

COURT FILE NUMBER Q.B. 1195 of 2020

COURT OF QUEEN'S BENCH FOR SASKATCHEWAN

JUDICIAL CENTRE SASKATOON

APPLICANT BTA REAL ESTATE GROUP INC.

RESPONDENT FAMILY FITNESS INC.

IN THE MATTER OF THE RECEIVERSHIP
OF FAMILY FITNESS INC.

BRIEF OF LAW OF THE RESPONDENT, FAMILY FITNESS INC.

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To be heard: February 22, 2021

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I. INTRODUCTION

1. This brief of law is filed on behalf of SM Fitness Inc. (“**SMI**”) in response to the Notice of Application dated February 2, 2021 (the “**Application**”), of BTA Real Estate Investment Group (“**BTA**” or the “**Applicant**”).
2. On October 13, 2020, a consent receivership order (the “**Receivership Order**”) was issued in the within Bankruptcy Proceedings (the “**Bankruptcy Proceedings**”) appointing Alvarez & Marsal Canada Inc. as Receiver of all of the Property (as defined in the Receivership Order) of Family Fitness Inc. (“**FFI**”). SMI was not and is not a party to the Bankruptcy Proceeding. Notwithstanding this fact, the Applicant has brought its Application in the Bankruptcy Proceedings. This brief addresses only the relief sought in paragraphs 1.d. and 1.e. of the Application, namely:
 - (a) A declaration that SMI acted in bad faith in contravention of section 4.2(1) of the *Bankruptcy and Insolvency Act*, RSC 1984, c B-3 (the “**BIA**”) by making its January 25, 2021, application to the Canadian Intellectual Property Office for trademark protection over the “Evolution Fitness” business name (the “**Trademark Application**”); and
 - (b) An order requiring SMI to withdraw or cancel forthwith the Trademark Application.
3. There is no basis for the relief that the Applicant seeks. SMI is not a party to the within Bankruptcy Proceedings and is not subject to the Receivership Order. Even if SMI was a party, the Receivership Order did not impact SMI’s rights. The Trademark Application is not the Property of FFI as defined in the Receivership Order. As a result there is no basis for the relief BTA seeks relief as against SMI.
4. Moreover, and in relation to the mark that is the subject of the Trademark Application, SMI meets all of the criteria for “use” set out in the *Trademarks Act*, RSC 1985, c T-13, that entitles SMI to apply for trademark protection of the mark. The mark at issue, which is a logo comprising a distinct design over the words “Evolution Fitness”, has been used by SMI since 2017 to market fitness services in Regina. The design of the mark was commissioned and paid for by a director of SMI and was created for SMI to use. SMI has promoted and marketed its services under the mark since it started to be used and SMI continues to use the mark to this day. SMI has a *bona fide* interest in the mark by virtue of having invested years’ worth of its promotional and marketing resources to build goodwill in the mark since the mark’s inception.
5. Importantly, however, and as outlined in further detail below, the *Trademarks Act* operates as a complete code for all matters concerning trademarks and trademark applications, including the procedure for opposing a trademark application. The Act confers exclusive jurisdiction to the

Registrar of Trademarks with respect to opposing trademarks and with respect to determining who is entitled to apply for and receive trademark protection of a particular mark. The fact that another entity (in this instance, FFI) may have begun using the mark around the same time as the applicant (in this instance, SMI) is not determinative of the rights to the mark. However, BTA's Application seeks to predetermine this very issue outside of the federal statutory scheme designed for this purpose, namely the *Trademarks Act*. Accordingly, BTA's Application is an inappropriate attempt to deny SMI of its right to reply and to circumvent the statutory scheme enacted by the Parliament of Canada.

6. This breach of procedural fairness is only one of the many problems that arise from BTA's inappropriate Application. Ultimately, only after the proper channels and procedure have been observed by an opponent to a trademark, and the Registrar has issued a decision, can that decision be reviewed by a court. Such review, however, remains the exclusive jurisdiction of the Federal Court of Canada.

