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Canada's Summary Trial Procedure: A Viable Alternative to Summary Judgment on Trademark Likelihood of Confusion Actions in the United States

Elaine Kussurelis

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CANADA’S SUMMARY TRIAL PROCEDURE: A VIABLE ALTERNATIVE TO SUMMARY JUDGMENT ON TRADEMARK LIKELIHOOD OF CONFUSION ACTIONS IN THE UNITED STATES

Elaine Kussurelis

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I. INTRODUCTION

At any early age, my parents taught me the Golden Rule, “treat others the way you would like to be treated.” Around the same time, I learned another popular idiom, “put yourself in someone else’s shoes.” The latter idiom attempts to teach its audience the importance of empathy. It reminds the listener that one’s first impression of, or reaction to, a situation may not be correct. To fully evaluate the situation, the phrase asks the listener to try to imagine themselves in the other person’s situation. Only after the listener has done this, should he or she make a final decision.

This attempt to put oneself in another’s shoes applies in the legal context as well. For example, finders of fact are sometimes asked to imagine themselves as a reasonable person—a hypothetical person who exercises the degree of attention, knowledge, and judgment that society requires of its members.¹ Alternatively, in trademark infringement lawsuits, which use the ordinary consumer standard, the finder of fact is asked to put themselves in the place of the ordinary consumer in the marketplace to decide whether or not there is infringement.² Generally, juries are empowered to make this determination because “[i]t is assumed that twelve men know more of the common affairs of life than does one man, [and] that they can draw wiser and safer conclusions from admitted facts thus occurring than

¹ *Reasonable Person*, BLACK’S LAW DICTIONARY (10th ed. 2014).

² J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:58 (5th ed. 2017).

can a single judge.”³ However, judges may occasionally make the ordinary consumer determination. When deciding an infringement claim at summary judgment, for example, a judge must place himself or herself in the shoes of the ordinary consumer in the marketplace.

This paper addresses the issues that come with having a judicial system that allows for trademark infringement lawsuits to be dismissed at the summary judgment stage of proceedings—i.e. balancing the problem of judges adopting an ordinary consumer mindset with the preservation of judicial resources—and discusses the possible solution of adopting a summary trial procedure similar to Canada’s summary trial. Part II provides background information about summary judgment on likelihood of confusion in trademark infringement actions in the United States. Part III analyzes the positive and negative aspects of a judge’s ability to dismiss trademark infringement lawsuits at summary judgment in the United States. Part IV reviews Canada’s trademark law and two Canadian procedures for resolving cases before trial: summary judgment and summary trial. Part V examines whether adopting a procedure like summary trial in the United States would be a viable solution to the problems that arise in the United States when dismissing a trademark infringement lawsuit at summary judgment. Part VI offers final thoughts.

II. BACKGROUND

Courts in the United States evaluate trademark infringement claims by determining whether the alleged infringing mark is likely to cause consumer confusion.⁴ To make this determination, courts balance multiple factors using a likelihood of confusion test.⁵ Each circuit uses its own set of factors, sometimes named after the landmark case from that circuit.⁶ The number of factors courts consider varies by circuit and ranges from six to thirteen factors with most

³ *Hana Fin., Inc. v. Hana Bank*, 135 S. Ct. 907, 911 (2015) (quoting *Railroad Co. v. Stout*, 84 U.S. 657, 664 (1874)).

⁴ LOUIS ALTMAN & MALLA POLLACK, *CALLAMAN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES* § 21:1 (4th ed. 2017).

⁵ GRAEME B. DINWOODIE & MARK D. JANIS, *TRADEMARKS AND UNFAIR COMPETITION LAW AND POLICY* 519 (4th ed. 2014).

⁶ *Id.* at 30.

circuits having about eight factors.⁷ For example, the Second Circuit balances its eight “Polaroid” Factors, while the Federal Circuit examines its thirteen “DuPont” Factors.⁸ Although each circuit has its own test, all the courts follow the same general pattern and include several common factors.⁹ Each circuit considers the alleged infringer’s intent, whether actual consumer confusion occurred, and a variety of “market factors.”¹⁰ Such market factors include the similarity of the marks, the similarity of the goods or services, and the purchasing conditions under which and the buyers to whom the sales are made (i.e. “impulse” vs. careful, sophisticated purchasing).¹¹

At trial, the fact-finder must examine each factor in light of the evidence presented and determine whether the factor weighs in favor of the plaintiff or the defendant. Then, it must balance the factors all together to determine whether the defendant’s use is “likely to cause confusion, or to cause mistake, or to deceive.”¹² However, a mere possibility of confusion is not enough.¹³ The fact finder must find probable confusion between the marks.¹⁴ The court makes this determination using an ordinary consumer standard, asking whether an ordinary purchaser in the marketplace is likely to be confused by the marks.¹⁵

Likelihood of confusion is an issue of fact, not law, at the trial court level.¹⁶ Despite the test’s factual nature, dismissal of an infringement lawsuit is allowed on summary judgment if there is no genuine issue of material fact on the issue of likelihood of confusion.¹⁷ In fact, the summary judgment motion can be a powerful trademark litigation weapon for either plaintiffs or defendants.¹⁸ A

⁷ MCCARTHY, *supra* note 2, § 23:1; *see generally* DINWOODIE & JANIS, *supra* note 5, at 522-23.

⁸ DINWOODIE & JANIS, *supra* note 5, at 521-23.

⁹ *Id.* at 520.

¹⁰ *Id.*

¹¹ *Id.* at 523.

¹² MCCARTHY, *supra* note 2, § 23:1.

¹³ *Id.* § 23:3.

¹⁴ *Id.*

¹⁵ *Id.* § 23:58.

¹⁶ *Id.* § 23:67.

¹⁷ *Id.*

¹⁸ 3 ANNE GILSON LALONDE, GILSON ON TRADEMARKS § 8.03 (Matthew Bender).

judge may determine that there is no need for a jury trial because the party alleging infringement has not produced any evidence that could possibly support a factual finding of likelihood of confusion.¹⁹ For example, a defendant can succeed in having the case dismissed at summary judgment by showing a lack of any genuine issue of material fact on likelihood of confusion due to a total dissimilarity of the goods or services involved or due to the complete dissimilarity of the marks.²⁰ Alternatively, a judge may determine that trial is unnecessary if there is sufficient evidence showing a likelihood of consumer confusion.²¹ Although obtaining summary judgment is difficult for a plaintiff on the issue of likelihood of confusion, it is not impossible if the facts of liability are clear.²²

Motions for summary judgment that are properly supported by affidavits, exhibits, depositions, etc., can dispose of the entire case before trial, sparing both time and money.²³ However, if the motion is denied, the adverse party receives the benefit of seeing—albeit in condensed form—the moving party’s theory of the case and main proof.²⁴ Thus, the nonmoving party will likely have the ability to prepare more thoroughly for trial, including preparing a more effective cross-examination.²⁵ Alternatively, the nonmoving party will likely introduce counter-affidavits and briefly disclose its own theory and proof in an attempt to block summary judgment. These actions will allow the moving party a greater opportunity to prepare for trial.²⁶ Thus, it is not likely that either party will gain the upper hand if the motion for summary judgment is denied and the case proceeds to trial.²⁷

At the appellate level, the majority of the circuit courts of appeal treat likelihood of confusion as an issue of fact reviewed on appeal using a “clearly erroneous” standard.²⁸ The Third Circuit, for example, has emphasized that “[t]he question of likelihood of confusion

¹⁹ MCCARTHY, *supra* note 2, § 32:120.

