

Making your mark and protecting your brand online in Canada

Part 1 - Brand enforcement online

Not for distribution



Making your mark and protecting your brand online in Canada

Part one – Brand enforcement
online

Moderator:



Mark Davis
Partner, Lawyer,
Trademark Agent

Speakers:



Amy Grenon
Partner, Lawyer,
Trademark Agent



Adam Haller
Senior Associate,
Trademark Agent



Madeleine Hodgson
Associate,
Trademark Agent



Christopher Wilson
Partner, Lawyer

Agenda

- Welcome and introductions
- Cross-border use of trademarks
- Grey market goods and web sales
- Online platforms
- SEO, keywords and brandjacking
- Closing remarks
- Breakout sessions

Cross-border use of trademarks in the online reality

Adam Haller
Senior Associate, Trademark Agent, Toronto

The fundamental tension

Trademark laws
are inherently
national

*“The internet has
no borders – its
natural habitat is
global”* Supreme
Court of Canada
in 2017 SCC 34

The spectrum of online contact



Factors

- Extent and nature of transactions with customers / benefits obtained by customers
- Nature of goods or services
- Gating / location selection
- Language
- Server location / country level domains
- Currency
- Shipping options
- Local Contact Information
- Local testimonials / endorsements / partnerships

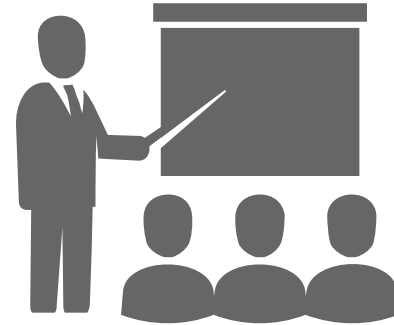
Examples

- *Miller Thomson LLP v. Hilton Worldwide Holding LLP*, 2020 FCA 143
- *Trader Joe's Co. v. Hallatt*, 835 F.3d 960 (9th Cir. 2016)



Tips

- Align your trademark strategy with your online presence
- Monitor and document where engagement is coming from



Grey market goods (parallel imports) and web sales

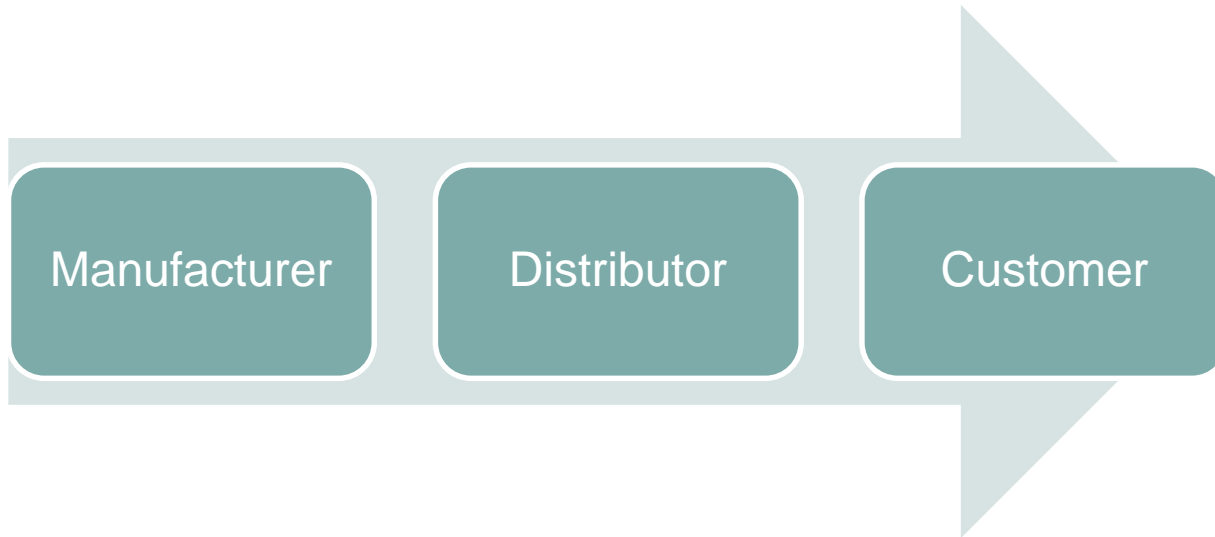
Amy Grenon
Partner, Lawyer, Trademark Agent, Toronto

Grey market goods | Outline

- What is a grey market good?
- What harm can they cause to my brand?
- How does Canadian law treat grey market sales?
- What proactive steps can be taken?
- How to approach enforcement?

What is a grey market good?

Genuine trademarked good that is sold outside of an authorized channel



What harm can be caused to my brand?

- ✘ Difference in quality of goods
- ✘ May not comply with local regulations
- ✘ May not have warranty coverage
- ✘ Sold in channels and at prices that erode brand value
- ✘ Impact relationship with licensed dealers

How does Canadian law treat grey market goods?

- Traditionally difficult to enforce using trademark and copyright law
- BUT success may be possible where:
 - Different labelling
 - Regulatory non-compliance
 - Different quality of goods
 - Different IP ownership
- Alternate causes of action e.g., contractual terms and related IP rights

What proactive steps can be taken?

- Build terms into manufacturing and distribution agreements
- Register key brands in jurisdictions where you make and where you sell
- Register social media handles for brands and variants
- Register with brand owners programs on e-commerce platforms
- Monitor, monitor, monitor!



