

Federal Court



Cour fédérale

Date: 20120926

Docket: T-735-07

Citation: 2012 FC 1128

Ottawa, Ontario, September 26, 2012

PRESENT: The Honourable Mr. Justice Boivin

BETWEEN:

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

**Plaintiffs/
Defendants by Counterclaim**

and

TRUDEAU CORPORATION (1889) INC.

**Defendant/
Plaintiff by Counterclaim**

PUBLIC REASONS FOR JUDGMENT
(Confidential Reasons for Judgment issued September 26, 2012)

I. Overview

[1] Bodum USA, Inc. (Bodum) and PI Design AG. (collectively the plaintiffs) are commencing an action against the company Trudeau Corporation (1889) Inc. (Trudeau or the

defendant) and are seeking relief in application of the *Industrial Design Act*, RSC 1985, c I-9 [Act] on the ground of infringement of two (2) Canadian industrial designs registered under numbers 107,736 and 114,070 (industrial designs), which correspond to Bodum double wall glasses marketed by Bodum.

[2] As part of their action, the plaintiffs are also claiming that Trudeau violated paragraph 7(b) of the *Trade-marks Act*, RSC 1985, c T-13, and are raising allegations of unfair competition (offence of confusion). The plaintiffs are seeking a permanent injunction against Trudeau as well as the profits in connection with its activities.

[3] Trudeau denies acting in violation of the industrial designs in question. Trudeau also denies directing public attention to its wares in such a way as to cause or be likely to cause confusion between its wares and the wares of Bodum. Furthermore, as plaintiff by counterclaim, Trudeau is seeking a declaration that the industrial designs in question are and have always been invalid.

[4] For the following reasons, the Court finds that the plaintiffs' action should be dismissed and that Trudeau's counterclaim should be allowed.

II. Factual background

The parties

[5] The plaintiff PI Design AG. is a company established in accordance with Swiss laws, and has its place of business in Lucerne, Switzerland. It holds the intellectual property of the company Bodum USA, Inc., including industrial designs 107,736 and 114,070.

[6] The company Bodum was founded in Denmark in 1944 and markets kitchen products. The plaintiff Bodum USA, Inc. is a company established in accordance with American laws, and its place of business is in New York City in the United States.

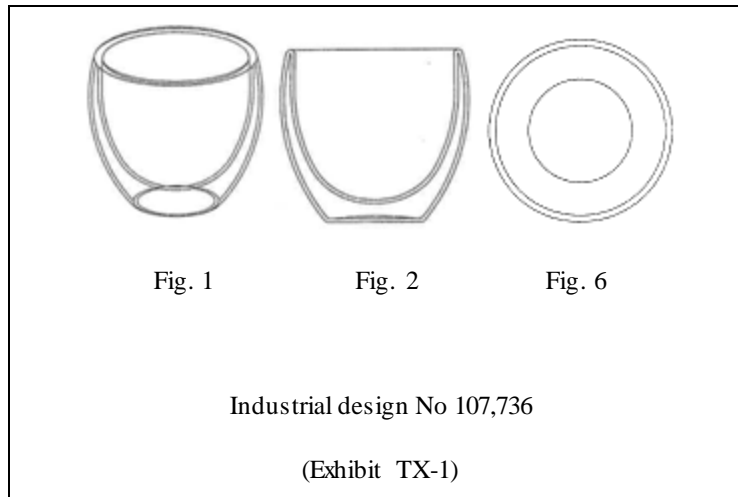
[7] PI Design AG. granted Bodum USA, Inc. a licence to distribute “Bodum” brand products in the United States, Canada, Mexico and South America. Bodum USA, Inc. has no place of business in Canada. Canadian retailers are supplied from the United States.

[8] The defendant, Trudeau, is a company established in accordance with Canadian laws, and its place of business is in Boucherville, Quebec. Founded in 1889, Trudeau is dedicated to researching and developing, designing, manufacturing, importing and marketing “Trudeau” and “Home Presence by Trudeau” brand kitchen products in Canada and around the world.

The industrial designs and the glasses in question

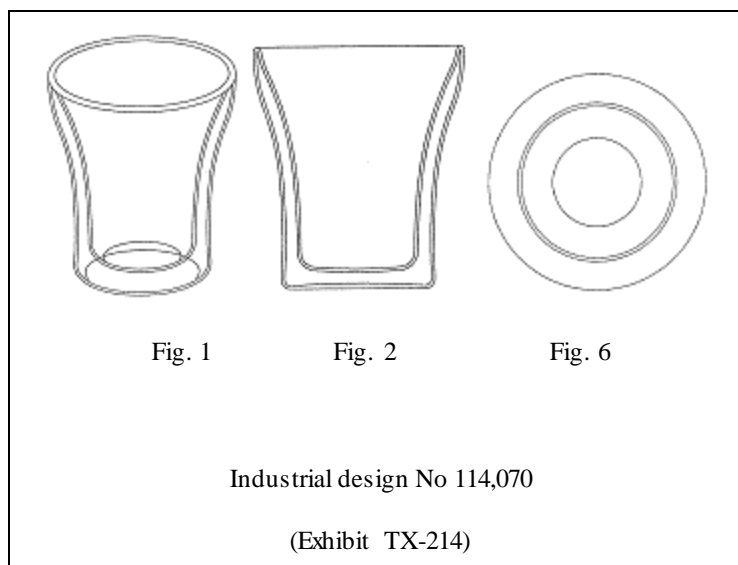
[9] Industrial design 107,736 (**TX-1**)¹ is described as follows:

¹ TX-1 corresponds to Exhibit TX-198 (Pavina)



The design consists of the visual features of the entirety of the drinking glass shown in the drawings. Drawings of the design are included wherein: Figure 1 is an oblique perspective view of the design; Figure 2 is a front view of the design; [Figure 3 is a rear view of the design; Figure 4 is a right view of the design; Figure 5 is a left view of the design]; Figure 6 is a top view of the design; and [Figure 7 is a bottom view of the design].

[10] Industrial design 114,070 (TX-214)² is described as follows:





The design consists of the visual features of the entirety of the drinking glass shown in the drawings. Drawings of the design are included wherein: Figure 1 is a perspective view of the design; Figure 2 is a front view of the design; [Figure 3 is

² TX-214 corresponds to TX-189 (Assam)

a rear view of the design; Figure 4 is a right side view of the design; Figure 5 is a left side view of the design]; Figure 6 is a top view of the design; and [Figure 7 is a bottom view of the design].

[11] The glass models **TX-186** and **TX-47** sold by Trudeau that are at issue in this case are as follows:

	
Trudeau glass	Trudeau glass
(Exhibit TX-186)	(Exhibit TX-47)
Product number: 4,601,063	Product number: 4,601,064

Earlier proceedings

[12] Bodum introduced its double wall glasses for the first time in August 2003 at the Ambiente trade fair in Frankfurt, Germany.

[13] Subsequently, Bodum's double wall glasses were introduced to the Canadian market towards the end of 2003 or the beginning of 2004 (T86 – May 22).

[14] The industrial designs 107,736 and 114,070 were filed on July 27, 2004. The industrial designs were registered with the Office of the Commissioner of Patents of the Canadian

Intellectual Property Office on February 1, 2006. The priority date for the industrial designs in question is February 18, 2004. The industrial designs have no registered variants.

[15] The Court notes that the industrial designs in question were not identified by the letter “D” in a circle with the name or the usual abbreviation of the proprietor of the design as set out in section 17 of the Act.