²⁰ *Id.*

²¹ *See id.* § 32:121.

²² *Id.*

²³ GILSON, *supra* note 18.

²⁴ *Id.*

²⁵ *Id.*

²⁶ *Id.*

²⁷ *Id.*

²⁸ MCCARTHY, *supra* note 2, § 23:73.

is ultimately one of fact, and we cannot roll up our sleeves and engage in the balancing ourselves.”²⁹ However, three circuits are in the minority, treating likelihood of confusion as an issue of law reviewed de novo.³⁰ Although the minority circuits treat the trial court’s underlying evaluation of the likelihood of confusion factors as an issue of fact reviewed using a clearly erroneous standard, the circuits treat the weighing and balancing of those factors and the ultimate conclusion as to confusion as a question of law reviewed de novo.³¹ The Sixth Circuit is in the minority of circuits that consider likelihood of confusion to be an issue of law reviewed de novo.³² In *Champions Golf Club, Inc. v. Champions Golf Club, Inc.*, the court emphasized that it applies a clearly erroneous standard to the trial court’s finding of fact supporting the likelihood of confusion factors but reviews de novo the legal question of whether those facts constitute a likelihood of confusion.³³

Courts holding that likelihood of confusion is a question of fact often determine, when deciding on motions for summary judgment, that the likelihood of confusion test poses a genuine material fact that should be left for trial.³⁴ However, courts may also determine that no genuine factual dispute exists on the issue of likelihood of confusion if the court finds that no reasonable jury or factfinder could make a contrary determination.³⁵ Courts have “an important authority to monitor the outer limits of substantial similarity within which a jury is permitted to make the factual determination whether there is a likelihood of confusion”; and thus, courts may grant motions for summary judgment on likelihood of confusion.³⁶ Factual disputes solely over a single likelihood of confusion factor will generally not prevent summary judgment unless the factor tilts the entire balance in favor of such a finding. However, a minority of courts

²⁹ *A&H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198, 237 (3d Cir. 2000).

³⁰ MCCARTHY, *supra* note 2, § 23:73.

³¹ DINWOODIE & JANIS, *supra* note 5, at 524.

³² MCCARTHY, *supra* note 2, § 23:73.

³³ *Champions Golf Club, Inc. v. Champions Golf Club, Inc.*, 78 F.3d 1111, 1116 (6th Cir. 1996).

³⁴ GILSON, *supra* note 18.

³⁵ *Id.*

³⁶ *Id.*

hold that consideration of the similarity of the marks factor alone may allow the court to grant summary judgment.³⁷

Summary judgment is an integral part of the Federal Rules of Civil Procedure because it allows for the “just, speedy and inexpensive determination of every action and proceeding.”³⁸ However, some circuit courts of appeal generally disfavor allowing summary judgment on the question of likelihood of confusion. Other circuits are more willing to dismiss cases on summary judgment.³⁹ For example, the Ninth Circuit has been the most negative of the circuits when considering granting summary judgment in a trademark infringement lawsuit.⁴⁰ The court has often cautioned that “[b]ecause of the intensely factual nature of trademark disputes, summary judgment is generally disfavored in the trademark arena.”⁴¹ In *Jada Toys, Inc. v. Mattel*, the Ninth Circuit even held that granting summary judgment was improper despite the fact that a clear dissimilarity of the marks was the basis for concluding that there was no genuine issue of fact as to the likelihood of confusion.⁴² However, the Ninth Circuit has on occasion found that summary judgment is appropriate.⁴³

Conversely, the Seventh Circuit has been more liberal than the Ninth Circuit in granting motions for summary judgment.⁴⁴ Although the Seventh Circuit has noted that “a motion for summary judgment in trademark infringement cases must be approached with great caution,” the court does not require that each of the seven confusion factors weigh in favor of a single party. For example, in *Sorensen v. WD-40 Co.*, the court upheld a granting of summary

³⁷ *Id.*

³⁸ *Id.*

³⁹ DINWOODIE & JANIS, *supra* note 5, at 524.

⁴⁰ MCCARTHY, *supra* note 2, § 32:120.

⁴¹ *Id.*

⁴² *Jada Toys, Inc. v. Mattel*, 518 F.3d 628, 637 (9th Cir. 2008).

⁴³ *Survivor Media, Inc. v. Survivor Prods.*, 406 F.3d 625, 635 (9th Cir. 2005) (holding that a finding of summary judgment is appropriate where no genuine issue of material fact exists); *see also* *Applied Info. Sciences Corp. v. EBay, Inc.*, 511 F.3d 966, 966 (9th Cir. 2007) (holding that summary judgment is proper where the registrant failed to provide any admissible evidence tending to show a likelihood of confusion).

⁴⁴ *See generally* MCCARTHY, *supra* note 2, § 32:120.

judgment despite some of the likelihood of confusion factors supporting a finding of a likelihood of confusion where the three most important factors (similarity of the marks, bad faith intent, and evidence of actual confusion) weighed in favor of the defendant.⁴⁵

The Supreme Court has yet to address whether likelihood of confusion can be resolved at summary judgment. However, it discussed a similar issue in *Hana Financial, Inc. v. Hana Bank*.⁴⁶ There, the Court found that the trademark issue of tacking—which uses the same ordinary consumer standard as likelihood of confusion—should be left to the jury.⁴⁷ However, the Court emphasized that “[i]f the facts warrant it, a judge may decide a tacking question on a motion for summary judgment.”⁴⁸ Ultimately, the Court in *Hana Financial* held that when a jury is to be empaneled and when the facts do not warrant an entry of summary judgment, the jury must decide whether tacking is warranted.⁴⁹

III. SUMMARY JUDGMENT ON THE ISSUE OF LIKELIHOOD OF CONFUSION IN TRADEMARK INFRINGEMENT LAWSUITS

A. *The “Vulcan mind meld” Problem*

A judge must examine the likelihood of confusion factors when deciding whether or not an infringement lawsuit should be dismissed on summary judgment.⁵⁰ Often, the judge identifies and discusses evidence relevant to each individual factor and then draws a conclusion as to whether that factor weighs in favor of a likelihood of confusion between the two marks.⁵¹ Then, the judge uses his or her findings from each individual factor to examine the likelihood of confusion test as a whole, determining whether sufficient evidence was presented for the lawsuit to survive summary judgment.⁵²

⁴⁵ *Sorensen v. WD-40 Co.*, 792 F.3d 712 (7th Cir. 2015).

⁴⁶ *Hana Fin., Inc.*, 135 S. Ct. at 907.

⁴⁷ *Id.* at 909.

⁴⁸ *Id.* at 911.

⁴⁹ *Id.* at 913.

⁵⁰ *See generally* MCCARTHY, *supra* note 2, § 23:1.

⁵¹ *Id.* § 32:120.

