

The Appearance of a Package and Trade-Marks

By Diane Bellavance

Summary of the case of *Tai Foong International Ltd v. La Maison Sami T.A. Fruits inc.*

In this case, Tai Foong International Ltd (“Tai Foong”) petitioned the court to grant it an interlocutory injunction prohibiting La Maison Sami T.A. Fruits inc. (“Sami”) from infringing its registered trade-mark in relation with the sale of white fragrant-scented rice originating from Thailand.

Tai Foong sells this rice in jute bags of approximately ten kilos bearing its trade-mark (an ox-head flanked by 2 shrimps and oriental script). Sami sells the same rice in jute bags which are similar to Tai Foong’s bags and also have an oriental script, but they include Sami’s unregistered trade-mark (a fish-head in a circle with the words “Trout-head” above the circle).

Tai Foong was of the opinion that the two bags placed side by side constituted sufficient evidence of the probability of confusion between the two trade-marks. Sami presented as witnesses retailers distributing the two products who testified that the two bags did not create any confusion for consumers who were well aware of which brand they were purchasing. Furthermore, Sami showed that other distributors also used similar packaging (jute bags with oriental text).



The court recognized the probative value of the retailers’ testimony and considered the fact that the bags used by the other distributors all had similar packaging; it also found that Sami’s packaging was distinctive as compared to Tai Foong’s and could easily be identified through its logo (the fish-head). Therefore, the court concluded that there was no evidence of confusion.

Nonetheless, the court thought it appropriate to consider the existence of irreparable injury and the balance of convenience, two criteria weighing in favour of Sami due, primarily, to the seizure before judgment executed by Tai Foong of large quantities of Sami’s bags of rice and the injunction which had the effect of preventing Sami from selling its rice.

Finally, it should be noted that when analyzing Sami’s motion to quash the seizure before judgment, the court, even if it was of the opinion that there was no evidence of confusion between the two trade-marks, stated that it would be possible for the logo (graphical representation) and appearance (get-up) of a bag of rice to be protected by copyright.

For more information, we invite you to contact Ms. Diane Bellavance of *Lavery, de Billy* at (514) 877-2907 or by e-mail at dbellavance@lavery.qc.ca or to visit our Web site www.laverydebilly.com to find out more about the outcome of this case.

Diane Bellavance

Diane Bellavance has been a member of the Quebec Bar since 1988 and specializes in Technology, Entertainment and Intellectual Property Law



You can contact any of the following members of the Technology, Entertainment, and Intellectual Property group in relation with this bulletin.

At our Montréal Office

Diane Bellavance
Patrick Buchholz
Martin Cabanes
David Eramian
Ian Rose

At our Québec City Office

Martin J. Edwards
Louis X. Lavoie
Simon Lemay
Louis Rochette
Jean-Pierre Roy
François Vallières

Montréal

Suite 4000
1 Place Ville Marie
Montréal, Quebec
H3B 4M4

Telephone:
(514) 871-1522
Fax:
(514) 871-8977

Québec City

Suite 500
925 chemin Saint-Louis
Québec, Quebec
G1S 1C1

Telephone:
(418) 688-5000
Fax:
(418) 688-3458

Laval

Suite 500
3080 boul. Le Carrefour
Laval, Quebec
H7T 2R5

Telephone:
(450) 978-8100
Fax:
(450) 978-8111

Ottawa

Suite 1810
360, Albert Street
Ottawa, Ontario
K1R 7X7

Telephone:
(613) 594-4936
Fax:
(613) 594-8783

Web Site

www.laverydebilly.com

All rights of reproduction reserved. This bulletin provides our clients with general comments on recent legal developments. The texts are not legal opinions. Readers should not act solely on the information contained herein.