

Intellectual Property Weekly Abstracts Bulletin — Week Of April 18

April 20, 2016

Trademark Decisions

MASTER TRANSMISSION held to likely be confused with MISTER TRANSMISSION mark

[Responsive Brands Inc. v. 2248003 Ontario Inc., 2016 FC 355](#)

Responsive Brands, the owner of the MISTER TRANSMISSION mark, has successfully maintained an action for infringement of its mark against the Defendant.

The Defendant used the trade and business names MASTER TRANSMISSION and MASTER TRANSMISSION & DRIVELINE. The Plaintiff alleged these names were confusingly similar to its mark and infringed it, as well as alleging passing off and depreciation of goodwill.

It was stated that the Defendant had previously worked for the Plaintiff and had sought approval to establish a new franchise location in the Huntsville, ON area, but they never put together a formal franchise application. The Defendant subsequently opened up an independent transmission repair shop.

After a review of the evidence, the Court held that there was insufficient evidence that any consumer had actually been confused or misled since the Defendant opened its business. The evidence of confusion was described as coming from individuals other than potential purchasers of transmission services: courier drivers, tow-truck operators and a third party parts supplier.

Nevertheless, despite the lack of evidence of actual confusion, the Court found there was a likelihood of confusion between the Plaintiff's trademarks and the Defendant's trade and business names.

The other claims were unsuccessful.

In the end, the Court ordered an interim and permanent injunction restraining the Defendant from further infringement, and ordered that the quantification issues be decided in a separate proceeding.

Patent Decisions

Quia timet claim not struck from patent infringement suit
[Gilead Sciences, Inc. v. Teva Canada Limited, 2016 FC 31](#)

We previously reported on the appeal of a refusal to strike out a statement of claim, which was dismissed, during the [week of April 4, 2016](#). In the previously published [Gilead Sciences, Inc. v. Teva Canada Limited, 2016 FC 336](#), the Court had dismissed Teva Canada Limited's appeal from the Prothonotary's Order declining to strike out Gilead's Statement of Claim in its entirety. The Prothonotary struck some of the pleadings, but allowed the action to continue on the basis of amended allegations of a likely future (quia timet) infringement.

The original underlying decision has now been published by the Court as 2016 FC 31.

By

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

Expertise

[Intellectual Property](#), [Patents](#), [Copyright](#), [Licensing](#), [Trademarks](#)

BLG | Canada's Law Firm

As the largest, truly full-service Canadian law firm, Borden Ladner Gervais LLP (BLG) delivers practical legal advice for domestic and international clients across more practices and industries than any Canadian firm. With over 725 lawyers, intellectual property agents and other professionals, BLG serves the legal needs of businesses and institutions across Canada and beyond – from M&A and capital markets, to disputes, financing, and trademark & patent registration.

blg.com

BLG Offices

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 De La Gauchetière Street West
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

The information contained herein is of a general nature and is not intended to constitute legal advice, a complete statement of the law, or an opinion on any subject. No one should act upon it or refrain from acting without a thorough examination of the law after the facts of a specific situation are considered. You are urged to consult your legal adviser in cases of specific questions or concerns. BLG does not warrant or guarantee the accuracy, currency or completeness of this publication. No part of this publication may be reproduced without prior written permission of Borden Ladner Gervais LLP. If this publication was sent to you by BLG and you do not wish to receive further publications from BLG, you may ask to remove your contact information from our mailing lists by emailing unsubscribe@blg.com or manage your subscription preferences at blg.com/MyPreferences. If you feel you have received this message in error please contact communications@blg.com. BLG's privacy policy for publications may be found at blg.com/en/privacy.

© 2024 Borden Ladner Gervais LLP. Borden Ladner Gervais LLP is an Ontario Limited Liability Partnership.