⁵² *Id.*

Judges perform the likelihood of confusion inquiry from the perspective of the ordinary consumer in the marketplace.⁵³

William E. Gallagher and Ronald C. Goodstein question a judge's ability to imagine themselves as an ordinary consumer, likening the attempt to a work of science-fiction by labeling it the "Vulcan mind meld."⁵⁴ The term comes from the ability of *Star Trek*'s Vulcan character, Mr. Spock, to touch someone's head with his fingertips and experience that person's thoughts as if they were his own.⁵⁵ Gallagher and Goodstein caution that "[t]he proposition that a human being can perform a 'Vulcan mind meld' with relevant consumers in the marketplace is, like the term, fiction."⁵⁶ This fictional proposition is especially relevant at summary judgment because when a judge uses the "Vulcan mind meld" to decide likelihood of confusion, he or she ultimately determines whether or not a lawsuit can move forward.

Gallagher and Goodstein caution that judges should not assume themselves to be fairly representative of the class of relevant consumers.⁵⁷ Because the judge applying the likelihood of confusion factors is also a consumer, he or she likely has his own subjective preferences.⁵⁸ However, these preferences are often entirely irrelevant to a proper confusion analysis⁵⁹ because it is unlikely that a judge can share the same thoughts and impressions as the ordinary consumer in the marketplace.⁶⁰ If, as is often the case, the judge trying a particular lawsuit is more educated and affluent than the ordinary consumer, the judge's subjective impression may differ from that of the ordinary consumer in the marketplace.⁶¹ Take the perceived purchase risk of a product—which is subjective in nature—as an example. An educated and affluent judge may have the sub-

⁵³ See *id.* § 23:91.

⁵⁴ William E. Gallagher & Ronald C. Goodstein, *Inference Versus Speculation in Trademark Infringement Litigation: Abandoning the Vulcan Mind Meld*, 94 TMR 1229, 1232 (2004).

⁵⁵ *Id.* at 1229.

⁵⁶ *Id.* at 1232.

⁵⁷ *Id.*

⁵⁸ DINWOODIE & JANIS, *supra* note 5, at 525.

⁵⁹ *Id.*

⁶⁰ Gallagher & Goodstein, *supra* note 54, at 1229.

⁶¹ *Id.* at 1232.

jective impression that a consumer's decision to purchase a particular product is routine or inconsequential, while the ordinary consumer may associate a material level of financial risk with the same purchase.⁶²

Further, the situation that judges address in litigation is necessarily substantially different from the ordinary consumer's experience in the marketplace.⁶³ Consumers have naturally acquired knowledge, experience, and motivations; have no mission to look for or experience confusion; and experience actual marketplace circumstances.⁶⁴ In contrast, judges are artificially focused on infringement during litigation.⁶⁵ Not only do judges have knowledge of the identities of the parties, the marks, and the products, but their main job in infringement litigation is to examine evidence that might support an inference of likelihood of confusion.⁶⁶ Further, judges generally consider only secondhand evidence of marketplace situations.⁶⁷ All of these factors taken together may result in judges placing undue emphasis on facts taken out of the actual marketplace context.⁶⁸

Finally, judges are sometimes asked to imagine themselves as an ordinary consumer in a class of which they are not—and will never be—a member. In *Triangle Publications Inc. v. Rohrlich*, the trial judge examined whether teenage girls would be likely to confuse plaintiff's mark, "Seventeen," for magazines with the defendant's mark, "Miss Seventeen," for girdles.⁶⁹ In his dissent, Judge Frank criticized the trial judge's "shaky kind of guess" that the ordinary female teenage consumer was likely to be confused by the two marks.⁷⁰ He suggested that courts should obtain information about the likelihood of confusion between the marks from the ordinary consumers themselves.⁷¹ Judge Frank went so far as to question adolescent girls, their mothers, and their sisters as to whether or not

⁶² *Id.*

⁶³ *Id.* at 1231.

⁶⁴ *Id.*

⁶⁵ *Id.*

⁶⁶ *Id.* at 1231.

⁶⁷ *Id.*

⁶⁸ *Id.*

⁶⁹ DINWOODIE & JANIS, *supra* note 5, at 525.

⁷⁰ *Triangle Publications v. Rohrlich*, 167 F. 2d 969, 976 (2d Cir. 1948).

⁷¹ *Id.*

confusion was likely between “Seventeen” magazine and “Miss Seventeen” girdles.⁷²

Gallagher and Goodstein offer a similar solution to Judge Frank. They propose using consumer research to inform the conclusion on likelihood of confusion.⁷³ Gallagher and Goodstein suggest that surveys about consumer perception and responses should be deemed important, and in some cases necessary, for plaintiffs to prevail on a trademark infringement claim.⁷⁴ Confusion surveys may provide finders of fact with evidence of actual confusion sufficient to support a finding of likelihood of confusion.⁷⁵ These surveys measure whether consumers believe that the senior user is the source of the alleged infringer’s product or whether it sponsors or approves of that product.⁷⁶

At first glance, survey evidence appears to be a viable solution to the “Vulcan mind meld” problem. However, survey use can present additional problems depending on the viability of the survey.⁷⁷ Some courts have found issue with the survey population, requiring that the universe tested by the survey be representative of the appropriate consuming public.⁷⁸ The appropriate consuming public is generally defined as potential purchasers of the infringer’s products.⁷⁹ Additionally, if the survey questions are phrased in a misleading manner or the pool of respondents is not appropriate given the circumstances of the lawsuit, the survey results will likely be misleading.⁸⁰ This misleading information is particularly problematic at summary judgment, where a judge’s reliance on a misleading survey could prevent a party from being able to try its case.

⁷² *Id.* at 977.

⁷³ Gallagher & Goodstein, *supra* note 54, at 1235.

⁷⁴ *Id.*

⁷⁵ GILSON, *supra* note 18.

⁷⁶ *Id.*

⁷⁷ *See generally* Daniel A. Klein, *Admissibility and weight of consumer survey in litigation under trademark opposition, trademark infringement, and false designation of origin provisions of Lanham Act (15 U.S.C.A. §§ 1063, 1114, and 1125)*, 98 A.L.R. FED. 20 (1990).

⁷⁸ GILSON, *supra* note 18.

⁷⁹ *Id.*

⁸⁰ *See id.*

B. Assessing the Similarity of the Marks Factor: A Balancing Act Between the Preservation of Judicial Resources and the Need for the Ordinary Consumer Fact Finder

The increasing use of summary judgment is one factor causing fewer and fewer cases to reach trial in federal courts.⁸¹ Dismissing a case on summary judgment allows courts to preserve judicial resources by preventing a case, in which there is no genuine issue of material fact, from going to trial.⁸² Because the similarity of the marks factor is “by far the most influential” in the likelihood of confusion analysis,⁸³ it may be tempting for a judge who perceives the marks to be dissimilar to determine that there is no genuine issue of material fact and to dismiss the lawsuit on summary judgment. On one hand, by dismissing the aforementioned case, the court does not waste judicial resources trying a case in which there is no genuine issue of material fact; and thus, the outcome is already certain. On the other hand, dismissing a case because the judge believes the marks to be dissimilar does not take into account a variety of other factors, including the risks of side-by-side comparison, using the real-world purchasing context, and the danger of the judge’s subjective beliefs entering the decision.

i. Side-by-Side Analyses in *Top Tobacco and Malletier*

In the Seventh Circuit case, *Top Tobacco, L.P. v. North Atlantic Operating Co., Inc.*, Judge Easterbrook concluded that it was “next to impossible to believe that any consumer, however careless, would confuse the products.”⁸⁴ He found that summary judgment was appropriate because the marks were so dissimilar that no consumer could be confused as to who made the respective products.⁸⁵ Judge Easterbrook’s analysis of the likelihood of confusion factors ended after the similarity of the marks inquiry.⁸⁶ “If we know for sure that

⁸¹ MCCARTHY, *supra* note 2, § 32:113.

