark, “French Press”, is valid. The parties agree that this is essentially a distinctiveness case. The task for the Court to determine is whether “French Press” is distinctive of Bodum or whether it had become generic as at February 2010 when the counterclaim was filed.

[24] If I found it to be a valid trade-mark, I was also asked to consider whether the defendant's use of the term “French Press” on its packaging and promotional materials is infringing, confusing or has caused any damage to Bodum. Finally, assuming validity, was the defendant’s use allowed under a license granted its predecessor in title and had the plaintiffs acquiesced to its use such that they are estopped from obtaining the equitable relief sought.

THE EVIDENCE:

[25] In addition to the transcripts of discoveries and admissions read in to the trial record, the Court received the evidence of six witnesses called by the plaintiffs and eight by the defendant. Over eight days of trial, thirty five exhibits were introduced by the plaintiffs and 121 by the defendant.

[26] The plaintiffs' witnesses are all presently, or were formerly, associated in some way with the plaintiffs' enterprise as employees, sales representatives or wholesale and retail customers. For the most part, I found their evidence credible but deserving of less weight when it was contradicted by the defendant's evidence, the documentary record and the physical exhibits.

[27] The defendant's witnesses included two of its competitors and several independent experts. There was no issue in these proceedings as to the independence and objectivity of the experts. The qualifications of two of them to give relevant and admissible opinion evidence were called into question and the plaintiffs urged that I give little weight to the opinions of the others. I will discuss my findings on the admissibility of that evidence below.

[28] Evidence of the results of searches conducted in intellectual property databases maintained by the Canadian Intellectual Property office and the United States Patent and Trademark Office were submitted by affidavit. While the relevance of that evidence was contested by the plaintiffs, the truth of the facts contained in the attached schedules was admitted.

[29] To explain the controversy between the parties and my findings I think it is helpful to provide a summary of the testimony heard at trial.

Plaintiffs' witnesses;

[30] The first witness for the plaintiffs was Koen de Winter, an industrial designer and later Professor of design in Montreal. Mr. de Winter was in the housewares business for many years and

had an early association in Europe with Jørgen Bodum, son of the founder of the firm. Mr. de Winter moved to Canada to work for Bodum's exclusive distributor in this country, Danesco. He left Danesco in 1997. Bodum USA took direct responsibility for distribution in Canada in 2005.

[31] Mr. de Winter testified that Bodum did not invent the plunger type of coffee maker – it was patented in Italy in the 1930s and later manufactured in France by Établissement Martin for the Melior company. Melior's products were imported and sold in Canada under that name and the "Chambord" brand. When the European patent expired, Bodum began to manufacture similar coffee makers in Europe. It later acquired Melior and its brands, including Chambord.

[32] To Mr. de Winter's recollection there were only two types of what he called "plunger coffee makers" on the market in Canada until the mid-1980s; Bodum's and Melior's. The market then began to change but only slowly. Initially, there were a few small scale importers of brands from other manufacturers, mainly from Italy. It was known in French as a *cafetière à piston* and the word *cafetière* was adopted in the United Kingdom to describe this type of coffee maker.

[33] Mr. de Winter identified Danesco promotional materials directed at retailers and consumers from the late 1980s through the 1990s that he had retained in his personal possession. Initially, in the 1980s, Danesco advertised "the Bodum-Bistro method" and "Bodum plunger-made coffee". In a pamphlet he wrote in 1987 for display to the public, de Winter describes the method as "plunger" and the product generically as a "plunger coffee maker". He also used the term "French coffee press".

[34] In the mid-90's, Mr. de Winter testified, Bodum was expanding its lines of housewares and he encouraged the company to find a way to distinguish their categories to avoid consumer resistance to a broad range of products under one brand name. He discussed this at trade shows in Europe with Jørgen Bodum and Carsten Jorgensen, Bodum's chief designer. The Bodum executives decided to use the term "French Press" in association with their coffee makers to distinguish them from their other products such as a line of plastic pepper mills. Bodum began using the term on its packaging and promotional materials which Danesco distributed in Canada in 1995.

[35] According to Mr. de Winter, the benefits of "French Press" as a brand name were that it was:

“...a name that's close to what it does and close to its origins... It's not very far from something that could sound like a generic name. In this case we had seen and we had used, ourselves, French coffee press as a word and as a description...And so to squeeze out the coffee was, in my eyes, a very small creative step, but something that as a brand would sound acceptable... And the fact that one refers to the action, which is to press and the other not to another action or what it looks like but to the origin, is not such an obvious combination, to say "French press", refers first to the origin of the manufacturer, *Établissement Martin*, and the second word refers to the action you have to make to -- or that's most characteristic for the coffee maker.”

(Transcript, Vol 1, pp 100-101).

[36] When it was first proposed by Bodum, Mr. de Winter says he expressed concern about the use of an English term in the Quebec market shortly after the 1995 referendum. He also questioned whether it sounded "too generic". He was persuaded by Jorgensen that while the term sounded generic, it would be similar to "British Airways" or "Air Canada" which were distinguishable as brands related to origin and function.

[37] On cross-examination Mr. de Winter acknowledged correspondence between the President of Danesco, Knud Petersen, and Jørgen Bodum in March and September 1994 in which the term “French Press” was used in a generic manner; the first in reference to brochures picked up at the Frankfurt trade show and the second referring to an article in the Consumer Reports magazine in which the term was used in that sense. No mention was made of Bodum in the article. Mr. Petersen also forwarded an article to Mr. Bodum in September of 1997 from the San Francisco Chronicle in 1997 in which the term was used generically to distinguish the product from other types of coffee makers.

[38] When Mr. de Winter left the business in 1997, Bodum had 85-90% of the Canadian sales for such non-electric coffee makers. There were additional products on the market offered by distributors such as Trudeau and Fox Run. At some point prior to 1997, he was aware that Fox Run was selling the BonJour line of coffee makers. Mr. de Winter kept one of their packages in his office. Jørgen Bodum told him when they met at European trade shows that “they had to do something” about the BonJour competition. According to Mr. de Winter, Bodum corporate management clearly knew about the BonJour sales at that time.

[39] Mr. de Winter agreed that the name Bodum appeared predominantly in all of the Danesco advertisements of the coffee makers, followed by the model name, and Bodum was the brand name chiefly associated with the coffee makers. It is still the preferred term used in Quebec, he says, for this type of coffee maker. The term “French Press” appeared in much smaller letters, beginning in 1995, to his recollection. The term was never used without the Bodum name. In the only written agreement between Bodum and Danesco, executed in December 1990 to license sales of Bodum

products by Danesco in Canada, reference is made solely to the trade-mark “Bodum”. Nor does “French Press” appear in the list of products appended to the agreement.

[40] Ms. Marie Cacciato, a public relations executive at JB Cumberland PR in New York, testified that she began handling the Bodum media relations account for the Canadian market in 2005. She tries to ensure that the term “French Press” is used as a trade-mark in promotional materials prepared for Canadian publications. It is capitalized and presented with the registration symbol. She acknowledged that editorial decisions result in the term being used in a generic sense. On cross-examination Ms. Cacciato was taken to several articles in Canadian publications in which the term French press was used as a reference to the type of coffee maker or method of making brewed coffee and not as a brand name or trade-mark.

[41] Fontaine Wong, the owner of Ming Wo Cookware, a Vancouver-based chain of housewares stores testified from her knowledge of retail sales. She described sales of Bodum coffee makers over 20-25 years, initially through Danesco. Her stores have carried similar products from other distributors including the Cuisinox, BonJour, Trudeau, Thermos, Le Creuset and Oxo brands. In their print advertisements, which she personally prepares, she tended to use “coffee press” for the description of such products but has also used, interchangeably, “French press”. She stopped using “coffee press” in 2011 to describe Bodum’s plunger-type makers when asked to do so by a Bodum representative. A few days prior to testifying she changed the description of a “Cuisinox French press” on her web site again when spoken to.

[42] Ms. Wong's stores sold the Bonjour French press for two years. The term French press, she acknowledged, was used by "a lot of companies" to identify and promote their products "...so people can understand what it is." Bonjour, Oxo and Le Creuset used French press on their packaging to her recollection, as did Melior when they were available in Canada, 30-40 years ago.

[43] The Ming Wo website has a search function for "French press". To Ms. Wong that means a plunger-type style of coffee maker, probably a Bodum product because of its dominance of the market. Grinders featured on the site include a setting for making "French press" coffee. She agreed that the message communicated was that French press is one method of brewing coffee and not the product of one manufacturer. She agreed that the terms "coffee press" and "French press" describe the same functional product and could be interchanged for each other. In her stores, they use the term "French press" to describe the type of coffee maker to their customers. Their use of the term is not limited to the Bodum products but she says her customers who know brands use Bodum and French press interchangeably. Those new to the process would call it a "coffee press".

[44] The defendant purchased an Oxo Good Grips French Press TM in one of Ms. Wong's stores prior to trial. The package bore the words "French press", as did the price sticker applied by the store and the cash register receipt.

[45] The plaintiffs characterized Ms. Wong as an independent witness. While I believe that she gave her evidence honestly and to the best of her recollection, I do not consider her to be completely independent of the plaintiffs. She has had a long commercial relationship with Bodum and relies, in part at least, in her business on the sales of their products in her stores. Her testimony, when it

favoured the plaintiffs, was undermined by the documentary evidence of her business practices. I was left with the sense that Ms. Wong did not know, respect or use French Press as an exclusive trade-mark of Bodum or communicate that message to her consumers.

[46] Gary Nichols is the co-owner of Details Sales Agency, the western Canada sales representative for Bodum since 2005. He has been in wholesale housewares for 30 years. Bodum and its coffee line now constitute about 95% of his business. He attends trade shows in the US and generally keeps abreast of the market. Bodum dominates the market in the “French press category” of coffee maker and is synonymous with the term. BonJour is their principal competitor. Others would be house brands imported by chain stores. He had discussed the competition from BonJour with the Bodum sales manager Jeff Malkasian. Mr. Nichols was aware of the use of the term “French press” by BonJour and other brands such as Le Creuset and Oxo and aware that his customers like Ming Wo sell French presses from various manufacturers and describe them as French presses. Mr. Nichols acknowledged that Amazon.ca and other on-line vendors sell Bodum and other French presses and that Danesco sells a coffee mug “with French press”. He doesn’t correct his customers when they refer to other products as French presses.