II. FACTS

7. The relevant facts are as set out in the affidavit of Matthew Sawa sworn February 18, 2021. Below is a summary of those facts:

- SMI was incorporated on December 5, 2012.
- SMI operates a fitness centre located at 1846 Scarth Street, Regina (the "**Scarth Street Gym**").
- SMI initially operated as a franchisee of Golds Gym, pursuant to a franchise agreement.
- On February 3, 2017, SMI ceased operating as a franchisee of Golds Gym, underwent rebranding, and began operating under the business and trade name of "Evolution Fitness" effective February 18, 2017.
- As a part of the rebranding process, SMI began operating under a new "Evolution Fitness" logo. That logo is shown below and is hereinafter referred to as the "**EF Mark**":



- The EF Mark was commissioned and paid for by Said Kaiss, who is a director of SMI. Both SMI and Family Fitness Inc. ("**FFI**") began using the EF Mark at the same time and concurrently operating their respective fitness centres using the EF Mark.

- Since SMI ceased operating as a Golds Gym in February 2017, SMI has marketed its services and built its brand awareness exclusively on the basis of the “Evolution Fitness” brand using the EF Mark.
 - SMI has invested significant resources, including money and employee time, in marketing its services and building recognition of the Evolution Fitness brand under and using the EF Mark.
 - In light of the above, SMI made the Trademark Application for trademark protection of the EVOLUTION FITNESS & DESIGN trademark which encompasses the EF Mark.
8. The EF Mark was designed to be used by SMI. SMI began using the EF Mark to market its fitness services in Regina as soon as the mark was first created. Accordingly, SMI submitted the Trademark Application pursuant to s. 30 of *The Trademarks Act* for trademark protection of the EF Mark. That section provides that a person may file an application for trademark protection of a trademark if they are using and entitled to use the trademark in Canada in association with goods and services. SMI is entitled to and has been using the EF Mark in Regina in association with fitness services since February 2017, being when the mark was first created.
9. On November 10, 2020, by order of this Court, the Receivership Order was amended to remove the Scarth Street Gym from the list of “Locations” of FFI that are subject to the Receivership Order. The Receivership Order was amended by consent of the parties on the basis that SMI is a separate legal entity than FFI and the Scarth Street Gym was included in the Receivership Order by mistake (see the Application Without Notice of FFI dated November 3, 2020).

III. ISSUES

10. SMI submits that the Application raises the following issues:
- (a) Has the Applicant provided sufficient grounds to base the relief it seeks in relation to the Trademark Application?
 - (b) Is the relief sought by the Applicant in relation to the Trademark Application within the jurisdiction of this Court to grant?
 - (c) What is the proper test for granting injunctive relief and has the Applicant satisfied the test?

IV. LAW AND ARGUMENT

A. The Applicant has Provided no Basis in Fact or Law for the Relief it Seeks in Relation to the Trademark Application

- i. SMI is not subject to the Receivership Order or an “interested person” within the meaning of s. 4.2(1) of the BIA
11. BTA seeks declaratory and injunctive relief in relation to the Trademark Application. Specifically, paragraphs 1.d. and 1.e. of the Application seek a declaration that SMI acted in bad faith contrary to s. 4.2(1) of the *BIA* by reason of making the Trademark Application, and a mandatory injunction compelling SMI to forthwith withdraw or cancel the Trademark Application. Leaving aside for now the issue of whether BTA has met the threshold test for injunctive relief (which is an elevated threshold in the case of a mandatory injunction), BTA has not provided adequate or any grounds on which to base the relief it seeks. The extent of the grounds BTA relies on are found at paragraphs 10 and 11 of the Application, reproduced below for ease of reference:
 10. BTA asserts that SMI acted in bad faith and in contravention of the Consent Receivership Order by applying to the Canadian Intellectual Property Office on January 25, 2021, for trademark protection of the “Evolution Fitness” business name.
 11. Section 4.2(1) of the *BIA* imposes a duty of good faith on all parties interested in proceedings under the *BIA*. Section 4.2(2) of the *BIA* empowers this Court to make any order it considers appropriate if satisfied that a party interests in *BIA* proceedings fails to act in good faith.
12. The Applicant incorrectly presumes that SMI is subject to the duty of good faith imposed by s. 4.2(1) of the *BIA*, and that SMI is in contravention of that duty as well as the Receivership Order. Section 4.2(1) of the *BIA* provides the following:

Good faith

4.2 (1) Any interested person in any proceedings under this Act shall act in good faith with respect to those proceedings.
13. First, and as noted earlier, SMI is not subject to the Receivership Order, or even a party to the within Bankruptcy Proceedings. The Applicant is fully aware that SMI is not party to these proceedings and, moreover, that SMI and FFI are separate and distinct legal entities. It was on this basis that the Applicant consented to removing SMI’s Scarth Street Gym from the Consent Receivership Order (see para 9 herein). Accordingly, SMI is not an “interested person” including by reason that it is not a party to the Bankruptcy Proceedings or subject to the Receivership Order.