⁸² *See generally id.*

⁸³ Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 Cal. L. Rev. 1581, 1600 (2006).

⁸⁴ *Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 509 F. 3d 380, 383 (7th Cir. 2007).

⁸⁵ *Id.*

⁸⁶ *Id.*

consumers are not confused about a product's origin," Judge Easterbrook emphasized, "there is no need to consult even a single [factor]." ⁸⁷ Thus, Judge Easterbrook proposed that "knowing for sure" allows a judge to bypass the likelihood of confusion factors. ⁸⁸ This analysis begs the following question: how can a judge "know for sure" that no consumer confusion exists? Judge Easterbrook recognized in the *Top Tobacco* opinion that judges "may misunderstand how trade dress affects purchasing decisions." ⁸⁹

Absolute knowledge is a high standard—and a high standard should be required when dismissing a trademark infringement lawsuit before an ordinary consumer factfinder has a chance to evaluate the case. Moreover, the similarity of the marks factor is complex. ⁹⁰ When examining the similarity of marks factor, the court must do more than view the marks side-by-side in the courtroom. ⁹¹ It must attempt to simulate the ordinary consumer's encounter with the mark in the real world and then assess the similarity of the marks with that context in mind. ⁹² The marketplace in *Top Tobacco* involved the two consumer goods sitting next to each other on a store shelf. ⁹³ However, that is not always the case in infringement actions. Sometimes, the average consumer in the marketplace does not have the luxury of viewing the marks side-by-side. ⁹⁴

In *Louis Vuitton Malletier v. Burlington Coat Factory Warehouse Corporation*, a trade dress case, the Second Circuit warned against using side-by-side similarity comparisons to analyze likelihood of confusion. ⁹⁵ The plaintiff sold a line of multicolored handbags through its Louis Vuitton stores and at upscale department stores with selling prices ranging between \$400 and \$4,000, while

⁸⁷ *Id.*

⁸⁸ *Id.*

⁸⁹ *Id.*

⁹⁰ DINWOODIE & JANIS, *supra* note 5, at 544.

⁹¹ *Id.*

⁹² *Id.*

⁹³ *See Top Tobacco, L.P.*, 509 F.3d at 380.

⁹⁴ *See Malletier v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532, 534 (2d. Cir. 2005) (vacating the district court's denial of plaintiff's motion for injunctive relief).

⁹⁵ *Id.*

the defendant sold a line of multicolored handbags through its discount retail stores at the price of \$29.98 per bag.⁹⁶ The plaintiff claimed that the defendant's trade dress was likely to cause both initial interest confusion (i.e., the purchaser is initially drawn to the handbag because they confuse the origin of defendant's bag with plaintiff's handbags⁹⁷) and post-sale confusion (i.e., someone other than the purchaser—chiefly potential purchasers—will see the defendant's bag and mistakenly relate it to the plaintiff's handbags⁹⁸).⁹⁹

In *Malletier*, the ordinary consumer in the marketplace would not simultaneously view the defendant's and the plaintiff's handbags.¹⁰⁰ The court emphasized that “the Lanham Act requires a court to analyze the similarity of the products in light of the way in which the marks are actually displayed in their purchasing context.”¹⁰¹ It is true that two products may be easily differentiated when carefully viewed side-by-side.¹⁰² However, those same products may still be confusingly similar in the eyes of ordinary consumers who encounter the products separately under typical purchasing conditions.¹⁰³ It is precisely that “real-world” confusion that the Lanham Act seeks to eliminate.¹⁰⁴ Thus, the *Malletier* court found side-by-side viewing to be inappropriate when it is isolated viewing that is at issue in the marketplace.¹⁰⁵

Although it may be tempting for a judge to attempt to preserve judicial resources by dismissing an infringement lawsuit at summary judgment when the marks appear to be entirely dissimilar, it is not always proper to do so. A judge must ensure that he or she considers the marks in the real-world purchasing context—which is not always side-by-side—because to do otherwise “frustrates (however unintentionally) Congress's intent.”¹⁰⁶

⁹⁶ DINWOODIE & JANIS, *supra* note 5, at 544.

⁹⁷ *See generally* GILSON, *supra* note 18, § 5.14.

⁹⁸ *See generally id.*

⁹⁹ DINWOODIE & JANIS, *supra* note 5, at 544.

¹⁰⁰ *See Malletier*, 426 F.3d at 539.

¹⁰¹ *Id.* at 538.

¹⁰² *Id.* at 539.

¹⁰³ *Id.*

¹⁰⁴ *Id.*

¹⁰⁵ *Id.* at 538.

¹⁰⁶ *Malletier*, 426 F.3d at 539.

ii. *Jada* on the Danger of Elevating a Judge's Subjective Beliefs over other Relevant Evidence

Finally, in *Jada Toys, Inc. v. Mattel, Inc.*, the Ninth Circuit warned against treating any one factor as dispositive to the ultimate question of likelihood of confusion.¹⁰⁷ The *Jada* court held that the dissimilarity of the marks alone does not absolve the need to inquire into evidence of other likelihood of confusion factors.¹⁰⁸ The court emphasized that holding otherwise would allow the possibility that persuasive evidence of one particular factor—dissimilarity of the marks—be considered at the expense of relevant evidence of other factors.¹⁰⁹ Giving courts the ability to rely on the dissimilarity of the marks factor alone to conclude that no likelihood of confusion exists would create the potential for a judge to elevate his or her own subjective impressions of the relative dissimilarity of the marks over evidence of, for example, actual consumer confusion.¹¹⁰ The likelihood of confusion test would be undermined if the subjective impressions of a particular judge were weighed at the expense of other relevant evidence.¹¹¹ Thus, although it may be tempting for a judge to conserve judicial resources by dismissing a trademark infringement lawsuit because he or she perceives the marks to be dissimilar, to do so would be improper.¹¹²

C. *Why Judges Should Have the Authority to Decide Trademark Infringement Cases at Summary Judgment*

Preventing judges from dismissing trademark infringement actions at summary judgment on likelihood of confusion would place an undue monetary burden on defendants and open the floodgates to infringement litigation. Summary judgment provides a quick and inexpensive opportunity for parties to dispose of a case in which there are no real issues of fact that call for trial.¹¹³ Summary judgment also raises the costs and risks associated with the pretrial phases of

¹⁰⁷ *Jada Toys, Inc.*, 518 F. 3d at 633.

¹⁰⁸ *Id.* at 634.

¹⁰⁹ *Id.* at 633.