[47] Thomas Perez, Chief Executive Officer and President of Bodum USA Inc., explained the plaintiffs’ corporate structure and their marketing efforts in Canada. Sales are mainly through major retail chains. They don’t sell to discount chains. Mr. Perez acknowledged that “French press” was a common name for the plunger or coffee press in North America but contended that the use of the term on the BonJour packaging was a source of confusion for customers.

[48] Mr. Perez was unable to provide any examples of actual confusion in the Canadian market but described a 2011 incident in a US shop where the manager referred to Bonjour's French presses as Bodum products. When asked on discovery if he was aware of any incidents of confusion he had been unable to recall any. That answer was not updated prior to trial.

[49] Bodum is now selling on-line through Amazon.ca and its own website and Facebook page. They don't use the trade-mark "French Press" on Facebook and Mr. Perez wasn't certain about the others. He agreed that it was not used in examples of advertising produced jointly with major retailers in Canada or in their more recent television advertising. Nor is "French Press ®" promoted in their displays in major Canadian retailers. It appears in letters on the packaging much smaller than the Bodum name and the model name. Mr. Perez described their promotional costs in Canada but could not say what proportion, if any, might relate to marketing "French Press". Bodum has taken action against other Canadian firms for copying their trade dress, i.e., product design and appearance, but not for using "French press". He is aware that competitors' products using French press as a descriptor are on the market in Canada. The packaging of a Bodum product for sale by Starbucks uses "French press" in the generic sense contrary to their guidelines. Bodum has marketed an electric coffee maker in which it uses "French press taste" in a descriptive and not a trade-mark sense.

[50] Bodum has no records relating to the creation of the term "French press" according to Mr. Perez. He believes that the term was created by Jørgen Bodum when he acquired Melior and that it was first used in Canada when Bodum applied for its trade-mark in May of 1995. Mr. Perez identified Canadian Industrial Design registrations obtained by Bodum in which the device is

described as a “French Press”. Mr. Perez acknowledged that the use of the term in those registrations was as an ordinary commercial description for the type of device. He was taken to Canadian patent applications by Bodum which state that “so called ‘French press’ coffee making devices are known” in the prior art and “[b]everage makers of this type are generally referred to as plunger filter beverage makers or as French press beverage makers.” Bodum product catalogues circulated in Canada in 2009 and 2010 do not use “French Press” as a trade-mark but as a generic description of the process. Bodum uses “The Original French Press” in reference to its Chambord model to distinguish it from the products of other manufacturers. The Chambord was the Melior product which Bodum later acquired.

[51] Mr. Perez identified a 1997 licence agreement that was entered into between Bodum Inc. and Culinary Parts Unlimited (“Culinary”) in settlement of trade dress litigation over the BonJour line. The agreement permitted Culinary to sell the BonJour French press throughout North America, including Canada, with certain specified restrictions. Pursuant to the agreement, packaging and product specifications for the BonJour product were precisely defined. Attached to the agreement as an exhibit is a reproduction of the BonJour packaging which states “The French Press coffee maker.” An attached list of the BonJour products to which the license applied refers to several other products described as “French press”. Meyer subsequently acquired the rights to the agreement from the successor in title to Culinary, BonJour International.

[52] Mr. Perez asserted that Bodum did not consent to the use of the trade-mark “FRENCH PRESS” in Canada through this agreement. He acknowledged, however, that there was nothing in the agreement or the attached list of detailed specifications that restricted such use.

[53] Mr. Perez identified proceedings before an American Court in 2009 in which Jørgen Bodum gave answers to the plaintiff's interrogatories that referenced a third party "French press coffee maker" offered for sale in New York State as early as 1965. In a declaration in the same proceedings entered as an exhibit, Mr. Bodum used "French press coffee makers" as a description of the general class of products. At trial in that case, Mr. Bodum described how he had taken over his father's business after the latter's untimely death in 1967. He testified that he had "found a lot of French press coffee makers in his [father's] office...most of them was a French brand called Radio." Mr. Perez agreed that Mr. Bodum used "French press" in a generic sense in that and other answers in that proceeding and acknowledged that both he and the company have done the same in other contexts. He agreed that many Canadians also use the term generically to describe the entire class of products.

[54] On May 2, 2102, Mr. Perez swore an affidavit in support of the plaintiffs' motion to further amend the claim in this proceeding so as to include Meyer's BonJour line as infringing the trade-mark. At paragraph 3 he deposed:

Neither I nor the plaintiffs were aware that BonJour incorporated the defendant or any of the Meyer group of companies were selling a product in Canada under the trade name BonJour with the trade-mark French Press on the packaging, prior to receiving the defendant's document production in this action. Before receiving the defendant's document production, to the best of my knowledge the plaintiffs were only aware of products bearing the trade-mark French Press that were sold under the Prestige line in Canada.

[55] Mr. Perez testified that he did not consult Mr. Bodum, with whom he said he speaks on a daily basis, or Mr. Nichols, before making this averment. He relied on his own knowledge of the Canadian market and possibly that of one of his sales managers.

[56] Mr. de Winter's evidence was that Jørgen Bodum and Carsten Jorgensen were concerned about the sales of the BonJour line in Canada prior to his departure from Danesco in 1997. Gary Nichols was aware of the BonJour sales in Canada from his dealings with independent retailers like Ming Wo in the preceding seven years and had discussed them with Jeff Malkasian. The agreement with Culinary in 1997 licensed BonJour sales throughout North America with similar trade dress.

[57] Mr. Perez was unable to provide an explanation as to how he could deny corporate knowledge of the BonJour sales in Canada in his May 2012 affidavit. On this and other aspects of his testimony, I considered Mr. Perez' evidence to be self-serving and deserving of little weight. I infer that he was personally aware of the 1997 agreement as he had referred to it in a US deposition. At best, he did not take appropriate steps to re-acquaint himself with the facts prior to making his affidavit. This had the effect, in my view, of misleading the Court when it considered the motion to further amend the Statement of Claim. I do not attribute this in any way to counsel for the plaintiffs. Mr. Perez was responsible, under the direction of Mr. Bodum, for initiating this litigation and should have informed himself of the pertinent facts.

[58] Jeffrey Malkasian, Vice President, Bodum USA, was responsible for sales throughout Canada between 2007 and 2011. In that capacity he worked with representatives such as Gary Nichols and visited retailers in Canada. He would use "Bodum French Press" to encourage retailers to go with their brand. When offered side by side in the stores they outsell the competition. He saw a lot of direct import brands which in his view were essentially copies of their models. But in comparing them, his focus was on the product rather than what was used on the packaging to describe the product. He would report to Bodum when he found what he thought were copies of the

design of their products. He was aware that BonJour was being sold on the Canadian market and it was frequently discussed in sales meetings. They would look for any retailer “that carries any French press that isn’t ours” with a view to having them sell the Bodum products.

[59] Mr. Malkasian agreed that “French press” is used to describe a brewing method. Bodum didn’t develop it but popularized it. Using “The Original French Press” in their marketing efforts is an implicit recognition that there are other French presses trading off their brand recognition. He uses the term himself generically to describe a category of their business.

[60] Mr. Malkasian recalled seeing ads in trade magazines featuring a BonJour press distributed in Canada by Fox Run. He knew that BonJour was on the Canadian market in 2007 and agreed he must have discussed this with Mr. Perez at that time. He has difficulty separating discussions about market developments in the two countries. He agreed that the most prominent feature of the Bodum packaging, apart from the image of the product itself, is the name Bodum followed by the model name and in very small letters, “French Press ®”.

Defendant’s witnesses;

[61] Jay Goldberg is a Chartered Accountant and Vice President of Accent Fairchild Group, a distributor and manufacturer of housewares and hardware. Accent Fairchild provides finance and operations services to Meyer in Canada. Mr. Goldberg described Meyer’s corporate structure and sales of housewares in Canada. Mr. Goldberg identified lists of sales records of products shipped by Meyer to Canada between 2006 and 2010 with or without “French press” on the packaging. He

identified exhibits relating to the sales of Meyer's Prestige brand through Canadian Tire Corporation, a President's Choice brand sold through Loblaws and the BonJour line imported and distributed by another firm, Sevy Imports. Sevy is a smaller company that focuses on smaller retailers. The rights to the BonJour line were assigned to the defendant by Culinary and BonJour International. The name BonJour is a registered trade-mark in Canada in association with a long list of wares. Sevy has the exclusive rights to the BonJour line in Canada.

[62] Charles Harari works for the Trudeau Corporation in Boucherville, Quebec as Vice President of product development. Mr. Harari has been in the housewares business since the mid-1960s and joined Trudeau in 1994. The plaintiffs sued Trudeau in 2007-2008 claiming infringement in relation to one of Bodum's registered industrial designs. That action went to trial a few weeks prior to this action and Mr. Harari testified against Bodum in that matter as well. While the plaintiffs brought that fact out, they did not challenge Mr. Harari's credibility in this proceeding. I did not find any reason to doubt that Mr. Harari testified honestly according to his recollection of facts and events or to give his evidence lesser weight.

[63] Mr. Harari says he refers to the type of product at issue in these proceedings as a "French press" and as a "cafetière". They are sold by Trudeau under several brand names to major chain stores and independent retailers. Trudeau uses "coffee press" to distinguish them from a similar product they sell for brewing tea. They also use "filter press coffee maker". He identified the Stella line imported by Adamo Imports that also uses "coffee press" and "tea press". The Tri-leaf product sold through Canadian Tire since at least 2010 is referred to as a "coffee press" on their website but

the site describes the process as “the French press method”. Paderno Kitcheware sells “coffee presses” through their catalogue and at their retail stores.

