

Intellectual Property Weekly Abstracts Bulletin — Week of September 12

14 septembre 2016

Trademark Decisions

Appeal allowed in part where opposed services were an extension of Applicant's earlier registration

[Caesarstone Sdot-Yam Ltd v. Ceramiche Caesar S.P.A., 2016 FC 895](#)

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

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

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

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

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

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

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

Supreme Court Update

Sandoz Canada Inc., et al. v. Attorney General of Canada, et al., (SCC #36798) – appeal discontinued

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

Other Industry News

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

Health Canada has published an [External Consultation Report – What we heard Health Products and Food Branch Transparency Initiatives](#).

Par

[Chantal Saunders, Beverley Moore, Adrian J. Howard, Jillian Brenner](#)

Services

[Propriété intellectuelle, Marques de commerce, Droit d’auteur, Octroi de licences, Brevets](#)

BLG | Vos avocats au Canada

Borden Ladner Gervais S.E.N.C.R.L., S.R.L. (BLG) est le plus grand cabinet d'avocats canadien véritablement multiservices. À ce titre, il offre des conseils juridiques pratiques à des clients d'ici et d'ailleurs dans plus de domaines et de secteurs que tout autre cabinet canadien. Comptant plus de 725 avocats, agents de propriété intellectuelle et autres professionnels, BLG répond aux besoins juridiques d'entreprises et d'institutions au pays comme à l'étranger pour ce qui touche les fusions et acquisitions, les marchés financiers, les différends et le financement ou encore l'enregistrement de brevets et de marques de commerce.

blg.com

Bureaux BLG

Calgary

Centennial Place, East Tower
520 3rd Avenue S.W.
Calgary, AB, Canada
T2P 0R3

T 403.232.9500
F 403.266.1395

Ottawa

World Exchange Plaza
100 Queen Street
Ottawa, ON, Canada
K1P 1J9

T 613.237.5160
F 613.230.8842

Vancouver

1200 Waterfront Centre
200 Burrard Street
Vancouver, BC, Canada
V7X 1T2

T 604.687.5744
F 604.687.1415

Montréal

1000, rue De La Gauchetière Ouest
Suite 900
Montréal, QC, Canada
H3B 5H4

T 514.954.2555
F 514.879.9015

Toronto

Bay Adelaide Centre, East Tower
22 Adelaide Street West
Toronto, ON, Canada
M5H 4E3

T 416.367.6000
F 416.367.6749

Les présents renseignements sont de nature générale et ne sauraient constituer un avis juridique, ni un énoncé complet de la législation pertinente, ni un avis sur un quelconque sujet. Personne ne devrait agir ou s'abstenir d'agir sur la foi de ceux-ci sans procéder à un examen approfondi du droit après avoir sopesé les faits d'une situation précise. Nous vous recommandons de consulter votre conseiller juridique si vous avez des questions ou des préoccupations particulières. BLG ne garantit aucunement que la teneur de cette publication est exacte, à jour ou complète. Aucune partie de cette publication ne peut être reproduite sans l'autorisation écrite de Borden Ladner Gervais S.E.N.C.R.L., S.R.L. Si BLG vous a envoyé cette publication et que vous ne souhaitez plus la recevoir, vous pouvez demander à faire supprimer vos coordonnées de nos listes d'envoi en communiquant avec nous par courriel à desabonnement@blg.com ou en modifiant vos préférences d'abonnement dans blg.com/fr/about-us/subscribe. Si vous pensez avoir reçu le présent message par erreur, veuillez nous écrire à communications@blg.com. Pour consulter la politique de confidentialité de BLG relativement aux publications, rendez-vous sur blg.com/fr/ProtectionDesRenseignementsPersonnels.

© 2025 Borden Ladner Gervais S.E.N.C.R.L., S.R.L. Borden Ladner Gervais est une société à responsabilité limitée de l'Ontario.