¹¹⁰ *Id.*

¹¹¹ *Id.*

¹¹² *See generally id.*

¹¹³ MCCARTHY, *supra* note 2, § 32:113.

litigation for plaintiffs.¹¹⁴ Summary judgment effectively serves as a screening mechanism to prevent plaintiffs from bringing frivolous lawsuits because such lawsuits are unlikely to survive summary judgment.¹¹⁵ It follows that eliminating summary judgment as a screening mechanism will allow for an increase in frivolous claims, opening the floodgates to litigation.¹¹⁶ By definition, frivolous lawsuits are cases filed with the intention to extort a settlement payment from a defendant by threatening a costly legal battle.¹¹⁷ An increase in frivolous lawsuits therefore places an unjust monetary burden on defendants, the targets of these lawsuits.¹¹⁸ Thus, judges should maintain the authority to decide infringement cases on likelihood of confusion at summary judgment because preventing plaintiffs from bringing frivolous lawsuits preserves judicial resources and avoids placing an undue monetary burden on defendants.

D. Finding Guidance in Hana Financial v. Hana Bank

The Supreme Court has not yet considered whether it is proper to determine likelihood of confusion at summary judgment in a trademark infringement lawsuit. However, the Supreme Court did recently address a similar issue—whether a judge or a jury should determine the outcome of a case on the trademark issue of tacking—in *Hana Financial*.¹¹⁹ Like the likelihood of confusion test in trademark infringement actions, tacking is also analyzed from the perspective of an ordinary consumer.¹²⁰ In *Hana Financial*, the Supreme Court held that because the tacking inquiry operates under an ordinary consumer standard, a jury should make the determination.¹²¹ In the *Hana Financial* opinion, Justice Sotomayor acknowledged that the court has long recognized across a variety of doctrinal contexts that when the relevant question is how an ordinary person

¹¹⁴ Samuel Issacharoff & George Loewenstein, *Second Thoughts About Summary Judgment*, 100 YALE L. J. 73, 76 (1990).

¹¹⁵ *Id.* at 106.

¹¹⁶ *See generally id.*

¹¹⁷ *Id.*

¹¹⁸ *See generally id.*

¹¹⁹ *Hana Fin., Inc.*, 135 S. Ct. at 907.

¹²⁰ *Id.*

¹²¹ *Id.*

or community would make an assessment, the jury is generally the decision maker that should provide the fact-intensive answer.¹²²

Justice Sotomayor's *Hana Financial* opinion employs strong language to advocate that ordinary consumer analyses be made by juries. However, the unanimous opinion goes on to find that a judge may decide a tacking question on a motion for summary judgment when the facts warrant it.¹²³ The court in *Hana Financial* ultimately held that "when a jury trial has been requested and *when the facts do not warrant entry of summary judgment . . . the question whether tacking is warranted must be decided by a jury.*"¹²⁴

Ultimately, the *Hana Financial* opinion is instructive in a trademark infringement context because both tacking and infringement use an ordinary consumer standard in their respective analyses. Despite the ordinary consumer standard lending itself to being a question for the jury to determine, the Supreme Court held in *Hana Financial* that the trademark issue of tacking can be resolved at summary judgment when the facts warrant it.¹²⁵ It follows that the Supreme Court would be likely to similarly find that when the facts warrant it, the trademark issue of infringement can be resolved at summary judgment. Thus, the Supreme Court is unlikely to create a bright-line rule that judges should not decide likelihood of confusion at summary judgment. Therefore, in order to solve the issues raised by deciding likelihood of confusion at summary judgment—the "Vulcan mind meld" problem, the risk of side-by-side comparison, the need to evaluate the real-world marketplace context, etc., — other avenues must be explored.

IV. TURNING TO CANADIAN LAW FOR A POTENTIAL SOLUTION

Trademark law in the United States and Canada share various common aspects. Like the United States, Canada provides legal protection to both registered and unregistered trademarks through the

¹²² *Id.* at 911.

¹²³ *Id.*

¹²⁴ *Id.* (emphasis added).

¹²⁵ *Hana Fin., Inc.*, 135 S. Ct. at 907.

Trade-marks Act and at common law.¹²⁶ Both the United States and Canada determine whether a mark is infringing on another trademark by examining likelihood of confusion factors, which include the similarity of the marks and the intent of the allegedly infringing mark holder.¹²⁷ Further, the confusion analysis is determined using an average consumer standard in both the United States and Canada.¹²⁸ One notable difference between trademark actions in the United States and Canada is that, in Canada, trademark infringement trials are conducted by a judge without a jury.¹²⁹ Conversely, trademark infringement trials in the United States are generally tried by a judge with a jury.¹³⁰ The following section examines Canada's treatment of trademark infringement actions at the summary proceedings stage for a potential solution to the foregoing problems presented at summary judgment in infringement actions in the United States.

A. *Trademark Infringement in Canada*

Canada's Trade-marks Act allows an action to be brought for trademark infringement.¹³¹ Trademark infringement actions are typically brought before the Federal Court of Canada.¹³² However, actions for infringement may also be brought in the Provincial court.¹³³ A Federal Court decision has effect throughout Canada, while a Provincial Court decision only has effect in that province.¹³⁴ In Canada, a trademark infringement trial is conducted by a judge without a jury.¹³⁵ The trial consists of the testimony of live witnesses, although expert evidence may also be introduced by affidavit.¹³⁶ Survey evidence is also commonly introduced at trial to determine whether the

¹²⁶ ETHAN HORWITZ, *Horwitz on World Trademark Law. Canada*. § 7 (2d ed. 2017).

¹²⁷ *Id.*

¹²⁸ *Id.*

¹²⁹ *Id.*

¹³⁰ See generally GILSON, *supra* note 18, § 8.04.

¹³¹ MONIQUE M. COUTURE, *Trademarks Throughout the World. Canada*. § 30:31.

¹³² *Id.*

¹³³ HORWITZ, *supra* note 126.

¹³⁴ *Id.*

¹³⁵ *Id.*

¹³⁶ *Id.*

marks are confusingly similar.¹³⁷ However, to be admissible, the survey evidence must be fair and unbiased, conducted by a qualified expert, cover an issue outside the experience of the judge, and usually may not be confined to a limited geographical area.¹³⁸ Admissible survey evidence can be accorded great weight by the courts.¹³⁹ Parties may also obtain preliminary injunctions in trademark infringement lawsuits.¹⁴⁰ However, to obtain a preliminary injunction, a party must show that there is a serious issue to be tried, that the plaintiff will suffer irreparable injury in the absence of an injunction, and that the balance of convenience is in the plaintiff's favor.¹⁴¹

A registered trademark holder has the exclusive right to use the mark. This right is infringed by any person who, without authorization, sells, distributes, or advertises goods or services in association with a confusingly similar trademark.¹⁴² A trademark is confusingly similar to another trademark if the use of both trademarks in the same area would likely lead to the inference that the products associated with such trademarks are made by the same person.¹⁴³ Canadian courts should consider all surrounding circumstances when determining whether two trademarks are confusingly similar.¹⁴⁴ The Trade-marks Act provides the court with a list of factors to consider in determining whether trademarks are similar, including the inherent distinctiveness of the marks and the extent to which the marks are known, the length of time the marks have been in use, the nature of the products, the nature of the trade, and the degree of similarity between the marks.¹⁴⁵ Canadian courts should also consider the intent of the allegedly infringing mark holder.¹⁴⁶ Whether or not a mark is famous is not a specifically enumerated factor, however, it is implicit in three of the factors provided in the Trade-marks Act—

¹³⁷ *Id.*

¹³⁸ *Id.*

¹³⁹ *Id.*

¹⁴⁰ *Id.*

¹⁴¹ *Id.*

¹⁴² *Id.*

¹⁴³ *Id.*

¹⁴⁴ *Id.*

¹⁴⁵ The Trade-Marks Act, R.C.S. 1985, c. T-13 § 6(5).