[64] The Trudeau website shows the different ways of preparing coffee and refers to the use of a “French press” for steeping coffee. They have sold them since 1995 or 1996 and compete with both Bodum and Meyer. He had first seen the Frieling product described as a French press at the Frankfurt Trade show in 1994-95 and, upon his return to Canada, in small specialized shops. La Cafetière has sold French presses in Canada since the late 1980’s. Similar products, manufactured in Taiwan and China, were directly imported by larger retailers, such as Stokes, and sold as French presses. Danesco sells a coffee mug “with French press”.

[65] Mr. Harari first saw the term “French press” used by the D.H. Lisser Company as early as the mid-1960’s to describe the Melior French press which it then distributed in Canada. He finds it difficult to understand how Bodum can claim to have exclusive rights to use the term as it describes the method of making that type of coffee. BonJour products were first distributed by Fox Run in Canada beginning around 1995-96. Fox Run displayed their wares at the Canadian Gift and Tablewares Association (CGTA) shows in Toronto. Sevy later became the BonJour distributor in Canada between 2005 and 2008.

[66] Harry Davies, a licensed private investigator, testified as a fact witness. His assignment was to research the use of the words “French press” in Canada in association with Internet sites and retail stores which sell French press devices; sales of related coffee products such as coffee beans

and ground coffee and Internet sites that use the words "French press" to describe the method of brewing coffee. His research excluded Bonjour, Prestige and Bodum products.

[67] To conduct this research, Mr. Davies visited a number of stores in Toronto, Mississauga, Etobicoke and Brampton, Ontario in March 2012 and made purchases of items that were described as French press devices and associated items such as coffee and grinders. He chose stores that he believed would be found across Canada. These included the Bay, Sears, Zellers, Walmart, Home Outfitters and grocery stores including Loblaws, Sobey's, Metro and Whole Foods. He conducted searches on the Internet and purchased products on-line which he selected. In May, he carried out a follow up visit to a Bay store to photograph grinders on display and conducted additional Internet research and placed on-line purchase orders.

[68] Mr. Davies identified a series of web page printouts stemming from his on-line research and physical exhibits purchased at the stores including coffee makers and packaged coffee grains. He described his observations of other products seen but not purchased. Other products introduced as exhibits through Mr. Davies were purchased on-line through Amazon.ca, a Canada Post shopping site, shopbot.ca and other Canadian based websites. The products purchased through those sites were shipped by Canadian based distributors. In addition, Mr. Davies ordered products from US based firms that indicated on their web sites that they would ship to Canada. Some of the products ordered had not been received as of the date of Mr. Davies' testimony and he identified web page print-outs from those sites.

[69] The coffee makers purchased by Mr. Davies from retail stores or on-line sites were described on their packaging or product inserts as “French press” makers. Similarly the bagged coffee he bought referred to a “French press” grind on the packaging as did the settings on the grinders purchased or observed. None of these items referred to a “coffee press”, “plunger-style” or “press pot” grind or setting for ground coffee.

[70] On cross-examination Mr. Davies agreed that he didn’t know when certain of the US based sites began shipping to Canada. He acknowledged that at certain stores he visited there were no coffee makers identified as “French press” devices. When he saw a product with “French press” on it he bought it. He could not say whether any of those products were available for sale in Canada or that the web pages he found on-line were published in 2010 or earlier. He did not investigate how many visitors from Canada had visited those sites.

[71] Patrick Russell was tendered by the defendant as an expert who, by virtue of his training and employment, would have knowledge of the Canadian coffee industry and the use of the term “French press” within that industry which is outside the experience and knowledge of the Court.

[72] Mr. Russell’s qualifications to provide opinion evidence as to how the words “FRENCH PRESS” are perceived were challenged. However, Bodum did not object to Mr. Russell testifying as a fact witness and no objection was made to his opinion evidence being received subject to closing argument as to its admissibility. Recognizing the Court’s role as a “gatekeeper” with respect to the admissibility of opinion evidence, I considered this to be acceptable in light of the pre-trial

agreement between the parties, with the Court's approval, to take certain steps to expedite the proceedings.

[73] Mr. Russell has been employed with Second Cup Limited since 1996. He describes his current role with the company as being a "coffee expert". He oversees beverage development and quality control and training for the company. He has won the Canadian Cup Tasters championship, competes internationally and has received certification as a coffee grader from the Specialty Coffee Associations Research Institute.

[74] Mr. Russell provided an overview of the speciality coffee industry in Canada including the nature and volume of coffee sales. He described the "French press" methodology as one of five common means of brewing coffee, referring to the nature of the type of brewing equipment employed in producing coffee beverages. The French press is a common retail item in speciality coffee shops and retail stores in Canada. The brewing method was introduced to him in the early 1990s as "French press coffee".

[75] Mr. Russell has trained hundreds of new franchisees and managers in how to make French press coffee. When he refers to that method in class he has been occasionally asked whether he means Bodum. He tells his students that "French press" speaks to a technology and Bodum speaks to a brand. Within the industry, he said, they refer to all of the devices as a French press brewer regardless of the brand.

[76] Mr. Russell identified an excerpt from a book entitled "*The Perfect Cup: a Coffee Lover's Guide to Buying, Brewing, And Tasting*" by Timothy James Castle published in 1991 and which continues to be sold through the Specialty Coffee Association of America. Second Cup sold the book from its stores before Mr. Russell joined the company. Chapter 2 discusses brewing methods including the French press. In addition, Mr. Russell identified articles from magazines and trade journals available in Canada and pages from Internet websites that he accessed which refer to the French press methodology.

[77] Mr. Russell acknowledged that Bodum is by far the largest manufacturer of French presses sold in Canada. He is familiar with other brands including BonJour, Espro, Prestige, Frieling, Capri, Mountain Equipment Co-op, Hario and Trudeau. He doesn't know whether they use the term "French press" on their packaging. Second Cup has carried BonJour and other French presses in the past but sells only Bodum now. He was not familiar with the use of "coffee press" by other coffee manufacturers or distributors. He agreed that some Canadian consumers associate "French press" with "Bodum".

[78] Having heard Mr. Russell's evidence, I am satisfied that he has expertise in the roasting, grinding, brewing and sale of coffee beverage products in Canada and abroad. I found much of his fact evidence to be helpful but did not consider it necessary to rely on his opinion evidence as to what the average consumer with an imperfect recollection would understand to be the meaning of "French press" on the packaging of the products at issue. It was not evidence beyond the knowledge and experience of an ordinary consumer nor beyond that of the trier of fact. For that reason, in reaching my decision I considered this opinion evidence to be inadmissible. I agree with the

plaintiffs that while it is interesting much of Mr. Russell's report is irrelevant, in particular that relating to his expertise as a coffee taster. In the result, while I accepted Mr. Russell's fact evidence I gave his opinion as to the meaning of the term "French press" no weight in reaching my decision.

[79] Kathryn Wise describes her occupation as a sourcing consultant in the housewares industry. She began working in that field in the United Kingdom more than thirty years ago and continued in Canada after 1980. In the subsequent years she worked with several retailers and distributors including D.H. Lisser and Fox Run. Currently she is with a distributor called PortStyle. She has known "French press" as the name for the type of product for many years; at least since the 1980s in Canada. Ms. Wise started Fox Run Canada in 1995 and obtained the BonJour product line for Canada. Fox Run sold it to department stores, independent housewares stores and Second Cup.

[80] Fox run advertised the Bonjour line in *Homestyle Magazine*, the principal magazine in Canada for housewares products. Ms. Wise identified BonJour and Fox Run internal price lists, magazine advertisements and catalogues for the BonJour product line which they would have distributed to their retail customers. The BonJour line was also displayed by Fox Run at the Canadian Gifts and Tablewares Association (CGTA) tradeshows twice a year.

[81] The Bonjour line was still with Fox Run when Ms Wise left the company in 2003 but it was later taken over by Sevy Imports where it remains today. Sevy also promoted the BonJour product line at the CGTA shows. PortStyle carried the La Cafetière brand in 2003-2004 and is doing so again. They also import their own stainless steel French press product and also a brand from England.

[82] In response to a question about Bodum's claim to the exclusive use of "French press" to describe their products, Ms. Wise stated:

I feel that a French press is French press. It's a function and the brand would be Bodum or Bonjour. To me I don't think it's right for Bodum to have it, it's what the product does. And it's a description of the item it's not a branding, and I think French press is French press and I don't see why it has to be exclusive to Bodum.

[83] On cross examination Ms. Wise agreed that Bodum is and always has been the market leader and is famous for its French press line of coffee makers. She acknowledged that some brands use "coffee press" to describe their products.

[84] Katherine Barber, a lexicographer by education and through extensive work experience, has expertise in researching the meaning of words, the history and origin of words and the use of words in common Canadian use. Her qualifications to testify as an expert were not challenged and I found her evidence to be both necessary and helpful.

[85] Ms. Barber worked on the bilingual Canadian Dictionary for two years and then, as the editor-in-chief of the Canadian Oxford Dictionary Project for 17 years, she oversaw the production of the first and second editions of the Canadian Oxford Dictionary and the production of related specialized dictionaries and other works. She is the author of books on word histories and Canadian English.

[86] Ms. Barber was asked, as an objective observer, to investigate the use of the term "French press" in Canada to determine whether it is used in common Canadian parlance, whether it is used

as a generic term for a certain type of plunger coffee maker, or whether it was used only for the products of a certain manufacturer. In her report and testimony, she described the extensive electronic databases and other sources that she relied upon. The initial search was conducted in January of 2011 and an updated search was performed in March of 2012.

[87] The entry for "French press" in the Oxford English Dictionary covers both the bodybuilding sense and the coffee pot sense. The first citation for the latter is taken from the 1976 Oakland, California *Tribune*. The OED defines "plunger pot" and "French press" as synonyms. The witness also found references to "French press" in the 2003 *Merriam-Webster's Collegiate Dictionary*, the 1999 *Encarta World English Dictionary*, the 2001 *Microsoft Encarta College Dictionary*, and the 2004 *Encarta Webster's Dictionary*, all available at the Toronto Public Library. The *Merriam-Webster Dictionary* indicates that it has a 1986 quotation for "French press" in its records.