How to approach enforcement

Purchase test product

Cease and desist letter

Complaint via e-commerce/ social media platform

Litigation against seller

Litigation against source

Working with online platforms

Madeleine Hodgson
Associate, Trademark Agent, Vancouver

Working with online platforms

Defamatory content

Public social media
sites

Counterfeiting

Independent
websites, social
media, retail
platforms

Working with online platforms

Protection

- Register rights
- Implement policies and agreements

Identification

- Monitor online platforms

Enforce

- Notice to platforms
- Litigation



Malpractices employed in SEO, keywords and brandjacking

Christopher Wilson
Partner, Vancouver

Keywords and ads – lawful

#bcaaonstrike

icbcadvice.com > getting-started

Getting Started - ICBC Advice

Getting Started. In this section you will find some helpful **tips** on making sure your Insurance Corporation of British Columbia (“**ICBC**”) claim gets started in the ...

Keywords and ads – unlawful

Vancouver Career College

Sponsored links

www.VCCollege.ca Full & Part-Time Diploma Programs Get your Diploma Fast. Free Info!
Programs - Admissions - Tuition and Financial Options - Campus Locations

Vancouver Community College

www.cdicollege.ca Start an In-Demand Career in the Rewarding Field of Healthcare Now.

Lush Soap at Amazon.co.uk

www.amazon.co.uk/lush+soap

amazon.co.uk is **rated** *****

Low prices on **Lush** Soap

Free UK Delivery on Amazon Orders.

Marketplaces

amazon.co.uk Your Amazon.co.uk Today's Deals Gift Cards Sell Help

COUNTDOWN TO **BLACK FRIDAY** DEALS WEEK > Shop all deals sponsored by NESCAFÉ Dolce Gusto

Shop by Department **Beauty** Search Beauty Lush Go Hello. Sign in Your Account Try Prime Basket Wish List

Beauty Brands Best Sellers Gift Ideas Make-up Skin Care Fragrance Manicure & Pedicure Hair Care Bath & Body Sun Care & Tanning

Departments < Any Category **Beauty**

- Bath Bombs (29)
- Bath & Body (109)
- Skin Care Gift Sets (27)
- Sets (52)
- Skin Care (79)
- Soaps & Hand Wash (7)
- Bubble Bath (22)
- Hand & Nail Creams (3)
- Hair Extensions (208)
- Polish (8)
- + See more...




Delivery Option (What's this?)
 FREE Super Saver Delivery

Brand
 Bomb Cosmetics
 Lush
 Burt's Bees
 Pukka Hair Extensions
 Pukka Hair
 China Glaze

Beauty > "Lush"

Related Searches: [lush bath bombs](#), [lush cosmetics](#), [lush products](#).

Showing 1 - 24 of 638 Results Detail Image Sort by Relevance

		
Bomb Cosmetics Chocolate Ballotin Assortment Bath Gift Set £9.99 £9.35 ✓Prime Order in the next 11 hours and get it by Friday, Nov 22. Eligible for FREE Super Saver Delivery. More buying choices £7.35 new (10 offers) ★★★★☆ (158)	Bomb Cosmetics Funkadelic Gift Pack £12.00 £11.06 ✓Prime Order in the next 11 hours and get it by Friday, Nov 22. Eligible for FREE Super Saver Delivery. More buying choices £8.60 new (10 offers) ★★★★☆ (40)	Bomb Cosmetics Mistletoe Kiss Gift Set £12.00 £11.76 ✓Prime Order in the next 11 hours and get it by Friday, Nov 22. Eligible for FREE Super Saver Delivery. More buying choices £8.99 new (7 offers) ★★★★☆ (47)

Product Listing Ads (PLAs)

Ads · See coleman stove



Coleman Guide
Series Dual F...

\$175.49

Amazon CA
Free delivery



Coleman Camp
Propane...

\$119.97

Amazon CA
Free delivery



Coleman
Perfectflow 2-...

\$79.97

Walmart.ca



Camp Chef
Everest High-...

\$160.14

Amazon CA
Free delivery



Coleman
2000020953...

\$99.99

Amazon CA
Free delivery

Closing remarks

Learn more

- **Breakout sessions now**

- Technical support available by emailing rsvp.canada@enortonrosefulbright.com

- **Join us again**

- October 22, 2020 | Part two | Mitigating branding risks on social media and e-commerce

- October 29, 2020 | Part three | Effective registration and branding strategies for 2020

Moderator



Mark Davis

Partner, Lawyer, Trademark Agent
Toronto

Tel: +1 416 216 4066

mark.davis@nortonrosefulbright.com

Our speakers



Amy Grenon

Partner, Lawyer, Trademark Agent
Toronto

Tel: +1 416 216 1931

amy.grenon@nortonrosefulbright.com



Madeleine Hodgson

Associate, Trademark Agent
Vancouver

Tel: +1 604 641 4945

madeleine.hodgson@nortonrosefulbright.com



Adam Haller

Senior Associate, Trademark Agent
Toronto

Tel: +1 416 216 1941

adam.haller@nortonrosefulbright.com



Christopher Wilson

Partner
Vancouver

Tel: +1 604 641 4841

chris.wilson@nortonrosefulbright.com



Law around the world

nortonrosefulbright.com

Norton Rose Fulbright Verein, a Swiss verein, helps coordinate the activities of Norton Rose Fulbright members but does not itself provide legal services to clients. Norton Rose Fulbright has offices in more than 50 cities worldwide, including London, Houston, New York, Toronto, Mexico City, Hong Kong, Sydney and Johannesburg. For more information, see nortonrosefulbright.com/legal-notices. The purpose of this communication is to provide information as to developments in the law. It does not contain a full analysis of the law nor does it constitute an opinion of any Norton Rose Fulbright entity on the points of law discussed. You must take specific legal advice on any particular matter which concerns you. If you require any advice or further information, please speak to your usual contact at Norton Rose Fulbright.