14. Accordingly, the fact that it is neither a party to the Bankruptcy Proceedings or subject to the Receivership Order is dispositive of the Application. BTA has provided no basis for the assertion that SMI is an interested party and the application, therefore, fails from the outset.
- ii. SMI has not interfered with the Applicant's rights to the "Evolution Fitness Gym" business name
15. The Applicant has conflated and confused the "Evolution Fitness Gym" business name with the Trademark Application. They are separate and distinct.
16. A business name, as it pertains to a corporation, is a name or style under which a corporation carries on business. A business name consists exclusively of a printed name, and no other distinguishing or identifying marks. In Saskatchewan, *The Business Names Registration Act*, RSS 1978, c B-11 (the "**BNRA**"), governs the use and registration of business names and, subject to some exceptions, requires all business names to be registered. A person may register a business name by making an application to the registrar (who is the Director of Corporations) in the prescribed form. A person dissatisfied with a decision of the registrar under the *BNRA* may appeal to the Court of Queen's Bench. The relevant provisions of the *BNRA* are outlined below:

Interpretation

2 In this Act:

...

(c) "**business name**" means:

...

(ii) in the case of a sole proprietor that is a corporation, a name or style other than its corporate name under which it carries on or intends to carry on business.

Business name to be Registered

4(1) Subject to subsection (3), every person who carries on business under a business name shall cause the business name to be registered under the Act.

...

Application for registration of a business name

6(1) Every application for a registration of a business name must be made to the registrar...

(2) An application shall consist of a declaration in a form prescribed in the regulations or, in the case of a limited partnership, in a form containing the information mentioned in section 16.

...

Appeal to judge of Court of Queen's Bench

10(1) A person who is dissatisfied with a decision of the registrar under this Act may, within one year from the date of the decision, appeal to a judge of the Court

of Queen's Bench who may, upon hearing the appeal, make any one or more of the following orders:

(a) an order dismissing the appeal;

(b) an order allowing the appeal;

...

17. BTA states at paragraph 13 of its Application:

For the reasons identified below, SMI knew, or ought to have known, that the rights to the business name "Evolution Fitness Gym" were included in the receivership estate of FFI and that both BTA and the Receiver understood that such rights were transferrable by the receiver in the asset sale facilitated in these proceedings:...

18. The above assertion is confusing, and leads to the conclusion that the Applicant has clearly misapprehended what exactly the business name "Evolution Fitness Gym" is, because the name is presently registered to FFI. Even more confusing is the fact that in the very affidavit that BTA has filed in support of its Application, the Affidavit of Natasha Halvorson sworn February 2, 2021, plainly recognizes at para 3 that BTA's solicitors **renewed the "Evolution Fitness Gym" business name in the name of FFI**:

Attached and marked collectively as Exhibit "B" to my affidavit are true copies of search results obtained from the Corporate Registry for Saskatchewan disclosing that the business name, "Evolution Fitness Gym", expired on February 29, 2020, **and was renewed in the name of the Debtor by W Law LLP on November 19, 2020**.

[emphasis added]

19. The Applicant's assertions are non-sensical. SMI does not presently seek to interfere with FFI's Registered Business Name. Rather, SMI has applied for trademark protection of the EF Mark, which is separate and distinct from the "Evolution Fitness Gym" business name.
20. In view of the above, and the fact that the "Evolution Fitness Gym" business name was renewed on November 19, 2020, **in the name of FFI by the Applicant's solicitors**, and continues to be registered to FFI, there is no basis for the allegation that SMI has acted in bad faith contrary to s. 4.2(1) of the BIA and the Receivership Order, because: (a) SMI has not interfered with the business name or its transfer to the Receiver; and (b) SMI is not a party to the Receivership Order.

iii. The Trademark Application is not "Property of FFI" subject to the Receivership Order

21. The Receivership Order appoints Alvarez & Marsal Canada Inc. the Receiver of all "Property of the Debtor". The "Debtor" is FFI, and "Property" is defined in the Receivership Order as follows:

“Property” shall mean all present and after-acquired property of the Debtor (and its proceeds) including property relating to the operations of the Debtor and the business name “Evolution Fitness Gym”, including all Property situated at or related whatsoever to the Locations, as the Receiver in its sole discretion may determine to be included therein.

