

Judicial Comity in the Federal Court

A recent decision of the Federal Court provides some interesting comments concerning judicial comity in the Federal Court.

The Facts

Eclectic Edge Inc. (“Eclectic Edge”) filed four trademark applications for the marks shown below (the “Eclectic Marks”) in association with women’s clothing.

VALENTINE SECRET



All of the Eclectic Marks were opposed by Gildan Apparel (Canada) LP (“Gildan”) on the basis that the applied-for marks were, among other things, confusing with Gildan’s SECRET marks. Gildan owned 59 registered trademarks, each of which consisted of the word SECRET by itself and with other words for use in association with, among

other things, “ladies hosiery, mens and ladies socks and stockings, ladies pantyhose, undergarments, underwear, undergarments lingerie and scarves” (the “Gildan Marks”).

At or about the same time Victoria’s Secret Brand Management Inc. (“Victoria’s Secret”) also opposed the Eclectic Marks. This opposition proceeded to a hearing before the Trademark Opposition Board (the “Board”) which was heard before the Gildan opposition. The hearing officer refused the Eclectic Marks primarily on the basis that they were confusing with VICTORIA’S SECRET and VS SPORT DESIGN owned by Victoria’s Secret.

The Gildan opposition proceeded to a hearing before the Board. The hearing officer also refused the Eclectic Marks on the basis that they were confusing with the Gildan Marks.

Eclectic appealed from the decision in the Victoria’s Secret case to the Federal Court and was successful save that the application for its VS trademark was refused. As a result, the Board’s decision was set aside concerning the other three applications which were allowed. In arriving at this decision, the judge concluded that material new evidence had been filed and applied a correctness standard to the Board’s decision. This decision was made in April 2015. We previously commented on this decision, see: <http://www.gsnh.com/the-importance-of-filing-the-necessary-evidence-in-trademark-oppositions/>.

Eclectic also appealed from the decision in the Gildan opposition to the Federal Court and this matter proceeded before a different judge than the judge who had heard the Victoria’s Secret appeal. Gildan was obviously hoping that it would achieve a similar result to that in the Victoria’s Secret decision.

Judicial Comity

The judge in the Gildan case referred to this doctrine as follows:

“A judge should follow a decision on the same question of one of his or her colleagues, unless the previous decision differs in the facts, a different question is asked, the decision is clearly wrong or the application of the decision would create an injustice. Judicial comity requires humility and mutual respect.”

In substance, judicial comity is a modified form of *stare decisis*, i.e. horizontal rather than vertical. However, it is clear that the principle of judicial comity only applies to determinations of law and has less application to factual findings.

The application of this doctrine in the context of appeals from the Board is further complicated because the standard of appeal varies depending on the materiality of any new evidence that may be filed. Where additional evidence is presented on appeal that would materially affected the hearing officer’s findings of fact, the decision is reviewed on a correctness standard. In all other cases, a decision of a hearing officer is reviewed on the standard of reasonableness.

Because of differences in the standard of review the judge in the Gildan case concluded that he was not required to follow the result of the Victoria’s Secret case since different issues were involved. Although he said that he was mindful of the findings made in that case.

The Standard of Review

The parties in the Gildan case filed additional evidence. The judge said that new evidence would be considered sufficiently material to affect the standard of review when

it puts a different light on the record or significantly extends the evidence that was before the hearing officer.

When the judge reviewed the additional evidence he was satisfied that the evidence was not substantial as it did not materially affect the findings and the determination of confusion made by the hearing officer. It did not put the case in a different light nor significantly extend beyond the evidence that was previously filed. As a result, the standard of review was reasonableness.

The judge concluded that the hearing officer had properly applied the test to determine if there was a reasonable likelihood of confusion between the Eclectic Marks and the Gildan Marks. The judge agreed with the hearing officer that a casual consumer observing the Eclectic Marks and having no more than an imperfect recollection of the Gildan Marks would likely be confused into thinking that the goods offered by Eclectic in association with its marks originated from Gildan.

Comment

While it may be difficult to explain the result of the Gildan decision to a member of the public it does appear that the underlying dispute in this case and the Victoria's Secret case were different since Gildan's marks emphasized the word SECRET and Victoria's Secret's mark consisted of trademarks containing the words VICTORIA'S SECRET and the letters VS. In addition, the standard of review was different.

The end result is that Eclectic Edge will not be able to obtain trademark registrations for any of the applied-for marks, having unsuccessfully run the gambit of oppositions filed by both Gildan and Victoria's Secret.

John McKeown

Goldman Sloan Nash & Haber LLP

480 University Avenue, Suite 1600

Toronto, Ontario M5G 1V2

Direct Line: (416) 597-3371

Fax: (416) 597-3370

Email: mckeown@gsnh.com

These comments are of a general nature and not intended to provide legal advice as individual situations will differ and should be discussed with a lawyer.