[16] Trudeau’s double wall glasses were introduced to the Canadian market in the fall of 2006. At the time, Trudeau was aware of the double wall glasses marketed by Bodum.

[17] On January 31, 2007, the plaintiffs sent a letter of formal notice to Trudeau. On May 1, 2007, the plaintiffs commenced this action in the Federal Court against Trudeau.

[18] On November 9, 2009, Prothonotary Morneau issued a confidentiality order. The order was renewed by the undersigned on May 16, 2012.

[19] On April 13, 2011, before the trial started, counsel for Trudeau served on counsel for the plaintiffs a written offer to settle.

[20] On January 30, 2012, Prothonotary Morneau rendered a decision setting security for Trudeau’s costs at \$55,000. That decision was appealed. On February 21, 2012, Justice de Montigny set aside Prothonotary Morneau’s decision in part and increased security for Trudeau’s costs to \$75,000.

III. Issues

[21] The issues raised in this case are the following:

- 1) Was there infringement of industrial designs 107,736 and 114,070?
- 2) Is the registration of industrial designs 107,736 and 114,070 invalid?
- 3) Does Trudeau's marketing of double wall glasses constitute unfair competition (offence of confusion)?

IV. Fact witnesses

[22] One fact witness was heard on behalf of the plaintiffs: Thomas Perez.

Thomas Perez

[23] Mr. Perez is the President of Bodum USA, Inc. He testified that he has worked at Bodum since June 2000 and that he has been the President of Bodum USA, Inc. since September 2007.

Mr. Perez provided Bodum's history and its connection to PI Design AG. In addition, Mr. Perez testified as to the presence of Bodum products on the Canadian market since the 1970s. Mr.

Perez presented various products sold by Bodum in Canada as well as Bodum's sales figures in Canada. More specifically, Mr. Perez testified as to the company's sales percentages and their breakdown into, namely, coffee presses, double wall glasses, tea products and finally, electrical appliances and other coffee makers.

[24] Regarding double wall glasses, Mr. Perez indicated that the double wall glass design was inspired by a small Japanese sake bowl spotted by Jürgen Bodum (T93 – May 22). Mr. Perez also described the introduction of the double wall glasses to the Canadian market and their marketing. In cross-examination, counsel for Trudeau raised questions concerning the amount of

Bodum sales in Canada and questions with respect to the industrial designs at issue. Furthermore, counsel for Trudeau guided Mr. Perez through a comparison between a variety of glasses and industrial designs.

[25] The defendant, Trudeau, presented two fact witnesses: Robert Trudeau and Charles Harari.

Robert Trudeau

[26] Mr. Trudeau shared the story and evolution of the Trudeau company.

[27] Mr. Trudeau is President of Trudeau's Board and has worked within the Trudeau company since 1967. He indicated that the company started to develop kitchen products in the 1980s. It was in 1995 that the company created the "Trudeau" and "Home Presence by Trudeau" brands. Mr. Trudeau testified as to the percentage of Trudeau products that are designed and manufactured by the company itself and then on the remaining percentage that represents Walt Disney brand products and Bormioli brand products distributed by the company in Canada.

[28] Mr. Trudeau also testified as to the diversity of the products sold by Trudeau on the Canadian market as well as the types of stores where products are available. In cross-examination, Mr. Trudeau confirmed that a children's double wall glass was created by Trudeau for Walt Disney in the 1990s (T202 – May 22). That glass was later submitted and shown as Exhibit P-1.

Charles Harari

[29] Mr. Harari is Vice-President of development at Trudeau. He testified that he has worked for the company since 1994 and that he is currently responsible for intellectual property issues, factory selection, quality control at the office in China, and product development.

[30] Mr. Harari testified as to the research and development of Trudeau's products. He also indicated that Trudeau has a portfolio of patents and industrial designs. Mr. Harari also testified as to the marking, labelling and packaging of Trudeau's products, as well as to the presentation of the products at the points of sale. Furthermore, Mr. Harari addressed the advertising of the company's products.

[31] Regarding Trudeau's sale of double wall glasses, Mr. Harari's testimony pertained namely to the company's initial agreement with the American company "Formation" (T57 – May 23) and his visit to the Chinese factory in 2006 (T60-62, – May 23), where the double wall glasses are made, and his initial questions concerning the intellectual property of double wall glasses. He also provided an overview of the various double wall glasses sold on the Canadian market. Finally, Mr. Harari specified that certain stores in Canada offer "Trudeau" brand products whereas others offer "Home Presence by Trudeau" brand products. There were no questions in cross-examination.

V. The expert witness

[32] Michel Morand is the only expert witness who appeared before the Court during the trial. He was called by Trudeau. His qualifications as an expert witness in industrial design as well as the content of his report were not the subject of objections by the plaintiffs.

Michel Morand

[33] Mr. Morand obtained a bachelor's degree in industrial design from the Université de Montréal in 1979. He started his own industrial design consultation office, Enta Design, in 1979.

[34] Mr. Morand gave an overview of the work of an industrial designer and explained the different products that he has designed throughout his career. Mr. Morand admitted that he has never designed a glass, but explained that the same methodology and process are applicable to the field. Mr. Morand stated that the shape of the industrial designs has existed for a long time. Moreover, Mr. Morand compared the industrial designs and the pre-2003 glasses and determined that the differences between the prior art glasses and the industrial designs are very minimal. Mr. Morand testified that, in his opinion, there was no "spark of inspiration" in the shape of the Bodum double wall glass. By comparing the industrial designs in question and the Trudeau double wall glasses and by analyzing the exterior lines and the interior lines more specifically, he concluded that the interior and exterior lines of the industrial designs in question and the Trudeau glasses were different.

[35] In cross-examination, Mr. Morand admitted that he is not a glassware designer. Mr. Morand also admitted that some glasses included in his report (MM-9, MM-12, MM-10,

MM-13, MM-18) were undoubtedly not double wall glasses. Also, Mr. Morand indicated that he had no physical example of several of the prior art glasses included in his report. Finally, Mr. Morand confirmed that the blue Bodum glass (TX-194) was a double wall glass and that there were no relevant differences in this case between that glass and the Trudeau glasses.

VI. Relevant statutory provisions

[36] The relevant legislation is reproduced in Annex A. At this point, the Court reiterates some relevant provisions for the purposes of this case.

[37] First, the Act defines a “design” in section 2 as being “features of shape, configuration, pattern or ornament and any combination of those features that, in a finished article, appeal to and are judged solely by the eye”.

[38] It is also important to note that industrial designs protect the visual features of an article, not its functionality. This principle is codified in section 5.1 of the Act:

No protection afforded by this Act shall extend to
(a) features applied to a useful article that are dictated solely by a utilitarian function of the article; or
(b) any method or principle of manufacture or construction.

[39] Finally, the registration of industrial designs is done in accordance with subsection 6(1) of the Act:




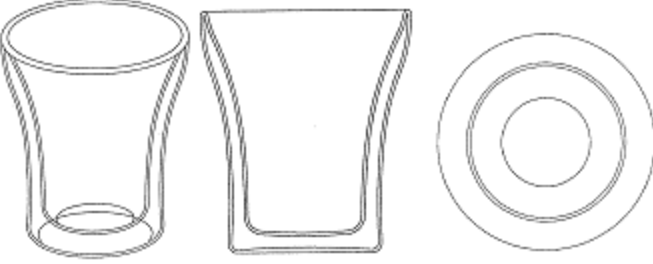

The Minister shall register the design if the Minister finds that it is not identical with or does not so closely resemble any other design already registered as to be confounded therewith, and shall return to the proprietor thereof the drawing or photograph and description with the certificate required by this Part.


