

World Trademark Review Daily

**Federal Court: well-known geographic locations are inherently weak
Canada - Smart & Biggar/Fetherstonhaugh**

Confusion

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In *London Drugs Limited v International Clothiers Inc* (2014 FC 223), the Federal Court of Canada has emphasised that well-known geographic locations are inherently weak and deserve a narrow scope of protection, even when used in association with goods and services that have no pre-existing connection to that geographic designation.

London Drugs Limited is a well-known Canadian drugstore and retailer of general merchandise that owns a series of various LONDON trademark registrations. In this case, London Drugs sought to appeal a decision of the Trademarks Opposition Board which allowed *International Clothiers Inc*'s two applications to register the mark SMITH & BARNES LONDON in connection with retail store services and a wide variety of goods, including clothing and housewares.

The standard of review for appeals of this nature is reasonableness, unless, after an examination of its significance and probative value, new evidence filed on appeal would have materially affected the board's decision, in which case the appropriate standard of review is correctness.

On appeal, London Drugs filed additional evidence, in an effort to elevate the standard of review to correctness and, in effect, reargue the case *de novo*.

Like in most other appeals to the Federal Court, the court found that none of London Drugs' new evidence made a substantial difference because it merely supplemented the evidence that was before the board. The standard of review was therefore whether the board's decision was reasonable. This decision is yet another example of the importance of filing one's best evidence at first instance as it is often very difficult to establish that the additional evidence is not just "more of the same".

The essence of London Drugs' appeal was that, even though London may be a well-known geographic location, the board's decision was unreasonable in finding that the appellant's LONDON marks were inherently weak. London Drugs contended that it is only where a geographic designation is used in relation to particular goods or services for which that area is renowned, and merely seeks to capitalise on the existing public association between the two, that the resultant trademark will have little inherent distinctiveness.

The court summarily rejected London Drugs' argument and held that it "stems from a fundamental misconception and misunderstanding" of the [Canadian Trademarks Act](#) and the very notion of distinctiveness. As emphasised by the court, distinctiveness of a mark has to do with its originality, uniqueness and inventiveness, not with the absence of deception. As a result, the court recognised that no one can claim a monopoly on a geographic name, especially when it is as well-known as London.

Recognising that the applicant's LONDON DRUGS trademark was inherently weak, the court stated that it could hardly be said that LONDON DRUGS and SMITH & BARNES LONDON were so similar that they were confusing.

The court therefore rejected London Drugs' appeal with costs.

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