[88] In a database of Canadian daily and weekly newspapers dating back to 1977, in the case of the *Globe and Mail*, she found 190 generic references to French presses as that type of coffee maker and method of brewing coffee. The earliest relevant item was from the *Globe and Mail* in 1985 referring to the Hario French press coffee maker.

[89] Ms. Barber found these results of generic usage over a 25 year period to be compelling evidence that the term "French press" is part of common Canadian parlance. One factor she considered is that in many of the 240 articles in which the term was used it was not "glossed", or defined within the sentence in which it appeared. That indicated, to her, that the editors who picked these articles for publication would expect their readers to know what the term meant, and this was

across the country. In searches of other newspaper and magazine databases she found additional references from 1995 and 1996.

[90] The witness also consulted terminology databases such as those produced by the federal government's translation Bureau and that of the *Office québécois de la langue française* in Québec. In the federal version, the three terms that are prescribed as correct to refer to the type of coffee maker in question are plunger coffee maker, plunger pot and French press. It is noted that "[t]hese are also referred to as a 'Bodum' or as a 'Melior', two companies that make these brewers." The Quebec office prescribes "cafetière à piston" in French and gives several English synonyms the first of which is French press followed by coffee press, plunger etc. The office recommends against the use of 'Bodum' or 'Melior'.

[91] References to Bodum's own use of French Press in a generic sense were found in a 2005 advertisement published in *Gifts and Tablewares* magazine. The text referred to Bodum's creation of the "first-ever French Press coffeemaker with a plastic frame" and acquisition of Melior in 1986 allowing them to produce the "original Chambord French Press". Further in the body of the advertisement is mention that the Chambord model received the gold medal award "for best French press." Similar references were found in a 1995 article in the New York Times quoting Mr. Bodum. All of this indicated to the witness that the term was being used in a generic sense by the plaintiffs in their publicity materials.

[92] In a search of the Culinary Arts Collection database to determine how the term is used in the food and restaurant industry, the witness found 11 articles from 1990 to 1995 which all used

"French press" to refer to a type of coffee maker. Search in the Google books database produced five references from 1985 to 1990 using "French press" generically to designate the type of coffeemaker. 18 records in the Canadian trade-marks database use the term in the description of wares or services. 92 references were found in a search of three Lexis-Nexis business databases for the period between 1970 and 1995.

[93] In summary, Ms. Barber found that "French press" is by far the most frequent term used to describe this type of coffee maker dating back to the mid-1980s and becoming much more frequent from the early to mid-1990's. It is the most common term today in Canadian parlance, generically, for that device in her opinion.

[94] On cross-examination Ms. Barber could not say why "French press" did not appear in the Canadian Oxford Dictionary or other Canadian dictionaries. She indicated that space and other constraints limit the number of words and expressions that will be included. She acknowledged that some words and expressions may be unique to Canada and that trade-marks may take on a generic sense. Terms can have a dual meaning where they may be used in common parlance but also refer to a proprietary term for a manufactured product. She had not considered that Bodum began distributing its products with the term "French Press" on them in 1995 which could account for an increased familiarity with the term.

[95] Ms. Barber held to her opinion that "French press" had a generic sense before it was registered as a trade-mark in Canada. She acknowledged that in some cases of citations she found it couldn't be said for certain whether the usage is generic or reference to a trade-mark. However, she

did not accept that "French press" is similar to terms which began as proprietary brands but have since taken on a generic character such as "iPod", "Thermos" or "Kleenex". Those were not words that existed in the language until the owners began making use of them, whereas the evidence she found, including references in the Globe and Mail in 1985 and the Vancouver Sun in 1987, indicated to her that French press was a word in the language before it was registered as a trademark.

[96] Dr. George Barnett, Professor of Communications at the University of California, was tendered as an expert in the flow of communications between Canada and the United States and how that affects English speaking Canadians' understanding of symbolic language and the meaning of words. His opinion did not extend to French although in his earlier research in this country, he had found that while the influence of American English on Canadian French was less pronounced it was still recognizable. As with Mr. Russell, the reception of his report and testimony was accepted subject to closing argument.

[97] In closing, the plaintiffs objected to the admission of Dr. Barnett's report on the ground that it lacked relevance as it was not connected to the issues respecting the uses of the words "French press" or the housewares industry. The report did not speak directly to the question of whether "French press" means the same in Canada as it does in the US. Dr. Barnett's opinion as to the effects of the American media on the Canadian market was therefore not admissible, the plaintiffs contended.

[98] I was satisfied that Dr. Barnett has the necessary expertise based on his extensive work experience and scholarly research in Canada and in the United States and his responses to the questions put to him when he was examined as to his qualifications. His opinion evidence was, in my view, helpful to the Court because of the contention that Americans and English speaking Canadians may ascribe different meanings to terms such as "French press".

[99] As a result of the close economic and other ties between Canada and the United States and the extensive communications between the two countries described in his report, greater than any other two countries in the world, we share a common information environment. An information environment is comprised of all of the sources of information available to a population of a given community including a transnational community. As a result, the people of the two countries share common meanings for words, according to Dr. Barnett. In his view, this is illustrated by the patterns of searching for the term "French press" on the Internet as found in the online tool "Google Insights for Search". Since the third quarter 2008, Canada and the United States share the same cyclic search pattern for that term which indicates to him that it is used in a similar way in both countries. In other words, people in both countries search for "French presses" without an association with any particular brand.

[100] Dr. Barnett acknowledged that there are meanings of words that are unique to Canada. He had not conducted any research directly into the use of the words "French press" in either country or the circulation of print or television media using the term or the sales of products with that descriptor from the United States to Canada. When pressed, he agreed that he did not know whether the people conducting an Internet search for "French press" had the Bodum product in mind or not.

[101] Dr. Ruth Corbin is managing partner of CorbinPartners Incorporated, a market research firm, and an Adjunct Professor at the Osgoode Hall Law School. Dr. Corbin has a PhD in psychology and an LL.M in intellectual property and teaches in that field. She was tendered both as an expert and as a fact witness. Her qualifications as an expert relate to intellectual property, marketing, trade-mark infringement, the impact of advertising, statistical analysis, and survey research. She has been previously qualified as an expert in this court, and the Superior Courts of Ontario, British Columbia, Alberta and Québec. Her qualifications in these proceedings were not contested and I was satisfied that her opinion evidence was necessary and helpful to the Court.

[102] Dr. Corbin was retained to investigate the use of the term "French press" in the Canadian marketplace and to gather empirical data on how the term is being used. In particular she was asked to determine whether the term is used generically or to distinguish one particular source of non-electric coffee makers from other sources of the same kind of coffee makers. To that end, she supervised a five-part investigation: (a) an examination of the use of "French press" on Internet sites accessible to Canadian consumers; (b) interactions with salespersons in retail stores where coffeemakers are sold; (c) canvassing of product packages in grocery stores; (d) consultation of specialized books about coffee making; and (e) a review of how the words "French press" are used in print media and advertising.

[103] Dr. Corbin's findings were as follows:

- i. Internet searches that might be carried out by consumers in Canada wishing to be informed about "French press" products disclosed that in a large majority of instances (83%), the term is used as a descriptive name:

- ii. When "French press" appeared in print in books about coffee making, in most instances (5/6) it appeared as a descriptive term and not in association with the device of any particular manufacturer;
- iii. Searches of printed media disclosed that in the majority of cases where "French press" is used, it is used as a descriptive term;
- iv. In "mystery shopping" at retail stores, in no case did clerks volunteer the term "French press" in association with a particular manufacturer and in a third of the cases they volunteered it to describe coffeemakers other than those of the Bodum brand;
- v. Nine bags of differently branded coffee were purchased in grocery stores on which the term "French press" is used in a descriptive sense; and
- vi. A search of the Canadian Intellectual Property Office database disclosed nine instances where "French press" appears as a descriptive name in the list of wares and services of registered trade-marks other than those registered to PI Design AG.

[104] Her conclusion based on this evidence was that "French press" is predominantly used as a generic term to describe a particular kind of non-electric coffee maker rather than to refer to a particular source or manufacturer of such coffeemakers.

[105] On cross-examination she conceded that if an ordinary consumer had been exposed to the Bodum packaging with the "French Press" trade-mark on it they might have the Bodum brand in mind when they use the term generically. She could not say whether the producers of the coffee brands have a Bodum in mind when they refer to the type of coffee maker on their packages as a "French Press". But the fact that the term appears next to words such as "percolator" designating other types of coffee makers indicates that in that context it is used in a descriptive sense.

[106] Dr. Corbin did not agree that Bodum was using “French Press” on their packaging in a way that would convey to consumers that it is a brand name. She did not take their volume of sales into account in forming her opinion. Her research intentionally avoided stores that carried only Bodum products because her staff would have been unable to determine whether the sales personnel used the term descriptively or as a brand name.

ANALYSIS:

[107] The Court dealt with several procedural and evidentiary issues during the course of the trial. Among them was an issue respecting production of the experts’ working papers and the admissibility of documentary evidence not disclosed prior to trial.

Request for production of defence experts’ working papers.

[108] The plaintiffs moved for production of the defence experts’ working papers, draft reports and correspondence, including email, between the experts and counsel and third parties relating to their mandate, retainer and the production of their reports. The defendant objected to this request on the ground that it exceeded requirements for production of expert reports under the *Federal Courts Rules*, SOR/98-106.

[109] When a similar question arose in *Jesionowski v. Gorecki* [1992] FCJ No 816 (QL), Justice Barbara Reed chose to follow the guidance of Justice Finch, as he was then, in *Vancouver Community College v Phillips* (1987), 20 BCLR (2d) 289 at 296-297, [1987] BCJ No 3149 (QL) at

para 28. In that case, Justice Finch ruled that in holding out the opinion evidence as trustworthy, the party calling the witness impliedly waives any privilege that previously protected from production the expert's papers that are relevant to the preparation or formulation of the opinions offered as well as to their consistency, reliability, qualifications and other matters touching on their credibility. See also *Lax Kw'alaams Indian Band v Canada (Attorney General)*, 2007 BCSC 090 at para 3.