VII. Analysis

1. Infringement

Preliminary remarks

[40] Before beginning to analyze the infringement issue, it is useful to reproduce the industrial designs of the Bodum glasses and the Trudeau glasses side by side:

INDUSTRIAL DESIGNS AT ISSUE	TRUDEAU DOUBLE WALL GLASSES
 <p>Fig. 1 Fig.2 Fig.6</p> <p>Industrial design No 107,736 (Exhibit TX-1)</p>	 <p>(Exhibit TX-186)</p> <p>and</p>  <p>(Exhibit TX-47)</p>
 <p>Fig. 1 Fig.2 Fig.6</p>	 <p>(Exhibit TX-186)</p> <p>and</p>

<p>Industrial design No 114,070 (Exhibit TX-214)</p>	 <p>(Exhibit TX-47)</p>
--	--

[41] The industrial designs represent the double wall glasses. It is also apparent from the hearings that Bodum's double wall glasses have a utilitarian function and that utilitarian function was admitted by the plaintiffs (Plan of argumentation of Plaintiffs/Defendants by Counterclaim, page 6).

[42] The Court also points out that Bodum's description of the *Pavina* series, which includes Bodum double wall glass TX-198, mentions that the utilitarian function of those glasses is to keep hot drinks hot and cold drinks cold. The following description indicates that those glasses are multifunctional:

Double wall glass PAVINA
 0.08 l/2.5 oz - 4557-10
 0.25 l/8 oz - 4558-10
 0.35 l/12 oz - 4559-10
 0.45 l/15 oz - 4560-10
 BODUM® Product Information



PRODUCT DESCRIPTION – THE STORY

The insulating quality of the double wall glasses doesn't just keep hot drinks hot for a longer period of time, it also keeps cold drinks cold longer. Another nice thing about them – there is no condensation water when you serve cold drinks, therefore no messy rings on your table. And by the way, they're great for ice cream as well. Double wall glasses are truly multifunctional. They are made from borosilicate glass and are dishwasher safe.

The insulating quality of the double wall glasses doesn't just keep hot drinks hot for a longer period of time, it also keeps cold drinks cold longer. Another nice thing about them – there is no condensation water when you serve cold drinks, therefore no messy rings on your table. And by the way, they're great for ice cream as well. Double wall glasses are truly multifunctional. They are made from borosilicate glass and are dishwasher safe.

[43] The utilitarian function of Bodum's double wall glasses was confirmed by Mr. Perez, the President of Bodum USA, Inc., during his examination, as making it possible to keep hot liquid hot or cold liquid cold (T89 – May 22).

[44] As such, more specifically, what is the functional element of Bodum's double wall glasses? In the case at bar, it is the space between the interior and exterior walls of the double wall glasses.

[45] As previously specified, and the parties agree on this point, industrial designs protect visual features but not utilitarian function, that is, in this case, the space between the double walls (John S. McKeown, *Fox, Canadian Law of Copyright and Industrial Designs*, 4th ed, (Toronto: The Carswell Thomson Professional Building, 2009) at page 811, c 31-9).

[46] The protection offered by industrial designs should also not be confused with the protection obtained for a product or a process through a patent. As admitted by the plaintiffs, industrial designs do not confer on them monopoly over double wall glasses in Canada (Plan of argumentation of Plaintiffs/Defendants by Counterclaim, page 6). Thus, as explained in *Sommer Allibert (UK) Limited and Another v Flair Plastics Limited*, [1987] 25 RPC 599 at page 625 (UK ChD, appeal) [*Sommer Allibert*], the similarities arising from the utilitarian function are not taken into account by the Court in its infringement analysis:


The court has to decide only whether the alleged infringement has the same shape or pattern, and must eliminate the question of the identity of function, as another design may have parts fulfilling the same functions without being an infringement. Similarly, in judging the question of infringement the court will ignore similarities or even identities between the registered design and the alleged infringement which arise from functional matters included within the design.

(Joint book of authorities, Tab 39)
(citing *Halsbury's Laws of England*, 4th ed, vol 48, para 407)

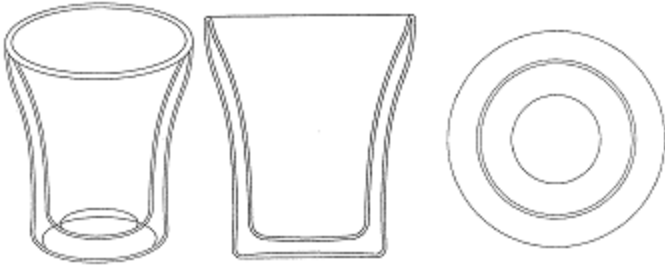
[Emphasis added.]

[47] In this case, it is the configuration of the double wall glasses that is of particular relevance. The Court notes that there are two industrial designs at issue in this case: design 107,736 (Exhibit TX-1) and design 114,070 (Exhibit TX-214).

[48] Industrial design 107,736 (Exhibit TX-1) is configured as follows:

<p>CONFIGURATION</p>	 <p>Fig. 1 Fig.2 Fig.6</p> <p>Industrial design No 107,736 (Exhibit TX-1)</p>
<p>(i) Height : width proportion [ratio]</p>	<p>9 : 10 [90%]</p>
<p>(ii) Curvature of the exterior wall (bottom ⇒ top)</p>	<p>Convex (very rounded)</p>
<p>(iii) Curvature of the interior wall (bottom ⇒ top)</p>	<p>Convex (very rounded)</p>
<p>(iv) Opening : base proportion [ratio]</p>	<p>2 : 1 [200%]</p>

[49] Industrial design 114,070 (Exhibit TX-214) is configured as follows:

<p style="text-align: center;">CONFIGURATION</p>	<div style="text-align: center;">  <p style="display: flex; justify-content: space-around; margin-top: 10px;"> Fig. 1 Fig.2 Fig.6 </p> <p style="margin-top: 20px;">Industrial design No 114,070 (Exhibit TX-214)</p> </div>
<p>(i) Height : width proportion [ratio]</p>	<p style="text-align: center;">6 : 5 [120%]</p>
<p>(ii) Curvature of the exterior wall (bottom ⇒ top)</p>	<p style="text-align: center;">Concave ⇒ slightly convex</p>
<p>(iii) Curvature of the interior wall (bottom ⇒ top)</p>	<p style="text-align: center;">Concave ⇒ convex</p>
<p>(iv) Opening : base proportion [ratio]</p>	<p style="text-align: center;">4 : 3 [135%]</p>

[50] It is also important to point out that industrial designs claim the design in its entirety as opposed to in part. Industrial designs 107,736 (Exhibit TX-1) and 114,070 (Exhibit TX-214) mention the following: “[t]he design consists of the visual features of the entirety of the drinking glass in the drawings”. In this case, where emphasis is on the entirety of the design, in order to establish infringement, the article in question will have to be quasi identical:

To establish infringement where the shape or configuration of the whole of an article of this kind is the essence of the design, I think there must be shown to be something reasonably approaching identity...

(*Sommer Allibert*, above, at page 626)
(citing *Jones & Attwood Ltd v National Radiator Company Ltd* (1928) 45
RPC 71 at 84)

[51] It follows that Trudeau double wall glasses must be characterized as substantially the same for there to be infringement and, in its analysis, the Court will ignore the utilitarian function of the double wall glasses, that is, the space between the walls.

[52] The analysis of the infringement issue starts with prior art.