[emphasis added]

22. The Receivership Order expressly contemplates the business name “Evolution Fitness Gym” as property of FFI that is subject to the Order. As outlined in detail above, that business name is presently registered to the Debtor/FFI. The Trademark Application, however, was made by SMI, not FFI, and it cannot be “property of the Debtor” that is subject to the Receivership Order.
23. There is no support for the contention that the Trademark Application is property at all. The Trademark Application is only an **application** for the protection of a trademark. A trademark, once registered, is undoubtedly property in the nature of intangible property. A trademark application, however, is a request made by an applicant to the Registrar of Trademarks to include the cited mark in the register of trademarks as belonging to the applicant if all the pertinent criteria in the *Trademarks Act* are met. If met, the Registrar will issue a certificate of registration to the applicant. This certificate is representative of the state of the trademarks register and the applicant’s property interest in the trademark that is cited on the certificate. Section 40 of the *Trademarks Act* provides that if a trademark application is not opposed by way of the prescribed statement of opposition (which will be outlined in further detail below) the Registrar must issue a certificate of registration:

Registration of Trademarks

40 When an application for the registration of a trademark either has not been opposed and the time for the filing of a statement of opposition has expired, or has been opposed and the opposition has been decided in favour of the applicant, the Registrar shall register the trademark in the name of the applicant and issue a certificate of its registration or, if an appeal is taken, shall act in accordance with the final judgment given in the appeal.

[emphasis added]

Until such a certificate is issued, however, no property exists, just a pending application.

24. Additionally, irrespective of how the Trademark Application is characterized (whether as property or not) the application was made by SMI and not by the Debtor/FFI. All parties recognize that the Applicant, SMI is a separate and distinct legal entity from FFI. Therefore, the Trademark Application cannot be “property of FFI” subject to the Receivership Order.
25. In sum, since the Trademark Application does not constitute “Property of the Debtor”, it is not possible for SMI to have acted in bad faith contrary to s. 4.2(1) of the *BIA* and the Receivership

Order by making the Trademark Application. As outlined earlier, SMI has a *bona fide* interest in the EF Mark that is the subject of the Trademark Application, and SMI is pursuing this interest by the lawful means available to it under the *Trademarks Act*.

iv. SMI has not acted in bad faith

26. The Applicant alleges that SMI has acted in bad faith contrary to s. 4.2(1) of the *BIA*. Again, leaving aside the fact that: (a) SMI is a separate legal entity from FFI; (b) is not subject to the Receivership Order; and (c) is not an “interested party” subject to the good faith obligations imposed by s. 4.2(1) of the *BIA*, there is absolutely no evidence that SMI has acted in bad faith, whether in relation to the Trademark Application or at all. This Court in *Elrose, School Division No. 33 v Stoneouse*, 78 Sask R 278, at para 14, adopted the following definition of bad faith in *Black’s Law Dictionary*:

Bad faith. The opposite of ‘good faith’ generally implying or involving actual or constructive fraud, or a design to mislead or deceive another, or a neglect or refusal to fulfill some duty or some contractual obligation, not prompted by an honest mistake as to one’s rights or duties, but by some interested or sinister motive. Term ‘bad faith’ is not simply judgment or negligence, but rather it implies the conscious doing of a wrong because of dishonest purpose or moral obliquity; it is different from a negative idea of negligence in that it contemplates a state of mind affirmatively operating with furtive design or ill will.

27. There is no evidence that SMI has engaged in fraud of any sort, whether actual or constructive, designed to mislead or deceive another, or that SMI has neglected to fulfill *any* contractual obligation, much less by reason of an interested or sinister motive. Applying for trademark protection of a mark that has been lawfully used and invested into since the mark’s inception does not constitute the “conscious doing of a wrong for a dishonest purpose or moral obliquity.” SMI cannot be said to have acted in bad faith. There is not a scintilla of evidence to support the contention that SMI acted in bad faith because no such evidence exists. SMI is lawfully pursuing its *bona fide* interest in the EF Mark through the appropriate means afforded to it by the *Trademarks Act*, as it is statutorily entitled to do.