[110] The principles expressed by Chief Justice Finch in *Vancouver Community College* have been incorporated into the British Columbia *Supreme Court Civil Rules*, BC Reg 168/2009, as Rule 13-4(11) by Order in Council 191 dated May 26, 2011, Schedule A, online: <http://www.ag.gov.bc.ca/new-rules/pdfs/OIC-2011.pdf>.

Rule 13-4 — Examinations in Aid of Execution

Production of documents

(11) Unless the court otherwise orders, the person to be examined for discovery under this rule must produce for inspection on the examination all documents in his or her possession or control, not privileged, relating to the matters referred to in subrule (2). [en. B.C. Reg. 95/2011, Sch. A, s. 6 (b).]

[111] Under Rule 4 of the *Federal Courts Rules*, the Court may provide for any procedural matter not provided for in the Rules or in an Act of Parliament by reference to the practice of the superior court of the province to which the subject-matter of the proceeding most closely relates.

[112] I chose to follow the British Columbia practice as the trial was taking place in that province and ordered the production of the experts' preliminary working papers and draft reports. I ruled that the plaintiff would have to lay a foundation for the production of any correspondence between counsel and the experts as I considered that, barring a showing to the contrary, such

communications were subject to litigation privilege and their admissibility had not been established. No further request was made for their production.

Objection to the Davies evidence:

[113] The plaintiffs objected to the admissibility of two volumes of documents relating to the website research conducted by Mr. Davies during his testimony as not having been disclosed prior to trial. They asserted that this was contrary to Rule 232(1)(c) of the *Federal Court Rules* as Mr. Davies was someone “under the control” of the defendant and the documents were not disclosed prior to trial. Because the documents were not disclosed by the defendant in its production they were not issues that the plaintiffs had to deal with in preparing for the trial. They also submitted that the documents were not put to the plaintiffs’ witnesses during cross-examination contrary to the rule in *Browne v Dunn* (1893), 6 R 67 (HL).

[114] Having heard submissions from counsel I was satisfied that there was no breach of Rule 232. This was not “trial by ambush” as was contended. In pre-trial case management the parties had agreed to an expedited trial and to deal with certain issues through requests to admit. The defendant’s requests to admit addressed, among other things, third party use of “French Press”. The request set out a list of product names and website addresses. Attached to the request was either the website document or a picture of the particular product. All of the products were, therefore, in issue as being on sale to Canadians from the websites. Shortly before trial the plaintiffs refused to admit these facts despite having been clearly put on notice that this evidence would be relied upon by the

defendant at trial. In those circumstances, the defendant was entitled, in my view, to introduce the evidence through its witness.

[115] The intent of Rule 232 is to prevent a party from withholding documents which it should have disclosed in its affidavit of documents prior to trial to avoid unfair surprise. That was not the case here as sufficient notice was given of the nature of the evidence that the defendant would lead at trial and it was all available or accessible to the plaintiffs. Nor was the introduction of this evidence in contravention of the rule in *Browne v Dunn* as the substance of the evidence was clearly put to the plaintiffs' witnesses during cross-examination. The defendant did not attempt to contradict the evidence of the plaintiffs' witnesses by introducing evidence during its case that they were not aware of and had not been put to them.

Is "French Press" a valid trade-mark?

Distinctiveness

[116] To be valid, a trade-mark must be distinctive. It must, as set out in s 2 of the *Trade-Marks Act*, actually distinguish the wares in association with which it is used by its owner from the wares of others. As stated in *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at paragraph 75, "distinctiveness is of the very essence and is the cardinal requirement of a trade-mark".

[117] Distinctiveness is a question of fact. The three conditions that must be established are: (1) the mark and wares must be associated; (2) the mark's owner must use this association in

manufacturing and selling its wares; and (3) this association must enable the mark's owner to distinguish its wares from those of others: *White Consolidated Industries, Inc v Beam of Canada Inc* (1991), 39 CPR (3d) 94 at 109-110, 1991 CarswellNat 214 at paras 59, 69 (FC).

[118] There is no dispute in these proceedings that the first two conditions are met. Bodum has used the mark in association with its wares by putting it on the packaging and instructions inserts for its non-electric coffee makers sold in Canada between May 5, 1997 and February 10, 2010. The issue is whether this association enabled Bodum to distinguish its wares from those of others that also used the term.

[119] Bodum makes no claim to exclusivity prior to 1995. I accept that, as Katherine Barber's research found, the incidence of the use of the term "French press" in the media increased significantly after 1995. I infer that this is attributable, at least in part, to Bodum's decision to make use of the term and to include it on its packaging.

[120] The French press type of coffee maker represents a relatively small portion of the coffee maker market in Canada. According to Mr. Russell, Canadians rely predominantly on the paper filter drip type. To the extent that Canadians know of and use a French press, the name Bodum has become synonymous with the product, particularly in Quebec. Bodum's sales between 1995 and 2005 ranged from a low of 30,000 units to a high of 90,000. None of its competitors, including BonJour, came close to that volume. But that did not make Bodum's use of the term distinctive of its products as opposed to others using the term in the market.

[121] The plaintiffs' most distinguishable trade-mark is, in fact, its corporate name. That name features prominently on all of their packaging and promotional materials. On most of its packaging "Bodum" appears in large letters over an image of the product, followed by the model name of the product and only then, in much smaller print, "French Press ®". Dr. Corbin's evidence was that the inclusion of this mark on the Bodum packaging had little effect.

[122] Wherever "French Press ®" appears in advertisements and on the packaging, its appearance is insignificant in comparison to the image of the product, the corporate name and the model name. There is no evidence that "French Press ®" was ever used as a self-standing mark by the plaintiffs. That in itself compromises the plaintiffs' position: *General Motors of Canada v Décarie Motors Inc* (2000), 9 CPR (4th) 368 (FCA) at para 34.

[123] Mr. Perez testified that he understood that Jørgen Bodum invented the term sometime between 1993 and 1995. But he has no personal knowledge of this and the weight of the evidence is clearly to the contrary. The term was already in generic use in Canada and elsewhere before Bodum purported to adopt it. The defendant has put forward many examples of such usage including several by Jørgen Bodum himself.

[124] I accept the evidence of Koen de Winter that Bodum decided to use the term to distinguish this category of product from the other types of housewares that the firm was offering to the retail market, such as salt and pepper shakers. They may have had the intent of using it as a trade-mark. The evidence that they used the English term in other languages on their packaging supports that inference. However, that use did not have the effect of distinguishing Bodum's brand of non-electric

coffee makers from the other similar products on the market. The term "French press" had already been employed by other manufacturers and distributors following the introduction of the products to the Canadian and American markets. The appearance of the term in advertisements and packaging by those manufacturers and distributors is evidence of the ordinary and *bona fide* commercial use of the term in Canada prior to the plaintiffs' first use of the mark. It was a generic commercial term to describe the type of device and method of brewing coffee before Bodum chose to employ it as a mark in Canada.

[125] This conclusion is supported in particular by Katherine Barber's review of the history of the use of the term. The records of such use preceded Bodum's decision to employ the mark by almost twenty years in the US (Oakland Tribune advertisement dated November 21, 1976 cited by the OED) and ten years in Canada (Globe and Mail article dated December 11, 1985 which explicitly references a non-Bodum product – the Hario French press). Other examples I consider noteworthy are a February 1987 article in *The Vancouver Sun* and a 1991 book by Timothy Castle entitled *The Perfect Cup: A Coffee-Lover's Guide to Buying, Brewing and Tasting*.

[126] This evidence is supported by the research conducted by Dr. Corbin, the evidence of Ms. Wise, Mr. Harari, concessions made by several of the plaintiff's witnesses on cross-examination and the evidence of statements by Bodum's officers who used the term in a generic sense.

[127] The plaintiffs acknowledge that several of their witnesses agreed that the term "French press" was often used generically, including by Bodum management. Some twenty-two examples of generic references by Bodum were identified in the evidence. Bodum's publicity agent, Ms

Cacciato, agreed that her efforts to insist on the trade-mark in materials provided to journals for publication were unsuccessful as the media continued to use it in a generic sense. The defendant produced evidence of some 222 generic references to “French press” in newspapers and magazines and 73 references in 24 websites including sites evidently based in Canada such as greenbeanery.ca, shopbot.ca and homehardware.ca.

[128] The defendant tendered evidence of fifteen coffee products from third party manufacturers and distributors now using the term “French press” on their advertising, packaging or in their product inserts. Ten varieties of coffee brands employing “French press” on their packaging for products sold in Canada were also identified. Moreover, the term is now commonly found on at least three well known coffee grinders sold to consumers in Canada as a setting for the coarse ground coffee which is best suited for this type of device.

[129] I recognize that some of these products, such as the Oxo, Le Creuset and Espro French presses, have entered the market since the date of the filing of the counterclaim which put the validity of the mark in issue. In the case of the Espro, it appeared on the Canadian market in April of 2010, a few months after the initial filing of the counter-claim. While I must view with caution the introduction of these products after the material date, I consider that such evidence is still relevant to the question of the state of the market place before that date as it is consistent with the widespread and continued use of the term.

[130] Bodum amended its claim a month before trial to add the BonJour product line. That required an amended statement of defence and counterclaim in which the validity of the trade-mark

was again called into question. It is arguable that the relevant date for determining distinctiveness should therefore be extended to the later filing date. I do not consider it necessary to make that determination in light of my other findings.

[131] The mark has been used in an ordinary commercial sense in several Canadian patent applications and industrial design registrations. The Canadian Intellectual Property Office has, since issuing the Bodum trade-mark registration, issued or allowed 14 other registrations to third parties that include the words “French press” or “French presses” within their description of wares.

[132] Bodum has used the term in a generic sense in three Canadian patent applications without identifying it as a trade-mark. Moreover it has used the term as the common name generally known and used by the public in two Canadian industrial design registrations: *Industrial Design Regulations*, SOR/99-460, s 9(2)(b).