Prior art

[53] With respect to prior art, the plaintiffs claim that the prior art differs from the industrial designs whereas the defendant is of the opposite opinion that the prior art is very similar, if not identical.

Relevant date

[54] The relevant date to determine the prior art is not an issue in this case, it is therefore sufficient to note that the relevant priority date for industrial designs 107,736 and 114,070 is February 18, 2004.

Comparison parameters

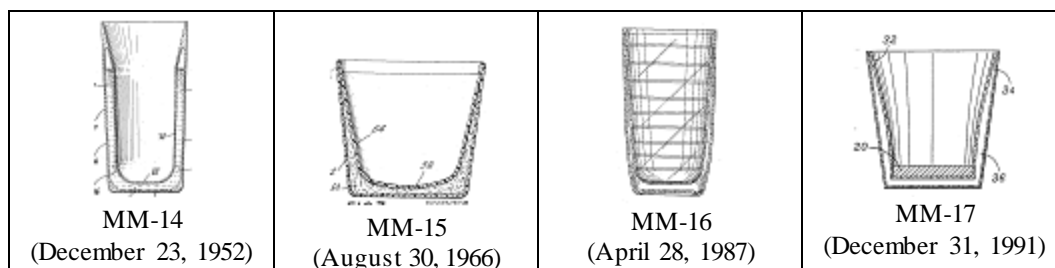
[55] In *Bata Industries Ltd v Warrington Inc.*, [1985] FCJ No 239, 5 CPR (3rd) 339, at page 345 (FCTD) (*Bata*), Justice Reed explained that industrial designs and prior art must be compared by ignoring the construction, colour and material processes:

The relevant evidence then, must be considered for the purpose of comparing the pre-existing designs with the registered design; differences in construction, material (leather-canvas, rubber-plastic), and colour (colour is not a part of the registered design in this case) must be ignored. It is the ornamentation, pattern, design, shape and configuration as set out in the drawings and description of the registered design which must be compared with that of pre-existing shoe designs.

[56] In the context of this case, the Court is mindful of those parameters and now turns to the issue of prior art in this case.

Double wall glasses

[57] The trial gave rise to discussions on the existence of double wall glasses prior to the priority date. Mr. Morand, the expert witness, explained that double wall glasses have existed for a certain number of years, even before 2003, and that a great many patents and industrial designs have provided specifications for double wall glasses. He provided the following examples, in particular:



(Michel Morand's Expert Report, paragraph 23)





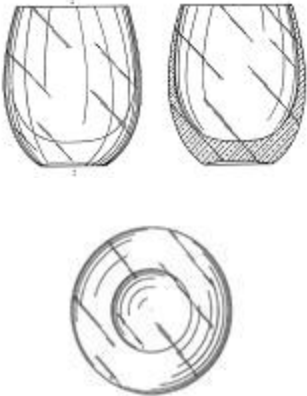

[58] For example, Mr. Morand referred to the U.S. Patent 3,269,144 from 1966 entitled "Double Wall Tumbler Having Cooling Means Therein" (T39-40 – May 24 and Exhibit MM-15) and the U.S. Patent 289,484 from 1987 entitled "Double Wall Insulated Tumbler" (T40 – May

24 and Exhibit MM-16). Mr. Morand is therefore of the opinion that [TRANSLATION] “double wall [glasses] have existed for a long time” (T40 – May 24).

[59] Furthermore, the evidence shows that Bodum marketed a blue plastic double wall glass in 1991 (Exhibit D-1, tabs 6-9; Exhibit TX-194). In light of the evidence, the Court finds that double wall glasses existed when Bodum introduced its double wall glasses on the Canadian market in 2003/2004.

Relevant prior art and the lines of industrial design 107,736 and Trudeau glasses TX-186 and TX-47

[60] Mr. Morand, the expert witness, indicated that internet research and an American patents database called USPTO (T7 – May 24), made it possible to show that there is relevant prior art for industrial design 107,736 (Exhibit TX-1). Mr. Morand explained to the Court that the differences between what can be found in the prior art and industrial design 107,736 are minimal (T33 – May 24). The table illustrates the prior art relevant to industrial design 107,736:

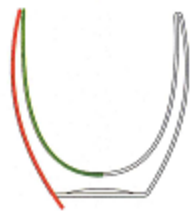
BODUM INDUSTRIAL DESIGN	PRIOR ART	
	 <p>(Exhibit TX-97) (1897)</p>	 <p>(Exhibit TX-106) (2000)</p>
 <p>Industrial design No 107,736 (Exhibit TX-1) (2003)</p>	 <p>(Exhibit TX-105) (2001)</p>	 <p>Double-walled salt dish (Exhibit TX-168) <i>(circa 1750-1800)</i></p>

[61] More specifically, Mr. Morand addressed the resemblances between the shape of the prior art designs and that of industrial design 107,736. In cross-examination, Mr. Morand was not able to confirm whether the prior art designs had a double wall. However, that element is not determinative in this case because, even though the two (2) industrial designs in question show an exterior line and an interior line with a space in between the two, nothing indicates that that

space contains air, liquid or glass. The description of the industrial designs in question is also silent on this point. The same can be said for certain prior art, including the design from 1897 (Exhibit TX-97).

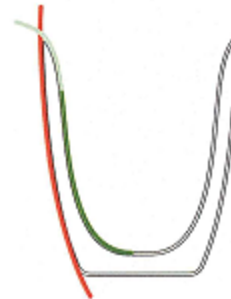
The lines of industrial design 107,736 and Trudeau glass TX-186

[62] As illustrated below, the interior line and the exterior line of industrial design 107,736 are completely convex, from the bottom to the top of the glass (Michel Morand, T19-20 – May 24). However, the interior line of Trudeau glass TX-186 is first convex, and then becomes concave. The exterior wall of the Trudeau glass is completely convex, like that of industrial design 107,736 (Michel Morand’s Expert Report, paragraph 25).



Industrial design No 107,736

(Exhibit TX-1)



Trudeau glass

(Exhibit TX-186)

[63] Mr. Morand, the expert witness, opined that the proportions of industrial design 107,736 and Trudeau glass TX-186 are not the same:

[TRANSLATION]

And even if I tried to reduce the Trudeau glasses, I would never arrive at the shape at the top because I would not have the same proportions; I

would not have the same, the same look. But it must still be noted that the curves at the top of the industrial design, a prominent curve compared to the others which have – in the Trudeau glasses, I clearly have two curves in the interior with a point of tangency; that is very important to say.

(T24 – May 24)

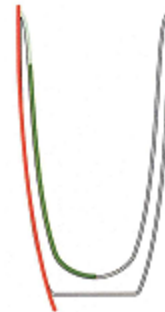
The lines of industrial design 107,736 and Trudeau glass TX-47

[64] Regarding industrial design 107,736 and Trudeau glass TX-47, Mr. Morand noted that the interior walls of industrial design 107,736 are completely convex, whereas the interior wall of Trudeau glass TX-47 is first convex, and then becomes concave at the top of the glass. The exterior wall of Trudeau glass TX-47 is completely convex, but a lot less rounded than the exterior wall of industrial design 107,736, as illustrated below (Michel Morand's Expert Report, paragraph 25).