B. Determinations Concerning Trademarks are the Exclusive Jurisdiction of the Registrar of Trademarks

i. SMI is entitled to apply for trademark protection of the EF Mark

28. As outlined above, the business name “Evolution Fitness Gym” is separate and distinct from the EF Mark that SMI seeks trademark protection of. The EF Mark encompasses elements in addition to and beyond the business name “Evolution Fitness Gym”. The Trademark Application is for the protection of a design featuring three diagonal lines within a circle over the words “Evolution Fitness”, namely the EF Mark, whereas the business consists exclusively of the printed name “Evolution Fitness Gym” as registered in the Saskatchewan business names registry.

29. In February 2017, a director of SMI, Said Kaiss, commissioned and paid for the EF Mark to be used by SMI. At that time, SMI began operating its Scarth Street Gym and marketing its fitness services using the EF Mark. This came about as a result of a rebranding effort in 2017 when SMI ceased operating as a franchisee of Golds Gym. FFI also began using the EF Mark in association with three fitness centres it owns.
30. Section 4(2) of the *Trademarks Act* defines “use” as it pertains to services in the following manner:
- (2)** A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.
31. The EF Mark has clearly been in “use” by SMI in association with fitness centre services and the Scarth Street fitness centre, and continues to be in use by SMI to the present date.
32. The *Trademarks Act* sets out a single requirement for eligibility to apply for trademark protection. That requirement is the applicant must be entitled to and is using, or proposing to use, the trademark in Canada in association with specified goods or services. Section 30(1) of the *Trademark Act* provides the following:
- Requirements for application**
- 30 (1)** A person may file with the Registrar an application for the registration of a trademark in respect of goods or services if they are using or propose to use, and are entitled to use, the trademark in Canada in association with those goods or services.
33. Since SMI is entitled to and has been using the EF Mark since February 2017 in association with marketing fitness services and the Scarth Street Gym, SMI meets the criteria to apply for protection of the EF Mark. Accordingly, SMI is entitled to and has made the Trademark Application. The Applicant cannot point to anything to assert that SMI is precluded from making the Trademark Application.
34. If the Applicant wishes to oppose the Trademark Application, it may do so through the proper channels set out in the *Trademarks Act*.
- ii. The *Trademarks Act* is a complete code for opposing trademark applications
35. BTA’s Application is entirely inappropriate insofar as it includes the trademark issue. The *Trademarks Act* provides a complete code and procedure for opposing trademark applications such as the Trademark Application at issue. The Registrar of trademarks has exclusive jurisdiction to first decide whether a trademark may issue:

If a person desires to stop an application for registration, the proper avenue is to institute an opposition to the application by way of a statement of opposition. **It is not permissible for an opponent of a registration [to] commence a court proceeding to by-pass the statutory authority vested in the Registrar.** Only after the Registrar has made a decision as to the registrability of a trademark, can the Court review the matter.

Fox on the Law of Trademarks and Unfair Competition, 4th ed (Toronto: Carswell, 2002) at c. 6.7(a) [*Fox on Trademarks*].

36. The Registrar of Trademarks derives its exclusive authority to determine all matters concerning trademark oppositions from s. 38 of the *Trademarks Act*. That section reads, in part:

Statement of opposition

38 (1) Within two months after the advertisement of an application for the registration of a trademark, any person may, on payment of the prescribed fee, file a statement of opposition with the Registrar.

Grounds

(2) A statement of opposition may be based on any of the following grounds:

(a) that the application does not conform to the requirements of subsection 30(2), without taking into account if it meets the requirement in subsection 30(3);

(a.1) that the application was filed in bad faith;

(b) that the trademark is not registrable;

(c) that the applicant is not the person entitled to registration of the trademark;

(d) that the trademark is not distinctive;

(e) that, at the filing date of the application in Canada, determined without taking into account subsection 34(1), the applicant was not using and did not propose to use the trademark in Canada in association with the goods or services specified in the application; or

(f) that, at the filing date of the application in Canada, determined without taking into account subsection 34(1), the applicant was not entitled to use the trademark in Canada in association with those goods or services.

Content

(3) A statement of opposition shall set out

(a) the grounds of opposition in sufficient detail to enable the applicant to reply thereto; and

(b) the address of the opponent's principal office or place of business in Canada, if any, and if the opponent has no office or place of business in Canada, the address of his principal office or place of business abroad

and the name and address in Canada of a person or firm on whom service of any document in respect of the opposition may be made with the same effect as if it had been served on the opponent himself.