[133] The plaintiffs rely upon *Thermos and Institut National des Appellations d’Origine des Vins et Eaux-de-vie et al v Andres Wines Ltd et al* (1987), 16 CPR (3d) 385, aff’d 30 CPR (3d) 279 (Ont CA) (“*Champagne*”) for the proposition that a word can take on a generic aspect through repeated use over time, including by the trade-mark owner, while retaining its validity as a trade-mark. As stated by the Supreme Court of Canada in *Mattel, Inc v 3894207 Canada Inc*, above, at para 75, an everyday expression not originated by the trade-mark owner would normally receive less protection than in the case of an invented, unique or non-descriptive word.

[134] The plaintiffs contend that for many Canadian consumers, as indicated by Mr. de Winter's evidence, Bodum is synonymous with this type of non-electric coffee maker. I also note Mr. Russell's evidence that students would occasionally say "you mean a Bodum" when he referred to the French press as one of the types of coffee makers they needed to be familiar with. The plaintiffs rely on that statement as evidence of the understanding of ordinary and average consumers. In my view, the anecdote doesn't establish that to the students the words "French press" means a Bodum but rather that they were familiar with the Bodum brand of that type of coffee maker. I accept that Bodum popularized the category in the Canadian market place through its marketing efforts. They established a reputation for the name "Bodum" but not for the name French Press.

[135] Ms Wong's evidence, as the only retailer to testify, did not persuade me that the term "French press" was synonymous with the Bodum brand. Her evidence was that she had used "coffee press" consistently for years in her advertisements to describe the Bodum products until she was asked to use the trade-mark.

[136] The plaintiffs urged me to find similarities in the evidence in this proceeding to the *Thermos* case. However, "Thermos" was a made up name, such as "Kleenex", which, subsequent to the introduction of the product and market success, became a generic term for the type of product associated with the mark and was used as an example by several of the Bodum witnesses. That is not the case here. Bodum is not trying to protect a coined word from falling into the public domain. This matter is analogous to cases in which the trade-mark claimant is trying to appropriate a word from the common language for its exclusive use: *Canadian Shredded Wheat Co. v Kellogg Co. of*

Canada, [1938] Ex CJ No 9, [1969] 1 DLR 7; *Brûlerie Des Monts Inc v 3002462 Canada Inc*, (1997), 75 CPR (3d) 445.

[137] Among the factors that may be considered in assessing distinctiveness are the efforts which the trade-mark owner exercised to police its rights: *Thermos*, above, at page 260-261. Bodum did nothing to enforce its trade-mark in Canada from the date of its adoption until it initiated this action in 2009 without prior notice. During those years, the use of the term as a generic expression increased significantly. Bodum itself contributed to this trend by circulating positive editorial materials in which there are generic references to French presses.

The effect of the US market and US Trademarks Appeal Board decision

[138] The plaintiffs acknowledge that the presence of American products on the Canadian market with the words “French press” on the packaging is a relevant consideration on the question of distinctiveness. They contend, however, that evidence as to the extent that American advertising and the reputation of the words in the American context have come into the Canadian market, it should be excluded on the basis of the rationale expressed by Justice Rouleau in *Philip Morris Inc v Imperial Tobacco Ltd* (1985), 7 CPR (3d) 254 at paras 90-92; as affirmed by the Court of Appeal in (1987), 17 CPR (3d) 289, 1987 CarswellNat 701, leave denied [1988] SCCA No 61 (QL). Justice Rouleau held that the circulation of U.S. publications in Canada was not sufficient to establish that the trade-mark in question had lost its distinctiveness; to find otherwise, the Court of Appeal added,

would be to subject Canadian registrants to a *force majeure* over which they had no effective control (1987 CarswellNat 701 at para 24).

[139] The principle was reiterated by Justice de Montigny in *Philip Morris Products SA v Marlboro Canada Ltd* [2010] FCJ No 1385 (QL); 2010 FC 1099 at para 300; varied in part but not on this point [2012] FCJ No 878 (QL); 2012 FCA 201. See also *Chalet Bar B Q (Canada) Inc v Foodcorp Ltd* (1982), 66 CPR (2d) 56, 1982 CarswellNat 472 (FCA) at para 39.

[140] The plaintiffs contend that the court should discount the evidence of the spillover effect of American usage in the media and in marketing websites on the Internet and Dr. Barnett's evidence of the flow of communications between the two countries. However, this is not a case where the rights of a Canadian assignee were being affected by the effect of advertising by the owner of the US mark, as discussed by Justice de Montigny in the Marlboro litigation. It is not a case of potentially lost distinctiveness but rather, one in which the plaintiffs assert the right to close off a term already in use within the North American industry at least a decade earlier.

[141] In my view, Dr. Barnett's evidence was, in essence, a statement of the obvious; that the flow of information across our border from the US has an influence on the Canadian perception of the meaning of the information. It was not necessary to rely on Dr. Barnett's opinion to reach that conclusion. In my view, the Court can take judicial notice of the movement of information across the Canada-US border.

[142] That is not to say that Canadian trade-marks must succumb to the *force majeure* of the American market but recognizes the practical reality of trans-border communications. Magazines and books published in the US are commonly available in this country. We watch an extraordinary amount of television produced in the US and accessible in Canada either free-to-air (by antenna) or through cable and satellite services. The Internet is a medium without frontiers. We routinely shop at American retailers through their on-line web pages and order goods for shipment across the border. The plaintiffs take advantage of the cross-border market reality. Bodum no longer rely on a Canadian based distributor but manage their Canadian sales operations from the US. They no longer attend the Canadian housewares trade shows and rely, for the most part, on US based staff who visit Canada from time to time. The same packaging and advertising is used in distributing and promoting their products in both countries. It does not sit well for Bodum to now claim that the Court should find that a wall separates Canada and the US when it comes to the influence of cross-border information and sales.

[143] Given the integration of the American and Canadian markets, I considered a 1999 decision of the U.S. Trademark Trial and Appeal Board to be instructive: *In re PI-Design AG*, US TTAB 1999, online; <http://des.uspto.gov/Foia/RetrievePdf?flNm=74580176-07-29-1999&system=TTABIS>. In that decision, the Board denied an appeal from an examiner who refused registration of the plaintiffs' "French Press" mark under s 2(e)(1) of the *Trademark Act*, 15 USC 1052 (e)(1) on the ground that it was merely descriptive. Applying the US test for "genericness", the Appeal Board found that the purchasing public would understand "French Press" as referring to the relevant category or class of goods. Alternatively, the Board refused to approve registration under 2(f) of the Act for insufficient evidence of acquired distinctiveness. No appeal

was taken from this decision to the U.S. District Court or to the Court of Appeal for the Federal Circuit and the application for registration of the mark was abandoned.

[144] With regard to the use of foreign jurisprudence, it is permissible for the Court to find some assistance in authoritative decisions provided that it proceeds very carefully in doing so: *Thomas & Betts, Ltd v Panduit Corp*, [2000] 3 FC 3 (FCA) at para 28. See also *Canadian Shredded Wheat Co. v Kellogg Co. of Canada*, [1939] 1 DLR 7 at para 7; *Cie générale des établissements Michelin - Michelin & Cie c National Automobile, Aerospace, Transportation and General Workers Union of Canada (CAW - Canada)*, [1996] FCJ No 1685 (QL) at para 66; and *Compo Co Ltd v Blue Crest Music et al*, [1980] 1 SCR 357, at pp 366-367.

[145] The evidence presented to the US Appeal Board in the 1999 decision was similar to that before the Court in this proceeding and the Board's decision is consistent with my own findings in this matter. Counsel advised that there was nothing in the Board's decision that turned on a vagary of US law in contrast to Canadian trade-mark law to their knowledge.

[146] I was satisfied that I could take the US decision into account in deciding this matter. However, it did not add any significant weight to the evidence favouring the defendant's position. Nor did I consider the plaintiffs' allegedly misleading use of the trade-mark registration symbol on Bodum packaging in the US, as argued by the defendant, to be relevant to the determination of the issues before me.

Conclusion on distinctiveness:

[147] Ultimately, in assessing distinctiveness, the court must apply its own common sense to the evidence: *Thorkelson v PharmaWest Pharmacy Limited*, 2008 FCA 100 at paragraph 15. Here, in my view, the evidence is compelling that the term “French press” was already in widespread use in North America when Bodum sought to appropriate it for its exclusive use and it wasn’t registrable at the date of registration.

[148] For the purposes of this action it is sufficient for me to find that the mark was not distinctive at the time its validity was called into question and I so find. But I am also satisfied that it was not distinctive when it was registered in Canada and consider that the application should not have been approved. Bodum has not established that a clear message was ever given to the public that the wares with which the trademark is associated and used are the wares of the trade-mark owner and not those of another party.

[149] On the strength of the evidence presented, the presumption of validity, as discussed in *Cheaptickets*, above, does not avail the plaintiffs. I agree with the defendant that “French press” is and was at all relevant times a common name for the type of non-electric coffee making device at issue in these proceedings, and the method of brewing coffee using such a device. The term was not distinctive when the application for registration was filed, when it was completed or when proceedings bringing the validity of the registration into question were commenced. The registration is invalid because the term was and is in ordinary and *bona fide* commercial use as a generic term.

Other Grounds of Invalidity:

[150] Paragraph 12(1)(b) provides that a trade-mark is not registrable when it is clearly descriptive of the character of the wares in association with which it is used. To be “clearly descriptive”, the term must relate to the composition of the goods or products or refer to an obvious intrinsic quality of the wares, such as a feature, trait or characteristic of the product itself in the sense that it would be the immediate and first impression of the everyday user: *Provenzano v Registrar of Trade-marks* (1977), 37 CPR (2d) 189 (FC) at para 2; *ITV Technologies, Inc v WIC Television Ltd*, 2003 FC 1056 at para 67; aff’d 2005 FCA 96.

[151] I infer from the evidence that the words “French” and “press” were associated with this type of coffee maker because of the place of manufacture of the Melior Chambord brand that was being imported into Canada and the US in the 1970s and 80s. Those words were then linked to other manufacturer’s products such as the Hario French press also sold in Canada in the 1980s. “Press” describes the method by which the beverage is separated from the coffee grains. I find that the two words taken together are clearly descriptive of the type of product itself. The trade-mark is, therefore, invalid on the ground of descriptiveness.