Industrial design No 107,736

(Exhibit TX-1)




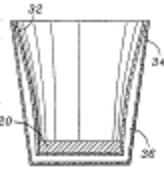





Trudeau glass

(Exhibit TX-47)

Relevant prior art and the lines of industrial design 114,070 and Trudeau glasses TX-186 and TX-4

[65] The prior art submitted into evidence in respect of industrial design 114,070 (TX-214) are the following:

 <p>Industrial design No 114,070 (Exhibit TX-214) (2003)</p>	 <p>FIG. 286. (One third.) (Exhibit TX-97) (1897)</p>	 <p>(Exhibit TX-13) (1915)</p>	 <p>(Exhibit TX-21) (December 31, 1991)</p>
	 <p>Coca-Cola glass (Exhibit TX-108) (circa 1919)</p>	 <p>History of the glass (19th century) (Exhibit TX-166) (1834)</p>	 <p>Assam No 4553-16 (Exhibit TX-219) (before 2003)</p>

[66] Mr. Morand also stated that the differences between what can be found in prior art and industrial design 114,070 (Exhibit TX-214) are minimal (Michel Morand, T33 – May 24). He also opined that industrial design 114,070 differs from Trudeau glasses TX-186 and TX-47 (T24–25 – May 24).

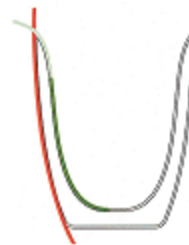
The lines of industrial design 114,070 and Trudeau glass TX-186

[67] Regarding industrial design 114,070 and Trudeau glass TX-186, Mr. Morand explained that the lines also differ (Michel Morand's Expert Report, paragraph 26).

[68] In that respect, Mr. Morand explained that the exterior line of industrial design 114,070 starts out concave and then becomes slightly convex towards the top whereas it is clear that the exterior line of Trudeau glass (TX-186) is convex. Regarding the interior lines of the Trudeau glass, they are first convex and then become concave, which is contrary to industrial design 114,070, as illustrated below:



Industrial design No 114,070
(Exhibit TX-214)

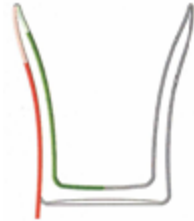


Trudeau glass
(Exhibit TX-186)

The lines of industrial design 114,070 and Trudeau glass TX-47

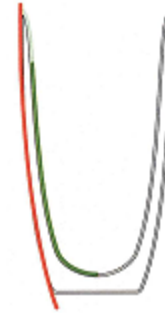
[69] Finally, with respect to industrial design 114,070 and Trudeau glass TX-47, Mr. Morand explained that the exterior wall and the interior wall of industrial design 114,070 are concave at the bottom of the glass and become slightly convex at the top of the glass. However, the interior wall of Trudeau glass TX-47 has a completely opposite curvature, that is, convex at the bottom becoming concave at the top. Also, the exterior wall of Trudeau glass TX-47 is completely

convex, which is not the case for industrial design 114,070 (Michel Morand's Expert Report, paragraph 26), as illustrated below:



Industrial design No 114,070

(Exhibit TX-214)



Trudeau glass

(Exhibit TX-47)

The legal test for comparison

[70] Having shown the prior art, the Court now turns to the legal test applicable to the comparative analysis. Section 11 of the Act defines infringement of an industrial design as follows:

11. (1) During the existence of an exclusive right, no person shall, without the licence of the proprietor of the design,

(a) make, import for the purpose of trade or business, or sell, rent, or offer or expose for sale or rent, any article in respect of which the design is registered and to which the design or a design not differing substantially therefrom has been applied; or

...

11. (1) Pendant l'existence du droit exclusif, il est interdit, sans l'autorisation du propriétaire du dessin,

(a) de fabriquer, d'importer à des fins commerciales, ou de vendre, de louer ou d'offrir ou d'exposer en vue de la vente ou la location un objet pour lequel un dessin a été enregistré et auquel est appliqué le dessin ou un dessin ne différant pas de façon importante de celui-ci;

[...]

(2) For the purposes of subsection (1), in considering whether differences are substantial, the extent to which the registered design differs from any previously published design may be taken into account.

(2) Pour l'application du paragraphe (1), il peut être tenu compte, pour déterminer si les différences sont importantes, de la mesure dans laquelle le dessin enregistré est différent de dessins publiés auparavant.

[Emphasis added.]

[71] In this case, infringement will therefore occur if the Trudeau glasses do not differ substantially from the industrial designs in question, as specified in the following excerpt from the doctrine in the field:

As previously set out, designs are registered in association with specifically identified articles. Infringement will occur when the design or a design not differing substantially therefrom has been applied to the article(s) for which the design was registered. ...

(John S. McKeown, *Fox, Canadian Law of Copyright and Industrial Designs*, 3rd ed, (Toronto: Carswell Thomson Professional Publishing 2000) at pages 837-838).

[72] The parties do not agree on the legal test the Court should apply for comparing the industrial designs in question and the Trudeau glasses and thus deciding whether infringement occurred.

[73] The plaintiffs claim that the Court must decide the issue by carrying out an analysis the way the consumer would see it and by applying the three-pronged test developed in England and stated in *Valor Heating Co. v Main Gas Appliances Ltd.*, [1972] FSR 497, that refers to the doctrine of “imperfect recollection”. The plaintiffs also rely on the judgment of the Superior Court of Quebec in *Les Industries Lumio (Canada) Inc. v Denis Dusablon et al*, 2007 QCCS

1204, (CST 700-17-001314-037, March 20, 2007, [*Lumio*]). The three-pronged test raised by the plaintiffs and reiterated in *Lumio* at paragraph 182 is as follows:

[TRANSLATION]

- a) The designs that are the subject of the comparison must not be examined side by side, but separately, so that imperfect recollection can guide the visual perception of the finished article;
- b) One must look at the entirety, and not the individual components of the design;
- c) Any change with respect to prior art must be substantial.

[74] The defendant told the Court that the test should be carried out from the point of view of how the aware consumer would see things. The defendant also contended that the three-pronged test, which was developed in England and was applied before the amendment of the Act in 1993, is no longer applicable.

[75] As noted by the defendant, a comparison of section 11 of the Act before the amendment of 1993 and after the amendment of 1993 indeed shows that the pre-1993 version contained an element of “fraudulent imitation”, whereas that element was removed by the 1993 amendment and replaced by the concept of “design not differing substantially”:

Before the 1993 Amendment

Using design without leave

Se servir d'un dessin sans autorisation

11. During the existence of an exclusive right, whether of the entire or partial use of a design, no person shall,

11. Pendant l'existence du droit exclusif, qu'il s'agisse de l'usage entier ou partiel du dessin, personne, sans la

without the licence in writing of the registered proprietor, or, if assigned, of the assignee of the proprietor, apply, for the purposes of sale, the design or a fraudulent imitation thereof to the ornamenting of any article of manufacture or other article to which an industrial design may be applied or attached, or publish, sell or expose for sale or use, any such article to which the design or fraudulent imitation thereof has been applied. R.S., c. I-8, s. 11.

permission par écrit du propriétaire enregistré, ou, en cas de cession, de son cessionnaire, ne peut appliquer, pour des fins de vente, ce dessin, ou une imitation frauduleuse de ce dessin, à l'ornementation d'un article fabriqué ou autre sur lequel peut être appliqué, ou auquel peut être attaché, un dessin industriel; et personne ne peut publier, ni vendre ni exposer en vente, ni employer l'article ci-dessus mentionné, sur lequel ce dessin ou cette imitation frauduleuse a été appliqué. S.R., ch. I-8, art.11.