¹⁴⁶ HORWITZ, *supra* note 126.

the inherent distinctiveness, the extent to which the mark has become known, and the length of time that it has been used.¹⁴⁷

Canada's Federal Court of Appeals has set four standards to analyze the likelihood of confusion.¹⁴⁸ First, courts must use the imperfect recollection test to determine the similarity of the marks.¹⁴⁹ This test is similar to the ordinary consumer standard in the United States in that it requires the court to consider the average, "somewhat-hurried"¹⁵⁰ consumer's imperfect recollection when analyzing the likelihood of confusion.¹⁵¹ Canada's imperfect recollection test finds that it is improper to do a side-by-side comparison of the marks. The marks should not be subjected to careful side-by-side analysis because the court must instead attempt to put itself in the position of the average consumer—a person who has only a general and not a precise recollection of the earlier mark and then sees the later mark by itself.¹⁵² If the court finds that the average consumer is likely to believe that the later mark's product is made by the earlier mark's brand (of which the consumer "has only such a recollection"), the court may properly conclude that the marks are similar.¹⁵³ Second, the marks must be considered in their entirety.¹⁵⁴ The nature of the goods associated with the mark must also be considered.¹⁵⁵ Finally, the court must consider the degree of resemblance of the appearance, sound, and ideas suggested.¹⁵⁶

When the court finds that trademark infringement is present, it may issue an injunction.¹⁵⁷ The court also has the authority to order that any infringing goods, packages, labels, and advertising material be destroyed.¹⁵⁸ The court can also order the recovery of either the damages sustained as a result of the infringement or an accounting of the infringer's profits attributable to the infringement, but not

¹⁴⁷ *Veuve Clicquot v. Boutiques Clicquot Ltee.*, [2006] S.C.R. 23 (Can.).

¹⁴⁸ HORWITZ, *supra* note 126.

¹⁴⁹ *Id.*

¹⁵⁰ *Veuve Clicquot v. Boutiques Clicquot Ltee.*, [2006] S.C.R. 23 (Can.).

¹⁵¹ HORWITZ, *supra* note 126.

¹⁵² *Id.*

¹⁵³ *Id.*

¹⁵⁴ *Id.*

¹⁵⁵ *Id.*

¹⁵⁶ *Id.*

¹⁵⁷ *Id.*

¹⁵⁸ *Id.*

both.¹⁵⁹ To award both damages and profits would allow the plaintiff double recovery.¹⁶⁰ However, the court may additionally award litigation costs to the successful party in a trademark infringement action. Finally, in some cases, the court may award punitive damages.¹⁶¹

B. Summary Proceedings in Canada: The 2009 Amendment to the Federal Court Rules

Canada's Federal Court Rules allow for two types of summary proceedings prior to trial, summary judgment and summary trial.¹⁶² In 2009, Canada amended its Federal Court Rules to modify the existing rules on summary judgment and to include a summary trial procedure.¹⁶³ Prior to the 2009 amendment, the judicial interpretation of the summary judgment rule limited the instances in which summary judgment could be granted.¹⁶⁴ The prior jurisprudence required that motions for summary judgment be dismissed when there was an issue of credibility or conflicting evidence and the outcome of the motion turned on the drawing of inferences.¹⁶⁵

The 2009 amendment recognized and sought to correct a deficiency in the prior summary judgment provisions' ability to "provide the flexibility needed to manage the Federal Court's caseload efficiently by the expeditious disposition of cases that do not require a full trial."¹⁶⁶ The summary trial procedure included in the 2009 amendment was modeled after a similar procedure found in the *British Columbia Rules of Court*. Including a summary trial procedure allows for the court to dispose summarily of actions in a greater range of circumstances than was permitted under the previous rules.¹⁶⁷

Thus, the 2009 amendment to Canada's Federal Court Rules modified the summary judgment rules and added a summary trial

¹⁵⁹ *Id.*

¹⁶⁰ *Id.* at n. 775.

¹⁶¹ *Id.*

¹⁶² Federal Courts Act, C.R.C., c 214, 216 (Can.).

¹⁶³ *Canada Gazette, Part II*, SOR/2009-331, 2603, December 23, 2009.

¹⁶⁴ *Id.*

¹⁶⁵ *Id.*

¹⁶⁶ *Id.*

¹⁶⁷ *Id.*

procedure, in part, to preserve judicial resources.¹⁶⁸ This is because Canada's civil justice system is "premised upon the value that the adjudication process must be fair and just."¹⁶⁹ A fair and just result cannot be achieved when the process is disproportionate to the nature of the dispute and the interests involved.¹⁷⁰

In *Hryniak v. Mauldin*, the Supreme Court of Canada called for a shift in the culture of Canada's civil justice system.¹⁷¹ The court emphasized that the proportionality principle—which says that the best forum for resolving a dispute is not always that with the most painstaking procedure—can act as a touchstone for access to civil justice.¹⁷² For example, the court highlighted that protracted trials, with unnecessary expense and delay, can prevent the fair and just resolution of disputes.¹⁷³

The 2009 amendment also sought to give parties more control over the pace of their litigation.¹⁷⁴ The inclusion of a summary trial procedure enabled the court to determine an issue or action through summary trial even when conflicting evidence or issues of credibility are present, which would have required a full trial prior to the 2009 amendment.¹⁷⁵ By expanding the number of instances in which an action could be disposed of summarily through the means of summary trial, the 2009 amendment provided greater flexibility to the parties to litigation and to the court, while enhancing access to justice.¹⁷⁶

C. The Procedure of Summary Judgment and Summary Trial in Canada

In Canada, a party may bring a motion for summary judgment or a motion for summary trial on all or some of the issues raised in the pleadings at any time after the defendant has filed a defense, but before trial has been scheduled.¹⁷⁷ Canadian trademark infringement

¹⁶⁸ See generally *id.*

¹⁶⁹ *Hryniak v. Mauldin*, [2014] S.C.R. 7 (Can.).

¹⁷⁰ *Id.*

¹⁷¹ *Id.*

¹⁷² *Id.*

¹⁷³ *Id.*

¹⁷⁴ *Canada Gazette*, *supra* note 163.

¹⁷⁵ *Id.* at 2604.