[152] Paragraph 12(1)(c) states that a trade-mark is not registrable where it is the name in the language of the wares or services in connection with which it is used or proposed to be used. I find from the evidence that “French press” was one of the commonly used names in English in Canada at the time the application was filed to describe the type of device at issue in these proceedings. It should not, therefore, have been registered as a trade-mark.

[153] Bodum contends that by reason of s 17(2) of the Act, its registration cannot be expunged or amended or held invalid on the ground of the previous use by a person other than Bodum, unless it's established that Bodum adopted the trade-mark in Canada with knowledge of that previous use. Bodum thus argues that the use, for example, of "French press" by Hario in 1985 and the use of the term by BonJour in the early 1990s, cannot go to invalidating the registration. I infer from the evidence that Bodum corporate management, specifically Jørgen Bodum and Carsten Jorgensen, knew of the previous use of the term when they adopted it as a trade-mark because of their knowledge of the marketplace and concerns expressed to Koen de Winter about the BonJour competition. For that reason, I impute the necessary knowledge to Bodum and will order that the trade-mark be expunged.

Other findings

[154] In the event that I am found to have erred in arriving at my conclusions on the validity of the trade-mark, I will set out briefly my findings on the other issues raised by the parties.

[155] The evidence does not establish that the defendant used "French press" as a trade-mark in association with the sales of its products in Canada. Rather, its use of the term was in a descriptive sense to identify the product as a particular type of coffee-maker and to distinguish that category of product from its other wares. Moreover, Bodum did nothing to exercise its rights to the trade-mark notwithstanding its knowledge since at least the early 1990s of the Prestige and BonJour products on the Canadian market. In my view, they can not now fairly complain about the defendant's descriptive use of the term on its products. I am also satisfied on the evidence before me that the use

by other manufacturers was of such an extent by the time these proceedings were commenced as to render meaningless any claim of distinctiveness: *Unitel Communications Inc v Bell Canada* (1995), 61 CPR (3d) 12 (FCTD).

[156] There is no evidence that the use of the term by others has caused confusion in the Canadian market between the plaintiffs' products, which are distinguishable primarily by the registered trademark BODUM, and the defendant Meyer's products. The sale of the Prestige line was primarily to lower end discounters with whom Bodum did not deal. Those sales were not a concern to Danesco according to Mr. de Winter. Similarly, sales of the BonJour line, imported by third parties, were never significant apart from a brief period when they were marketed by a major retailer. Most of those products were recalled and remaindered out of the country due to a concern over the composition of the plastic.

[157] Mr. Perez acknowledged these facts in his evidence. At best he could recall one instance of possible confusion in the US. As there is no evidence of confusion in Canada, there can be no passing off. Nor is there any evidence of a depreciation of Bodum's goodwill while the allegedly infringing products were on the market. Bodum dominated the market throughout the relevant time-frame by at least a factor of ten.

[158] Accordingly, no damages would have been awarded had I found that the trade-mark was valid and the defendant's use infringing. I would not grant an equitable remedy such as an accounting for profits or an injunction. The evidence is that Bodum's share of the market has been maintained and Meyer's, always minor in comparison, has been declining.

[159] Bodum knew of the use of the term “French press” by the defendant’s predecessor in title since at least 1997 as evidenced by the settlement agreement which ended the trade-dress and other disputes between Bodum and Culinary and several individuals. I recognize that the settlement agreement does not expressly confer a license to use the trade-mark in Canada and that there is no evidence of an express intent to waive Bodum’s Canadian rights. Indeed, at section 14, it states that the agreements dealing with the intellectual property rights applies only in the US and shall have no effect on any party’s rights in any other country subject to the proviso that Bodum agreed not to take action to prevent Culinary from selling current BonJour products in “in any country in North America”. The agreement expressly incorporates the license for the trade dress rights into Canada of Culinary’s BonJour product. At paragraph 13, Bodum undertook not to seek “damages from or injunctive relief against [Culinary] for selling BonJour products currently sold in the North America and not listed on page 5 of Exhibit B, the license agreement.” Page 5 of Exhibit B lists 15 BonJour French presses.

[160] In negotiating this agreement, it is clear that Bodum was more concerned with the minutiae of the appearance of the BonJour products than in asserting trade-mark rights. Nonetheless, while Bodum did not grant a license to the use of the mark in Canada, the term “French press” is used 18 times in the agreement and its attachments in reference to permitted sales throughout North America. BonJour, and Meyer, as the successors in title, acted in reliance on that agreement. I agree with the defendant that it would be unjust to allow Bodum to now resile from the broader implications of that agreement merely because its lawyers and management were not alive to them when it was signed. At the very least, it is evidence that Bodum did not take active measures to protect its claimed mark and through the agreement undermined its claim to distinctiveness.

COSTS:

[161] The defendant, having been successful on the claim and counterclaim, shall have its costs. The parties requested an opportunity to submit written submissions on costs. They shall first have an opportunity to determine whether they can settle the question between themselves. Failing that, the defendant shall submit a bill of costs within 60 days of the date of this judgment together with its written representations. The plaintiffs will have 30 days thereafter in which to submit their written representations as to costs. The defendants will then have a further 15 days in which to submit a reply. The Court will then determine the award in writing without a hearing.

JUDGMENT

THIS COURT'S JUDGMENT is that:

1. The plaintiff's action for declaratory relief, damages and an injunction is dismissed;
2. The defendant's counterclaim for a declaration that Trade-mark Registration No. TMA475,721 is invalid is granted;
3. Trade-mark Registration No. TMA475,721 shall be expunged from the Register of Trade-Marks;
4. The defendant, plaintiff by counterclaim, is awarded the costs of this action including the counterclaim and the application in Court File No. T-738-11.

"Richard G. Mosley"

Judge

ANNEX A

LEGISLATIVE PROVISIONS

Trade-marks Act**RSC, 1985, c T-13**

Definitions

2. In this Act,

“distinctive”, in relation to a trade-mark, means a trade-mark that actually distinguishes the wares or services in association with which it is used by its owner from the wares or services of others or is adapted so to distinguish them;

When deemed to be used

4. (1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

**Loi sur les marques
de commerce****LRC (1985), c T-13**

Définitions

2. Les définitions qui suivent s'appliquent à la présente loi.
« distinctive » relativement à une marque de commerce, celle qui distingue véritablement les marchandises ou services en liaison avec lesquels elle est employée par son propriétaire, des marchandises ou services d'autres propriétaires, ou qui est adaptée à les distinguer ainsi.

Quand une marque de commerce est réputée employée

4. (1) Une marque de commerce est réputée employée en liaison avec des marchandises si, lors du transfert de la propriété ou de la possession de ces marchandises, dans la pratique normale du commerce, elle est apposée sur les marchandises mêmes ou sur les colis dans lesquels ces marchandises sont distribuées, ou si elle est, de toute autre manière, liée aux marchandises à tel point qu'avis de liaison est alors donné à la personne à qui la propriété ou possession est transférée.

Prohibitions

7. No person shall

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

(b) direct public attention to his wares, 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 wares, services or business and the wares, services or business of another;

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

(d) make use, in association with wares 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

Interdictions

7. Nul ne peut :

a) faire une déclaration fausse ou trompeuse tendant à discréditer l'entreprise, les marchandises ou les services d'un concurrent;

b) appeler l'attention du public sur ses marchandises, ses services ou son entreprise de manière à causer ou à vraisemblablement causer de la confusion au Canada, lorsqu'il a commencé à y appeler ainsi l'attention, entre ses marchandises, ses services ou son entreprise et ceux d'un autre;

c) faire passer d'autres marchandises ou services pour ceux qui sont commandés ou demandés;

d) utiliser, en liaison avec des marchandises ou services, une désignation qui est fausse sous un rapport essentiel et de nature à tromper le public en ce qui regarde :

(i) soit leurs caractéristiques, leur qualité, quantité ou composition,

(ii) soit leur origine géographique,

(iii) the mode of the manufacture, production or performance of the wares or services; or

(iii) soit leur mode de fabrication, de production ou d'exécution;

(e) do any other act or adopt any other business practice contrary to honest industrial or commercial usage in Canada.

e) faire un autre acte ou adopter une autre méthode d'affaires contraire aux honnêtes usages industriels ou commerciaux ayant cours au Canada.

Further prohibitions

10. Where any mark has by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind, quality, quantity, destination, value, place of origin or date of production of any wares or services, no person shall adopt it as a trade-mark in association with such wares or services or others of the same general class or use it in a way likely to mislead, nor shall any person so adopt or so use any mark so nearly resembling that mark as to be likely to be mistaken therefor.

Autres interdictions

10. Si une marque, en raison d'une pratique commerciale ordinaire et authentique, devient reconnue au Canada comme désignant le genre, la qualité, la quantité, la destination, la valeur, le lieu d'origine ou la date de production de marchandises ou services, nul ne peut l'adopter comme marque de commerce en liaison avec ces marchandises ou services ou autres de la même catégorie générale, ou l'employer d'une manière susceptible d'induire en erreur, et nul ne peut ainsi adopter ou employer une marque dont la ressemblance avec la marque en question est telle qu'on pourrait vraisemblablement les confondre.

Further prohibitions

11. No person shall use in connection with a business, as a trade-mark or otherwise, any mark adopted contrary to section 9 or 10 of this Act or

Autres interdictions

11. Nul ne peut employer relativement à une entreprise, comme marque de commerce ou autrement, une marque adoptée contrairement à

section 13 or 14 of the *Unfair Competition Act*, chapter 274 of the Revised Statutes of Canada, 1952.

l'article 9 ou 10 de la présente loi ou contrairement à l'article 13 ou 14 de la *Loi sur la concurrence déloyale*, chapitre 274 des Statuts révisés du Canada de 1952.