Industrial Design Act, RSC 1985, c I-9, s 11 (before the amendment of SC 1993, c 44, s 164)

(Defendant's book of additional authorities)

After the 1993 Amendment

Using design without licence

Usage sans autorisation

11. (1) During the existence of an exclusive right, no person shall, without the licence of the proprietor of the design,

11. (1) Pendant l'existence du droit exclusif, il est interdit, sans l'autorisation du propriétaire du dessin :

(a) make, import for the purpose of trade or business, or sell, rent, or offer or expose for sale or rent, any article in respect of which the design is registered and to which the design or a design not differing substantially therefrom has been applied; or

a) de fabriquer, d'importer à des fins commerciales, ou de vendre, de louer ou d'offrir ou d'exposer en vue de la vente ou la location un objet pour lequel un dessin a été enregistré et auquel est appliqué le dessin ou un dessin ne différant pas de façon importante de celui-ci;

(b) do, in relation to a kit, anything specified in paragraph (a) that would

b) d'effectuer l'une quelconque des opérations visées à l'alinéa a) dans la

constitute an infringement if done in relation to an article assembled from the kit.

mesure où elle constituerait une violation si elle portait sur l'objet résultant de l'assemblage d'un prêt-à-monter.

(2) For the purposes of subsection (1), in considering whether differences are substantial, the extent to which the registered design differs from any previously published design may be taken into account.

(2) Pour l'application du paragraphe (1), il peut être tenu compte, pour déterminer si les différences sont importantes, de la mesure dans laquelle le dessin enregistré est différent de dessins publiés auparavant.

Industrial Design Act, RSC 1985, c I-9, s 11 (after the amendment of SC 1993, c 44, s 164)
(Joint book of authorities, Tab 42)

[76] Furthermore, even though the doctrine also seems to support the proposal that the test to determine whether infringement occurred has been different since the amendment (John S. McKeown, *Fox, Canadian Law of Copyright and Industrial Designs*, 3rd ed, (Toronto: Carswell Thomson Professional Publishing 2000) at page 838), without ruling on the issue, the Court indeed notes that the application of the three-pronged test may raise a certain number of questions with respect to its relevance, in light of the amendment of section 11 of the Act in 1993.

[77] During the hearing, a discussion took place concerning the use of the expression “aware consumer” and “informed consumer”. The Court notes that the French versions of certain Federal Court decisions on industrial designs, namely *Bata*, above, and *Rothbury International Inc v Canada (Minister of Industry)*, 2004 FC 578 at paragraph 31, [2004] FCJ No 691

[*Rothbury*], use the French expression “*consommateur averti*” [“aware consumer”] to translate the English expression “informed consumer” [“*consommateur informé*”].

[78] The question is thus the following: is there a difference between the expressions “aware consumer” and “informed consumer” for the purposes of this case? Le Petit Robert defines the term “*Averti*” [“Aware”] as follows: [TRANSLATION] “having knowledge, conscious. = well-informed, not ignorant, concerned”. It defines the term “*Informé*” [“Informed”] as follows: [TRANSLATION] “With knowledge of the facts. = aware, knowledgeable, apprised of”. The Larousse French-English/English-French dictionary defines “*Averti*” [Aware] as “Informed, experienced” and “Informed” as “Au courant, renseigné” [“Aware, apprised of”].

[79] The definitions quoted above show that the words “*Averti*” [“Aware”] and “*Informé*” [“Informed”] indeed mean the same thing and the Court is of the opinion that they can be considered synonyms of the English expression “informed consumer”.

[80] In short, the issue of using the expression “aware consumer” or “informed consumer” is a false debate. The Court is of the opinion that the alleged infringing product must be analyzed by the Court from the point of view of how the informed consumer would see things, as specified by my colleague Justice Tremblay-Lamer in 2004 in *Rothbury*, above, at paragraph 31; see also *Algonquin Mercantile Corporation v Dart Industries Canada Ltd*, (1984), 1 CPR (3d) 75, at page 81); *Sommer Allibert*, above, at pages 624-25).

Application in this case

[81] Thus, after weighing the testimony of the expert witness, Mr. Morand, and the parties' arguments, the Court finds that the Trudeau glasses do not have the features attributed to them by the plaintiffs and that the Trudeau glasses are not infringing products.

[82] Firstly, prior art clearly demonstrates that the lines of industrial design 107,736 existed. More specifically, and the Court is in agreement with Mr. Morand, the design from 1897 has interior and exterior lines very similar to industrial design 107,736. The design from 1897 has an interior line and therefore a double wall. That double wall may contain an air chamber, glass or liquid. Exhibit TX-168 (Double-walled salt dish) is also very similar if we disregard the base, which could be characterized as a variant.

[83] Moreover, by comparing the proportions of industrial design 107,736 and Trudeau glasses TX-186 and TX-47, the proportions differ namely with respect to the exterior curves and openings. Similarly, by comparing industrial design 114,070 and Trudeau glasses TX-186 and TX-47, the fact is that the proportions differ once again as industrial design 114,070 is designed according to an exterior concave curve that becomes convex. However, the exterior line of the Trudeau glasses is completely convex. What is more, the evidence in the record demonstrates that the shape of industrial design 114,070 existed in a prior Bodum Assam model (Exhibit TX-219, Assam No 4553-16), the only real difference being that it had a handle (Exhibit D-1, "Defendant's Discovery Read-Ins of Jörgen Bodum", Tab 10, pages 30 and 32).

Blue Bodum double wall glass TX-194

[84] In addition, the blue Bodum double wall glass TX-194 made in 1991 was the focus of the discussions during the trial.

[85] The blue Bodum double wall glass TX-194 clearly shows that Bodum made double wall glasses before 2003/2004. The plaintiffs admit that colour is not protected by industrial design, but allege that there are differences between the blue Bodum double wall glass and the Trudeau glasses in question. The plaintiffs' arguments can be summarized as follows:

[TRANSLATION]

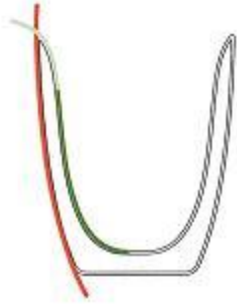
- The Trudeau glasses are translucent, but the blue Bodum double wall glass is less so;
- The blue Bodum double wall glass does not seem to be a double wall glass;
- The blue Bodum double wall glass contains two (2) pronounced rings at the top of the glass;
- The bottom of the glass does not have the same shape as the Trudeau glasses.

(Plan of Argumentation of Plaintiffs/Defendants by Counterclaim, page 8.)

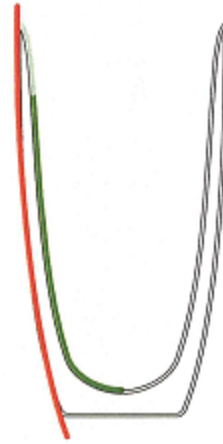
[86] The defendant denies these differences and their relevance, if applicable.

[87] In light of the evidence, the Court is of the opinion that the Trudeau glasses are a lot more similar to some pre-2003 glasses than to the industrial designs in question in this case. The blue Bodum double wall glass TX-194 is an example of this. More specifically, as explained by the expert witness, Mr. Morand, the Court is in agreement with him that the Trudeau glasses have the same configuration as the blue Bodum double wall glass TX-194. When compared, the Trudeau glasses and the blue Bodum double wall glass TX-194 have a convex exterior line and

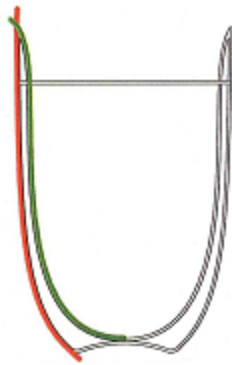
an interior line that becomes convex towards the top and those lines differ from the industrial designs, as illustrated below:



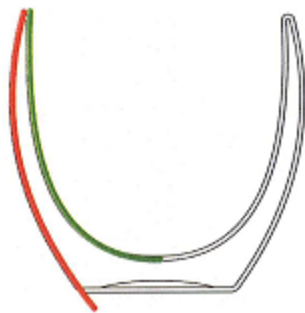
Trudeau glass
(Exhibit TX-186)



Trudeau glass
(Exhibit TX-47)



(Exhibit TX-194)



Industrial design No 107,736
(Exhibit TX-1)



Industrial design No 114,070
(Exhibit TX-214)

[88] The Court recalls that it is settled law that colour must be disregarded when assessing prior art. With respect to the rings and the bottom of the blue Bodum double wall glass TX-194, they are not [TRANSLATION] “obvious” and the Court is instead of the opinion that they have no impact on the visual aspect of the glass (Mr. Morand, cross-examination, T53-55 – May 24).