¹⁷⁶ *Id.*

¹⁷⁷ Federal Courts Act, C.R.C., c 213(1) (Can.).

actions may be decided at summary judgment¹⁷⁸ or summary trial.¹⁷⁹ Parties to intellectual property actions in Canada may also jointly agree to proceed by way of summary trial, rather than spending time and money preparing for and having a full trial.¹⁸⁰ However, once a party moves for summary judgment or summary trial, the party may not bring a further motion for either summary judgment or summary trial unless the party receives permission from the court.¹⁸¹ As a general principle, the court must interpret and apply the rules governing summary judgment and summary trial “so as to secure the just, most expeditious and least expensive determination of every proceeding on its merits.”¹⁸²

i. Summary Judgment

In Canada, summary judgment is available because it allows for the efficient disposition of actions, in whole or in part, where conducting a trial to hear a full range of evidence is unnecessary.¹⁸³ Courts may grant motions for summary judgment when there is no genuine issue for trial.¹⁸⁴ A motion for summary judgment must be based solely on the evidence offered by the parties in their motion records.¹⁸⁵ A response to a motion for summary judgment cannot rely on what *might* be adduced as evidence at a later stage in the proceedings.¹⁸⁶ Rather, it must provide specific facts and offer the evidence showing that there is no genuine issue for trial.¹⁸⁷

If the court is satisfied that there is no genuine issue for trial with respect to a claim or defense on a motion for summary judgment, the court must grant summary judgment.¹⁸⁸ However, if the court finds that there is a genuine issue of fact or law for trial, the court

¹⁷⁸ Harley Davidson Motor Co. Group, LLC v. Manoukian, [2013] F.C. 193 (Can.). (granting summary judgment for trademark infringement).

¹⁷⁹ Malletier S.A. v. Singga Enterprises (Canada) Inc., [2011] F.C. 776 (Can.). (granting summary trial for trademark and copyright infringement).

¹⁸⁰ Tremblay v. Orio Canada Inc., [2013] F.C. 109 [26] (Can.).

¹⁸¹ Federal Courts Act, C.R.C., c 213(2) (Can.).

¹⁸² *Id.* at *Interpretation, General Principle*.

¹⁸³ *Canada Gazette*, *supra* note 163.

¹⁸⁴ *Id.*

¹⁸⁵ *Id.*

¹⁸⁶ Federal Courts Act, C.R.C., c 214 (Can.).

¹⁸⁷ *Id.*

¹⁸⁸ Federal Courts Act, C.R.C., c 215(1) (Can.).

may “nevertheless determine that issue by way of summary trial and make any order necessary for the conduct of the summary trial; or . . . dismiss the motion in whole or in part and order that the action, or the issues in the action not disposed of by summary judgment, proceed to trial or that the action be conducted as a specially managed proceeding.”¹⁸⁹

ii. Summary Trial

The summary trial procedure allows the court to determine an issue or action even if there is conflicting evidence or if issues of credibility are present.¹⁹⁰ The motion record for a summary trial must contain all of the evidence a party wishes to rely upon, including affidavits, admissions, affidavits or statements of an expert witness, and other admissible evidence.¹⁹¹ The court is permitted to draw an adverse inference if a party fails to file responding or rebuttal evidence.¹⁹² After a party moves for summary trial, no further affidavits or statements may be served unless the party received permission from the court.¹⁹³ However, in the case of the moving party, there is also an exception if the content of the affidavit or statement is limited to evidence that would be admissible at trial as rebuttal evidence.¹⁹⁴ Further, the court has authority at summary trial to make any order required for the conduct of the summary trial.¹⁹⁵ This includes the authority to issue orders requiring a deponent or an expert who has given a statement to be cross-examined live before the court at the summary trial proceeding.¹⁹⁶ Finally, the court may draw an adverse inference at summary trial if a party fails to cross-examine on an affidavit.¹⁹⁷

The court must dismiss a motion for summary trial if “the issues raised are not suitable for summary trial” or if “summary trial would

¹⁸⁹ Federal Courts Act, C.R.C., c 214(3) (Can.).

¹⁹⁰ *Canada Gazette*, *supra* note 163, at 2604.

¹⁹¹ Federal Courts Act, C.R.C., c 216(1) (Can.).

¹⁹² Federal Courts Act, C.R.C., c 216(4) (Can.).

¹⁹³ Federal Courts Act, C.R.C., c 216(2) (Can.).

¹⁹⁴ *Id.*

¹⁹⁵ *Id.*

¹⁹⁶ Federal Courts Act, C.R.C., c 216(3) (Can.).

¹⁹⁷ Federal Courts Act, C.R.C., c 216(4) (Can.).

not assist in the efficient resolution of the action.”¹⁹⁸ The party seeking summary trial has the burden to prove that a summary trial is appropriate.¹⁹⁹ A judge evaluates the following factors to determine whether a case is appropriate for summary trial: the amount of money involved, the complexity of the matter, the urgency of the matter, any prejudice delay may cause, comparing the cost of taking the case to a full trial to the amount of money involved, whether the case requires an extensive trial, whether the credibility of witnesses is critical in the case, whether summary trial will be a waste of time, whether summary trial will cause the action to be divided into separate trials, and any other relevant issue.²⁰⁰

Once a motion for summary trial is before the court, the party making an assertion has the burden to prove that assertion using relevant evidence and applying appropriate law.²⁰¹ If the court dismisses a motion for summary trial, the court may order the action (or issues within the action that were not disposed of by summary trial) to proceed to trial.²⁰² Alternatively, the court may grant judgment either generally or on an issue if the court is satisfied that there is sufficient evidence for adjudication, unless the court finds that it would be unjust to decide the issues on the motion for summary trial,²⁰³ regardless of complexity or conflicting evidence.²⁰⁴ When granting judgment on a motion for summary trial, the court may make any order necessary for the disposition of the action, including an order directing a trial to determine the amount of money to which the moving party is entitled, imposing terms regarding enforcement of the judgment, and awarding costs.²⁰⁵

¹⁹⁸ Federal Courts Act, C.R.C., c 216(2) (Can.).

¹⁹⁹ *Teva Canada Ltd. v. Wyeth LLC and Pfizer Canada Inc.*, [2011] F.C. 1169 (Can.).

²⁰⁰ HORWITZ, *supra* note 126.

²⁰¹ *Teva Canada Ltd. v. Wyeth LLC and Pfizer Canada Inc.*, [2011] F.C. 1169 (Can.).

²⁰² Federal Courts Act, C.R.C., c 216(8) (Can.).

²⁰³ Federal Courts Act, C.R.C., c 216(6) (Can.).

²⁰⁴ *Driving Alternative Inc. v. Keyz Thankz Inc.*, [2014] F.C. 559 (Can.).

²⁰⁵ Federal Courts Act, C.R.C., c 216(7) (Can.).

V. SHOULD THE UNITED STATES ADOPT A SUMMARY PROCEEDING SIMILAR TO CANADA'S SUMMARY TRIAL?

The Supreme Court's holding in *Hana Financial*—“when a jury trial has been requested and when the facts do not warrant entry of summary judgment . . . the question whether tacking is warranted must be decided by a jury”—suggests that the Supreme Court will not create a bright-line rule eliminating summary judgment on the likelihood of confusion in trademark infringement claims.²⁰⁶ Not adopting said bright-line rule benefits courts and defendants alike because summary judgment acts as a screen that prevents frivolous lawsuits, which cost both courts and defendants time and money to manage.²⁰⁷ However, the availability of summary judgment as an option for disposing of an infringement claim poses various problems. First, it is nearly impossible for a judge to perform the “Vulcan mind meld” required to become an ordinary consumer in the likelihood of confusion analysis.²⁰⁸ Further, judges should exercise caution when examining the similarity of the marks factor to ensure that their analysis of the similarity of the marks considers the real-world purchasing context and does not elevate their own subjective beliefs over other evidence.²⁰⁹ Canada's summary trial procedure offers a suitable solution to the foregoing issues.