When trade-mark registrable

Marque de commerce enregistrable

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

12. (1) Sous réserve de l'article 13, une marque de commerce est enregistrable sauf dans l'un ou l'autre des cas suivants :

(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;

a) elle est constituée d'un mot n'étant principalement que le nom ou le nom de famille d'un particulier vivant ou qui est décédé dans les trente années précédentes;

(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 wares 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;

b) qu'elle soit sous forme graphique, écrite ou sonore, elle donne une description claire ou donne une description fausse et trompeuse, en langue française ou anglaise, de la nature ou de la qualité des marchandises ou services en liaison avec lesquels elle est employée, ou à l'égard desquels on projette de l'employer, ou des conditions de leur production, ou des personnes qui les produisent, ou du lieu d'origine de ces marchandises ou services;

- | | |
|--|--|
| <p>(c) the name in any language of any of the wares or services in connection with which it is used or proposed to be used;</p> | <p>c) elle est constituée du nom, dans une langue, de l'une des marchandises ou de l'un des services à l'égard desquels elle est employée, ou à l'égard desquels on projette de l'employer;</p> |
| <p>(d) confusing with a registered trade-mark;</p> | <p>d) elle crée de la confusion avec une marque de commerce déposée;</p> |
| <p>(e) a mark of which the adoption is prohibited by section 9 or 10;</p> | <p>e) elle est une marque dont l'article 9 ou 10 interdit l'adoption;</p> |
| <p>(f) a denomination the adoption of which is prohibited by section 10.1;</p> | <p>f) elle est une dénomination dont l'article 10.1 interdit l'adoption;</p> |
| <p>(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;</p> | <p>g) elle est constituée, en tout ou en partie, d'une indication géographique protégée et elle doit être enregistrée en liaison avec un vin dont le lieu d'origine ne se trouve pas sur le territoire visé par l'indication;</p> |
| <p>(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</p> | <p>h) elle est constituée, en tout ou en partie, d'une indication géographique protégée et elle doit être enregistrée en liaison avec un spiritueux dont le lieu d'origine ne se trouve pas sur le territoire visé par l'indication;</p> |
| <p>(i) subject to subsection 3(3) and paragraph 3(4)(a) of the <u>Olympic and Paralympic Marks Act</u>, a mark the adoption of which</p> | <p>i) elle est une marque dont l'adoption est interdite par le paragraphe 3(1) de la <u>Loi sur les marques olympiques et</u></p> |

is prohibited by subsection 3(1) of that Act.

paralympiques, sous réserve du paragraphe 3(3) et de l'alinéa 3(4)a) de cette loi.

Idem

Idem

(2) A trade-mark that is not registrable by reason of paragraph (1)(a) or (b) is registrable if it has been so used in Canada by the applicant or his predecessor in title as to have become distinctive at the date of filing an application for its registration.

(2) Une marque de commerce qui n'est pas enregistrable en raison de l'alinéa (1)a) ou b) peut être enregistrée si elle a été employée au Canada par le requérant ou son prédécesseur en titre de façon à être devenue distinctive à la date de la production d'une demande d'enregistrement la concernant.

Effect of registration in relation to previous use, etc.

Effet de l'enregistrement relativement à l'emploi antérieur, etc.

17. (1) No application for registration of a trade-mark that has been advertised in accordance with section 37 shall be refused and no registration of a trade-mark shall be expunged or amended or held invalid on the ground of any previous use or making known of a confusing trade-mark or trade-name by a person other than the applicant for that registration or his predecessor in title, except at the instance of that other person or his successor in title, and the burden lies on that other person or his successor to establish that he had not abandoned the confusing trade-mark or trade-name at the date of advertisement of the applicant's application.

17. (1) Aucune demande d'enregistrement d'une marque de commerce qui a été annoncée selon l'article 37 ne peut être refusée, et aucun enregistrement d'une marque de commerce ne peut être radié, modifié ou tenu pour invalide, du fait qu'une personne autre que l'auteur de la demande d'enregistrement ou son prédécesseur en titre a antérieurement employé ou révélé une marque de commerce ou un nom commercial créant de la confusion, sauf à la demande de cette autre personne ou de son successeur en titre, et il incombe à cette autre personne ou à son successeur d'établir qu'il n'avait pas abandonné cette marque de commerce ou ce nom commercial créant de

	la confusion, à la date de l'annonce de la demande du requérant.
When registration incontestable	Quand l'enregistrement est incontestable
(2) In proceedings commenced after the expiration of five years from the date of registration of a trade-mark or from July 1, 1954, whichever is the later, no registration shall be expunged or amended or held invalid on the ground of the previous use or making known referred to in subsection (1), unless it is established that the person who adopted the registered trade-mark in Canada did so with knowledge of that previous use or making known.	(2) Dans des procédures ouvertes après l'expiration de cinq ans à compter de la date d'enregistrement d'une marque de commerce ou à compter du 1 ^{er} juillet 1954, en prenant la date qui est postérieure à l'autre, aucun enregistrement ne peut être radié, modifié ou jugé invalide du fait de l'utilisation ou révélation antérieure mentionnée au paragraphe (1), à moins qu'il ne soit établi que la personne qui a adopté au Canada la marque de commerce déposée l'a fait alors qu'elle était au courant de cette utilisation ou révélation antérieure.
When registration invalid	Quand l'enregistrement est invalide
18. (1) The registration of a trade-mark is invalid if	18. (1) L'enregistrement d'une marque de commerce est invalide dans les cas suivants :
(a) the trade-mark was not registrable at the date of registration,	a) la marque de commerce n'était pas enregistrable à la date de l'enregistrement;
(b) the trade-mark is not distinctive at the time proceedings bringing the validity of the registration into question are commenced, or	b) la marque de commerce n'est pas distinctive à l'époque où sont entamées les procédures contestant la validité de l'enregistrement;

(c) the trade-mark has been abandoned, and subject to section 17, it is invalid if the applicant for registration was not the person entitled to secure the registration.

c) la marque de commerce a été abandonnée. Sous réserve de l'article 17, l'enregistrement est invalide si l'auteur de la demande n'était pas la personne ayant droit de l'obtenir.

Rights conferred by registration

Droits conférés par l'enregistrement

19. Subject to sections 21, 32 and 67, the registration of a trade-mark in respect of any wares or services, unless shown to be invalid, gives to the owner of the trade-mark the exclusive right to the use throughout Canada of the trade-mark in respect of those wares or services.

19. Sous réserve des articles 21, 32 et 67, l'enregistrement d'une marque de commerce à l'égard de marchandises ou services, sauf si son invalidité est démontrée, donne au propriétaire le droit exclusif à l'emploi de celle-ci, dans tout le Canada, en ce qui concerne ces marchandises ou services.

Infringement

Violation

20. (1) The right of the owner of a registered trade-mark to its exclusive use shall be deemed to be infringed by a person not entitled to its use under this Act who sells, distributes or advertises wares or services in association with a confusing trade-mark or trade-name, but no registration of a trade-mark prevents a person from making

20. (1) Le droit du propriétaire d'une marque de commerce déposée à l'emploi exclusif de cette dernière est réputé être violé par une personne non admise à l'employer selon la présente loi et qui vend, distribue ou annonce des marchandises ou services en liaison avec une marque de commerce ou un nom commercial créant de la confusion. Toutefois, aucun enregistrement d'une marque de commerce ne peut empêcher une personne :

(a) any *bona fide* use of his personal name as a trade-name, or

a) d'utiliser de bonne foi son nom personnel comme nom commercial;

(b) any *bona fide* use, other than as a trade-mark,

b) d'employer de bonne foi, autrement qu'à titre de marque de commerce :

(i) of the geographical name of his place of business, or

(i) soit le nom géographique de son siège d'affaires,

(ii) of any accurate description of the character or quality of his wares or services, in such a manner as is not likely to have the effect of depreciating the value of the goodwill attaching to the trade-mark.

(ii) soit toute description exacte du genre ou de la qualité de ses marchandises ou services, d'une manière non susceptible d'entraîner la diminution de la valeur de l'achalandage attaché à la marque de commerce.

Depreciation of goodwill

Dépréciation de l'achalandage

22. (1) No person shall use a trade-mark registered by another person in a manner that is likely to have the effect of depreciating the value of the goodwill attaching thereto.

22. (1) Nul ne peut employer une marque de commerce déposée par une autre personne d'une manière susceptible d'entraîner la diminution de la valeur de l'achalandage attaché à cette marque de commerce.

Action in respect thereof

Action à cet égard

(2) In any action in respect of a use of a trade-mark contrary to subsection (1), the court may decline to order the recovery of damages or profits and may permit the defendant to continue to sell wares marked with the trade-mark that were in his possession or under his control at the time notice was

(2) Dans toute action concernant un emploi contraire au paragraphe (1), le tribunal peut refuser d'ordonner le recouvrement de dommages-intérêts ou de profits, et permettre au défendeur de continuer à vendre toutes marchandises revêtues de cette marque de commerce qui

given to him that the owner of the registered trade-mark complained of the use of the trade-mark.

étaient en sa possession ou sous son contrôle lorsque avis lui a été donné que le propriétaire de la marque de commerce déposée se plaignait de cet emploi.

Licence to use trade-mark

Licence d'emploi d'une marque de commerce

50. (1) For the purposes of this Act, if an entity is licensed by or with the authority of the owner of a trade-mark to use the trade-mark in a country and the owner has, under the licence, direct or indirect control of the character or quality of the wares or services, then the use, advertisement or display of the trade-mark in that country as or in a trade-mark, 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 trade-mark in that country by the owner.

50. (1) Pour l'application de la présente loi, si une licence d'emploi d'une marque de commerce est octroyée, pour un pays, à une entité par le propriétaire de la marque, ou avec son autorisation, et que celui-ci, aux termes de la licence, contrôle, directement ou indirectement, les caractéristiques ou la qualité des marchandises et services, l'emploi, la publicité ou l'exposition de la marque, dans ce pays, par cette entité comme marque de commerce, nom commercial — ou partie de ceux-ci — ou autrement ont le même effet et sont réputés avoir toujours eu le même effet que s'il s'agissait de ceux du propriétaire.

Patent Rules

Règles sur les brevets

SOR/96-423

DORS/96-423

76. Any trade-mark mentioned in the application shall be identified as such.

76. Toute marque de commerce mentionnée dans la demande est désignée comme telle

FEDERAL COURT

SOLICITORS OF RECORD

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