...

37. The relief the Applicant seeks in relation to the Trademark Application – a declaration of bad faith and an order for SMI to withdraw the application – amounts to a determination about *who* is entitled to apply for trademark protection of the EF Mark. In *Copperhead Brewing Co. v John Labatt Ltd./John Labatt Ltée*, [1995] FCJ No 668, 95 FTR 146, the Federal Court drew parallels between the *Trademarks Act* and the *Patent Act*. It found that both acts establish a comprehensive scheme whereby the only person empowered to make decisions concerning *who* is entitled to apply for protection under the *Trademarks Act* or the *Patent Act* is the person so designated under the respective acts, namely the Registrar of Trademarks or the Commissioner of Patents:

21 ...the Federal Court of Appeal held that the Court was without jurisdiction to decide ownership of an invention **and entitlement to apply for a patent with respect to ownership of an invention. Although the case dealt with the *Patent Act*, I am of the view that the Court of Appeal's comments at pages 73 and 74, regarding the Court's jurisdiction under section 20 of the *Federal Court Act*, apply equally to the case before me:**

...

... Under the *Patent Act*, the official who must first decide whether a patent may issue to an applicant is the Commissioner. The Act does not empower the Courts to give him directions on the decision he should reach; it is only if he is alleged to have made a wrong decision that, under the statute, the Courts may be seized of the matter. In my view, it would be contrary to the scheme of the *Patent Act* for the Courts to assume the power, in a case like the present one, to make the declaration sought.

[emphasis added]

38. *Rothmans, Benson & Hedges Inc. v Imperial Tobacco Ltd.*, 1997 CarswellNat 1171, [1997] FCJ No 840 [*Rothmans*] is instructive on this point. The facts of *Rothmans* are analogous to the present case in that the plaintiff sought identical relief to that sought by BTA, namely, “relief by way of an injunction to restrain the defendants...from proceeding to register the trademark as set out in [the trademark applications]” (at para 3). In *Rothmans*, the Court expressly rejected the plaintiff’s argument that the relief sought is “by orders *in personam*, not determinations *in rem* about rights to a registered trade-mark for which the Act provides” (at para 5). Ultimately, the Federal Court of Appeal unequivocally found that even it did not have the jurisdiction to order the defendant to withdraw its trademark application. The Court found it was without jurisdiction because the *Trademarks Act* provides a complete code of procedure such that only the Registrar

of Trademarks is entitled to determine, in the first instance, whether a trademark may issue or not:

6 In my opinion, the relief here questioned is within the principle of the decision of Mr. Justice Heald in *Friendly Ice Cream Corp. v. Friendly Ice Cream Shops Ltd.* (1972), 7 C.P.R. (2d) 35 (Fed. T.D.). In discussing declaratory relief there sought, that the defendant was not entitled to seek or to be granted registration of certain words as trade-marks, Heald J. wrote at p. 40:

I have no difficulty whatsoever in concluding that this portion of the statement of claim must be struck out. ... **the Trade Marks Act provides the way in which applications for trade marks may be opposed. ... [it] contains a complete code of procedure in such circumstances which has to be followed. I know of no authority which would allow the Court to abridge or by-pass these statutory provisions. This, in effect, is what the plaintiff is asking the Court to do...**

7 **I agree with the defendants that the person who must first decide whether a trade-mark may issue is the Registrar of Trade-marks. Only if the Registrar is alleged to have made a wrong decision may the Court be engaged to review the matter.** The defendants are entitled to apply for registration of trade-marks under the *Act*, and to have any application determined by the Registrar, after consideration of any opposition that may be advanced in accord with procedures under the *Act*. To restrain the defendants from seeking to register the trade-marks applied for...would deprive them of rights to apply for registration in accord with procedures established under the *Act*.

8 **The Court would not grant the relief sought...even if it had jurisdiction to do so, which in my view, it does not have. To grant the relief requested would by-pass the statutory method and the tribunal established by Parliament for determining applications for registration of trade-marks.**

39. The foregoing passage from *Rothmans* outlines the following key principles:

- (a) The *Trademarks Act* provides a complete code of procedure for opposing trademark applications that must be followed;
- (b) No authority exists that would allow any court to abridge or bypass the statutory scheme and tribunal established by Parliament; and
- (c) Only after the Registrar of Trademarks has issued a decision, and that decision is alleged to be wrong, may the Court be engaged to review the matter.