A. *Why Summary Trial is the Proper Solution*

Although it would be beneficial to always have a jury decide the question of likelihood of confusion, an analysis of the Supreme Court's *Hana Financial* decision provides that eliminating summary procedure altogether is unlikely. Canada's summary trial or a similar procedure—like a formal, binding version of the Alternative Dispute Resolution procedures: summary jury trial and summary bench trial²¹⁰—is a desirable alternative to summary judgment. Summary trial is a better procedural choice than summary judgment in decid-

²⁰⁶ *Hana Fin., Inc.*, 135 S. Ct. at 911.

²⁰⁷ Issacharoff & Loewenstein, *supra* note 114.

²⁰⁸ Gallagher & Goodstein, *supra* note 54.

²⁰⁹ *Malletier*, 426 F.3d at 539; *see also Jada Toys, Inc.*, 518 F.3d at 633.

²¹⁰ WAYNE D. BRAZIL, *MOORE'S FEDERAL PRACTICE*, § 16.53 (3d ed. 1948).

ing likelihood of confusion because it offers parties more of an opportunity to litigate their position than summary judgment provides. Summary trial is also a viable alternative to summary judgment because it preserves judicial resources.

Summary trial should replace summary judgment in likelihood of confusion actions because summary trial allows parties to more exhaustively advocate their case. At summary trial, both parties have the benefit of cross-examining witnesses and experts, which is not an option at summary judgment.²¹¹ The opportunity for cross-examination also benefits the judge, who must decide whether a likelihood of confusion exists. The judge is able to examine more evidence on likelihood of confusion at summary trial than he or she would at summary judgment. This opportunity is beneficial to the judge who must become the “ordinary consumer” to determine the likelihood of confusion. For example, a judge may benefit from hearing the testimony and cross-examination of a witness providing evidence of actual confusion. Hearing the witness’ personal explanation of confusion may assist the judge in understanding how an average consumer in the marketplace may be confused by two similar marks. Summary trial also gives parties more control over their investment in the case because the parties may agree to proceed by way of summary trial, spending less time and money than they would if they went to trial.²¹²

Additionally, summary trial is a suitable alternative to summary judgment because it preserves judicial resources. Like summary judgment, summary trial preserves judicial resources by disposing of cases that do not require a full trial, including frivolous claims.²¹³ Thus, summary trial protects against the opening of the floodgates to frivolous infringement litigation that would normally occur without summary judgment. Further, summary trial preserves judicial resources more efficiently than summary judgment because summary trial allows the court to dispose summarily of actions in a greater range of circumstances.²¹⁴ Parties may also elect to forego having a full trial and instead choose to have a summary trial, which preserves judicial resources.

²¹¹ Federal Courts Act, C.R.C., c 214-216 (Can.).

²¹² See generally *Canada Gazette*, *supra* note 163.

²¹³ *Id.*

²¹⁴ *Id.*

B. Although Canada's Summary Trial Does Not Solve the "Vulcan Mind Meld" Problem, the United States Can Amend Canada's Summary Trial to Cure this Issue

Issues at summary trial are decided by a judge rather than a jury.²¹⁵ Thus, the judge must still attempt to put themselves in the place of the ordinary consumer in the marketplace at summary trial on the likelihood of confusion issue. It follows that adopting a summary trial procedure in the place of summary judgment will not solve the problems associated with a judge "becoming" the ordinary consumer. Adopting a summary trial procedure will not cure the inability of a judge to perform a "Vulcan mind meld" into an ordinary consumer or prevent the risk of the judge's subjective beliefs entering the decision. Summary trial similarly does not quash the danger of side-by-side mark comparison or ensure that the real-world purchasing context is used.

Although it is possible that, like judges in the United States, Canadian judges experience similar problems of "becoming" an ordinary consumer, Canada does not have the option to have a jury trial on a trademark infringement action in federal court.²¹⁶ Therefore, there is no opportunity for jurors—who are generally considered average consumers—to resolve the likelihood of confusion question in Canada. Accordingly, Canada's summary trial rule was not written or adopted to resolve any issue with a judge, rather than a jury, becoming an ordinary consumer.

To cure the aforementioned problems associated with summary trial, the United States should amend Canada's summary procedures to fit its needs. Adopting a proceeding similar to Canada's summary trial proceeding in trademark infringement actions on the likelihood of confusion would provide a suitable solution to the current problems faced at summary judgment on likelihood of confusion. In Canada, parties may move for summary judgment or summary trial on likelihood of confusion.²¹⁷

However, parties to trademark infringement actions in the United States should not be given the ability to resolve likelihood of confusion at summary judgment or summary trial. Instead, parties

²¹⁵ *Id.*

²¹⁶ See generally HORWITZ, *supra* note 126.

²¹⁷ See generally *id.*

wishing to use a summary proceeding to dispose of an infringement case on likelihood of confusion should be limited to using summary trial. If parties have access to both summary judgment and summary trial as summary proceedings, the issues related to a judge becoming an ordinary consumer will be exacerbated. That is because none of the problems surrounding judges becoming ordinary consumers are resolved by adopting summary trial. Allowing parties to access both summary judgment and summary trial would give judges more opportunities to decide on likelihood of confusion before juries—the appropriate finder-of-fact when considering likelihood of confusion—have the ability to analyze the question. Thus, summary trial should be the sole summary proceeding that parties to trademark infringement actions should have access to on the question of likelihood of confusion.

While summary trial does not directly correct the problem of judges becoming the ordinary consumer, it is better suited to help judges think like an ordinary consumer at the summary proceeding stage than is summary judgment. Judges are able to consider more evidence at summary trial than they are at summary judgment. In addition to affidavits, admissions, affidavits or statements of an expert witness, and other admissible evidence, judges are able to consider the testimony and cross-examination of witnesses and experts at summary trial. Allowing cross-examination of witnesses and experts is a unique feature to summary trial, which is unavailable at summary judgment. Parties also benefit from having the ability to cross-examine witnesses and experts at the summary proceeding stage. Therefore, although summary trial fails to solve judges' inability to truly transform themselves into the ordinary consumer, it is better suited to decide the likelihood of confusion question because it allows judges to consider more evidence in making the likelihood of confusion determination than summary judgment does.

VI. CONCLUSION

Ultimately, adopting a bright-line rule eliminating summary judgment on the likelihood of confusion analysis is unlikely due to the Supreme Court's holding in *Hana Financial* and the negative impact such a rule would have on judicial resources. However, allowing summary judgment on the likelihood of confusion is equally

as problematic because judges cannot perform a “Vulcan mind meld” to become an ordinary consumer and may face issues considering marks in the real-world context. Canada’s summary trial procedure offers a solution to these diametrically opposed issues. Although a summary trial proceeding does not prevent the judge from having to become an ordinary consumer, it preserves judicial resources while also offering parties a better ability to advocate their case. Thus, with respect to trademark infringement actions on likelihood of confusion, a proceeding similar to summary trial in Canada should be implemented in place of summary judgment.