[89] As a result, the plaintiffs’ argument that it is the translucent double wall of the Trudeau glasses that makes them so similar to Bodum double wall glasses (Opening Statement of Plaintiffs/Defendants by Counterclaim, paragraph 5) must be rejected.

[90] It follows that, even if the Court disregarded the prior art, the Trudeau glasses have almost none of the features of the configuration of the industrial designs in question.

2. Invalidity

[91] The Court recalls that the defendant, by counterclaim, argues the invalidity of the industrial designs in question whereas the plaintiffs contend that the registration of those designs is valid.

[92] First, it must be noted that industrial designs registered with the Office of the Commissioner of Patents of the Canadian Intellectual Property Office are protected for ten (10) years (section 10 of the Act) and enjoy a *prima facie* presumption of validity. Subsection 7(3) of the Act states the following:

Certificate to be evidence of contents

Le certificat fait foi de son contenu

7. (3) The certificate, in the absence of proof to the contrary, is sufficient evidence of the design, of the originality of the design, of the name of the proprietor, of the person named as proprietor being proprietor, of the commencement and term of registration, and of compliance with this Act.

7. (3) En l'absence de preuve contraire, le certificat est une attestation suffisante du dessin, de son originalité, du nom du propriétaire, du fait que la personne dite propriétaire est propriétaire, de la date et de l'expiration de l'enregistrement, et de l'observation de la présente loi.

[93] That presumption is, however, not irrebuttable.

[94] As mentioned in paragraph 12, the first public disclosure of the Bodum glasses took place in August 2003 (Exhibit D-1, Defendant's Discovery Read-Ins of Jörgen Bodum, Tab 5, page 24, line 5).

[95] As indicated at paragraphs 57-59, the prior art shows that double wall glasses existed before 2003. In fact, the evidence demonstrates that the existence of double wall glasses goes back as far as the 19th century (Michel Morand's Expert Report, paragraph 22). The evidence also demonstrates that the pre-2003 glasses – including one prior art glass that goes back to 1897 – had configurations and proportions very similar to the industrial designs in question.

[96] The courts have held that to be registrable, an industrial design must be substantially different from prior art. A simple variation is not sufficient. The Supreme Court of Canada stated this principle in 1929 – a principle that is still in effect today – in *Clatworthy & Son Ltd v Dale*

Display Fixtures Ltd, [1929] SCR 429, at page 433. The Supreme Court of Canada remarked that opening the door to a simple variation would as a result paralyze the market:

... It must be remembered, however, that to constitute an original design there must be some substantial difference between the new design and what had theretofore existed. A slight change of outline or configuration, or an unsubstantial variation is not sufficient to enable the author to obtain registration. If it were, the benefits which the Act was intended to secure would be to a great extent lost and industry would be hampered, if not paralyzed. ...

[97] In 1985, in *Bata*, above, at page 347, Justice Reed pointed out that, to be registrable, the designs in question must show originality, that is, there needs to be a spark of inspiration. The Court adopts Justice Reed's comments:

The jurisprudence demands a higher degree of originality than is required with regard to copyright. It seems to involve at least a spark of inspiration on the part of the designer either in creating an entirely new design or in hitting upon a new use for an old one. ...

[98] By comparing the prior art submitted into evidence and the industrial designs in question, by focussing on lines and by ignoring the manufacturing processes, materials used and colours (*Bata*, above, page 345), the Court finds that the designs do not vary substantially. Even though Mr. Perez, the President of Bodum USA Inc., testified that the inspiration for industrial design 107,736 (TX-1 and Exhibit glass TX-198) came from a sake bowl that Jörgen Bodum apparently saw in Japan – Jörgen Bodum did not testify at the trial – the evidence nevertheless demonstrates that the field of glassware, like the fields of shirt collars and shoes, is a field that has existed for a long time. They are articles used daily and, therefore, the difference must be marked and substantial (*Le May v Welch*, (1884), 28 Ch D 24, (CA) at pages 34-35, cited in *Bata*, above, at page 348). On that point, the expert witness, Mr. Morand, testified that [TRANSLATION] “glasses have indeed existed for thousands of years and all shapes have already, for the most part, been

explored in the same way as shown by other prior art” (Examination, Michel Morand, T29 – May 24).

[99] For these reasons, the Court is of the opinion that the industrial designs in question do not meet the criteria defined by the jurisprudence entitling them to registration. As a result, the industrial designs in question do not satisfy the requirement of substantial originality and, consequently, they are not entitled to the protection set out in the Act and must be expunged from the register.

3. Unfair competition

[100] Regarding the allegations raised by the plaintiffs concerning unfair competition, they were made at the time of the written submissions and were still part of the plaintiffs’ allegations during the opening statements. Those allegations were, however, withdrawn at the pleading stage (Plan of Argumentation of Plaintiffs/Defendants by Counterclaim, page 11; T142-143 – May 29). The Court will therefore not rule on the issue.

X. Conclusion

[101] In conclusion, the Court dismisses the plaintiffs' infringement action and allows Trudeau's counterclaim of invalidity. Consequently, the industrial designs in question must be expunged from the register.

[102] Regarding costs, the parties will be given a deadline to try to resolve the issue themselves. Prothonotary Morneau informed the Court that he will remain available in that respect.

[103] If the parties are unable to agree on costs, they can serve and file written submissions on costs by October 24, 2012. Those submissions should not exceed ten (10) pages. Responses not exceeding five (5) pages could be served and filed by October 31, 2012.

[104] Finally, the Court reiterates its thanks to the parties' counsel involved in this litigation for their professionalism, respect and courtesy vis-à-vis each other and vis-à-vis the Court.

POSTSCRIPT

[1] These Public Reasons for Judgment are un-redacted from Confidential Reasons for Judgment which were issued on September 26, 2012, pursuant to the Direction dated September 26, 2012.

[2] The Court canvassed counsel for the parties whether they had concerns if the Confidential Reasons for Judgment were issued to the public without redactions. On October 3,

2012, counsel for the plaintiffs and counsel for the defendant jointly advised that there were no portions of the Confidential Reasons for Judgment that should be redacted but requested certain amendments. The Court accepts the amendments requested by counsel for the plaintiffs and counsel for the defendant. The amendments have been incorporated in these Public Reasons for Judgment.

“Richard Boivin”

Judge

ANNEX*Industrial Design Act, RSC 1985, c I-9*

INTERPRETATION

DÉFINITIONS

Definitions

Définitions

2. In this Act,

2. Les définitions qui suivent s'appliquent à la présente loi.

“design” or “industrial design” means features of shape, configuration, pattern or ornament and any combination of those features that, in a finished article, appeal to and are judged solely by the eye;

« dessin » Caractéristiques ou combinaison de caractéristiques visuelles d'un objet fini, en ce qui touche la configuration, le motif ou les éléments décoratifs.

...

[...]

“utilitarian function”, in respect of an article, means a function other than merely serving as a substrate or carrier for artistic or literary matter;

« fonction utilitaire » Fonction d'un objet autre que celle de support d'un produit artistique ou littéraire.

...

[...]

“variants” means designs applied to the same article or set and not differing substantially from one another.

« variantes » Dessins s'appliquant au même objet ou ensemble et ne différant pas de façon importante les uns des autres.

PART I

PARTIE I

INDUSTRIAL DESIGNS

DESSINS INDUSTRIELS

Registration

Enregistrement

...

[...]

Restriction on protection

Limites et protection

5.1 No protection afforded by this Act shall extend to

5.1 Les caractéristiques résultant uniquement de la fonction utilitaire d'un objet utilitaire ni les méthodes ou principes de réalisation d'un objet ne peuvent bénéficier de la protection prévue

(a) features applied to a useful article that are dictated solely by a utilitarian

function of the article; or

par la présente loi.

(b) any method or principle of manufacture or construction.

Registration of design

Enregistrement du dessin

6. (1) The Minister shall register the design if the Minister finds that it is not identical with or does not so closely resemble any other design already registered as to be confounded therewith, and shall return to the proprietor thereof the drawing or photograph and description with the certificate required by this Part.

6. (1) Si le ministre trouve que le dessin n'est pas identique à un autre dessin déjà enregistré ou qu'il n'y ressemble pas au point qu'il puisse y avoir confusion, il l'enregistre et remet au propriétaire une esquisse ou une photographie ainsi qu'une description en même temps que le certificat prescrit par la présente partie.

...

[...]

Certificate of registration

Certificat d'enregistrement

7. (1) A certificate shall be signed by the Minister, the Commissioner of Patents or an officer, clerk or employee of the Commissioner's office and shall state that the design has been registered in accordance with this Act.

7. (1) Le certificat, qui atteste que le dessin a été enregistré conformément à la présente loi, peut être signé par le ministre, le commissaire aux brevets ou tout membre du personnel du bureau de ce dernier.

...

[...]

Certificate to be evidence of contents

Le certificat fait foi de son contenu

(3) The certificate, in the absence of proof to the contrary, is sufficient evidence of the design, of the originality of the design, of the name of the proprietor, of the person named as proprietor being proprietor, of the commencement and term of registration, and of compliance with this Act.

(3) En l'absence de preuve contraire, le certificat est une attestation suffisante du dessin, de son originalité, du nom du propriétaire, du fait que la personne dite propriétaire est propriétaire, de la date et de l'expiration de l'enregistrement, et de l'observation de la présente loi.

Exclusive right

Droit exclusif

Exclusive right

Droit exclusif

9. An exclusive right for an industrial

9. Le droit exclusif à la propriété d'un

design may be acquired by registration of the design under this Part.

dessin industriel peut être acquis par l'enregistrement de ce dessin conformément à la présente partie.

Duration of right

Durée du droit

10. (1) Subject to subsection (3), the term limited for the duration of an exclusive right for an industrial design is ten years beginning on the date of registration of the design.

10. (1) Sous réserve du paragraphe (3), la durée du droit exclusif à la propriété d'un dessin industriel est limitée à dix ans à compter de la date de l'enregistrement du dessin.

...

[...]

Using design without licence

Usage sans autorisation

11. (1) During the existence of an exclusive right, no person shall, without the licence of the proprietor of the design,

11. (1) Pendant l'existence du droit exclusif, il est interdit, sans l'autorisation du propriétaire du dessin :

(a) make, import for the purpose of trade or business, or sell, rent, or offer or expose for sale or rent, any article in respect of which the design is registered and to which the design or a design not differing substantially therefrom has been applied; or

a) de fabriquer, d'importer à des fins commerciales, ou de vendre, de louer ou d'offrir ou d'exposer en vue de la vente ou la location un objet pour lequel un dessin a été enregistré et auquel est appliqué le dessin ou un dessin ne différant pas de façon importante de celui-ci;

(b) do, in relation to a kit, anything specified in paragraph (a) that would constitute an infringement if done in relation to an article assembled from the kit.

b) d'effectuer l'une quelconque des opérations visées à l'alinéa a) dans la mesure où elle constituerait une violation si elle portait sur l'objet résultant de l'assemblage d'un prêt-à-monter.

Substantial differences

Différences importantes

(2) For the purposes of subsection (1), in considering whether differences are substantial, the extent to which the registered design differs from any previously published design may be taken into account.

(2) Pour l'application du paragraphe (1), il peut être tenu compte, pour déterminer si les différences sont importantes, de la mesure dans laquelle le dessin enregistré est différent de dessins publiés auparavant.

ACTION FOR INFRINGEMENT

ACTION POUR VIOLATION D'UN
DROIT EXCLUSIF

...

[...]

Defence

Action irrecevable

17. (1) In any proceedings under section 15, a court shall not award a remedy, other than an injunction, if the defendant establishes that, at the time of the act that is the subject of the proceedings, the defendant was not aware, and had no reasonable grounds to suspect, that the design was registered.

17. (1) Dans le cadre des procédures visées à l'article 15, le tribunal ne peut procéder que par voie d'injonction si le défendeur démontre que, lors de la survenance des faits reprochés, il ignorait – ou ne pouvait raisonnablement savoir – que le dessin avait été enregistré.

Exception

Exception

(2) Subsection (1) does not apply if the plaintiff establishes that the capital letter "D" in a circle and the name, or the usual abbreviation of the name, of the proprietor of the design were marked on

(2) Le paragraphe (1) ne s'applique pas si le plaignant démontre que la lettre « D », entourée d'un cercle, et le nom du propriétaire du dessin, ou son abréviation usuelle, figuraient lors de la survenance des faits reprochés :

(a) all, or substantially all, of the articles to which the registration pertains and that were distributed in Canada by or with the consent of the proprietor before the act complained of; or

a) soit sur la totalité ou la quasi-totalité des objets qui étaient distribués au Canada par le propriétaire ou avec son consentement;

(b) the labels or packaging associated with those articles.

b) soit sur les étiquettes ou les emballages de ces objets.

Proprietor

Propriétaire

(3) For the purposes of subsection (2), the proprietor is the proprietor at the time the articles, labels or packaging were marked.

(3) Pour l'application du paragraphe (2), le propriétaire du dessin est celui qui en est le propriétaire lors du marquage des objets, des étiquettes ou des emballages.

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

UNFAIR COMPETITION AND
PROHIBITED MARKS

CONCURRENCE DÉLOYALE ET
MARQUES INTERDITES

Prohibitions

Interdictions

7. No person shall

7. Nul ne peut :

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

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

(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;

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;

...

[...]

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-735-07

STYLE OF CAUSE: **Bodum USA Inc et al
v Trudeau Corporation (1889) Inc.**

PLACE OF HEARING: Montréal, Quebec

DATE OF HEARING: May 22-23-24-29, 2012

**PUBLIC REASONS
FOR JUDGMENT:** BOIVIN J.

DATED: September 26, 2012

APPEARANCES:

Christopher Atchinson

FOR THE PLAINTIFFS

François Guay
Ekaterina Tsimberis

FOR THE DEFENDANT

SOLICITORS OF RECORD:

Atchinson Law Firm
Montréal, Quebec

FOR THE PLAINTIFFS

Smart & Biggar
Montréal, Quebec

FOR THE DEFENDANT