40. Moreover, as it concerns reviewing the decisions of the Registrar of Trademarks, such review remains the exclusive jurisdiction of the Federal Court. Sections 55, 56 and 57 of the *Trademarks Act* provide the following:

Jurisdiction of Federal Court

55 The Federal Court has jurisdiction to entertain any action or proceeding, other than a proceeding under section 51.01 [this section refers specifically to offences

for knowingly passing off goods], for the enforcement of any of the provisions of this Act or of any right or remedy conferred or defined by this Act.

Appeal

56 (1) An appeal lies to the Federal Court from any decision of the Registrar under this Act within two months from the date on which notice of the decision was dispatched by the Registrar or within such further time as the Court may allow, either before or after the expiration of the two months.

...

Exclusive jurisdiction of Federal Court

57 (1) The Federal Court has exclusive original jurisdiction, on the application of the Registrar or of any person interested, to order that any entry in the register be struck out or amended on the ground that at the date of the application the entry as it appears on the register does not accurately express or define the existing rights of the person appearing to be the registered owner of the trademark.

[emphasis added]

41. The Federal Court of Appeal in *Bacardi & Co v Havana Club Holding SA*, 2004 FCA 220, affirmed that s. 57 of the *Trademarks Act* grants the Federal Court sole and exclusive jurisdiction respecting trademark applications:

30 **This section [section 57] grants the Federal Court sole and exclusive jurisdiction to alter the register, to the exclusion of all other courts and tribunals.** As stated in Fox (Kelly Gill & R. Scott Jolliffe, eds., *Fox on Canadian Law of Trade-Marks and Unfair Competition*, 4th ed., looseleaf (Toronto: Carswell, 2003) at 2-28):

...the Federal Court has exclusive original jurisdiction in all cases of conflicting applications for registration of any trade-mark and in all cases where it is sought to have any entry in the register of trade-marks made, expunged, varied or rectified.

42. In light of the foregoing, it becomes apparent that the Applicant is attempting to circumvent a complete code that have been statutorily prescribed by the Parliament of Canada.

C. The Applicant's Requested Relief is not "appropriate in the circumstances"

43. BTA seeks an order "requiring SMI to withdraw or cancel forthwith its application for trademark protection of the 'Evolution Fitness' business name." The Applicant does not state expressly that it is seeking an injunction. However, it is injunctive relief that is being sought. As stated by Gotsky J. in *Westfair Foods Ltd. v Derby Holdings Ltd.* 1987 CanLII 4707 (SK QB) at paragraph 10: "A mandatory injunction is one which requires an act to be done."

44. There are clear defects in the Application and prayer for relief.

- (a) There is continued confusion in the Applicant's materials between the "Evolution Fitness" business name with the EF Mark. SMI has not applied for a business name, and FFI already has the "Evolution Fitness" business name.
 - (b) BTA incorrectly refers to the Application as the "Evolution Fitness" business name, absent the "Gyms". It is not clear why.
 - (c) Assuming that BTA intended to refer to the Trademark Application, it is entirely unclear on what basis the Application seeks, what is effectively, a mandatory injunction. No grounds or authority for such an order have been recited and it is not clear on what basis the relief is requested.
45. The Applicant seems to rely exclusively on s. 4.2 of the *BIA* as the exclusive authority that this Court can issue mandatory injunctions to compel a third party to extinguish rights conferred on it by other statutes. It is difficult to understand how the Applicant arrived at this conclusion, particularly given the extremely limited evidence.
46. There is no connection, legal or that has otherwise been evidenced, between the requested relief and any curative aspect of their proposed relief.
47. Granting the Applicant's proposed relief would not accomplish anything. FFI is entitled to oppose the Trademark Application if it believes that SMI is not entitled to obtain the registration. It is in that context that the parties' substantive rights to the Trademark can and ought to be determined.
48. Even if the Court grants the requested relief and there is no appeal, SMI will withdraw or cancel its application and, presumably, FFI will submit its own application. SMI is still then statutorily authorized to oppose FFI's trademark application. The end result will be the same, namely that the substantive rights of these parties' entitlement to the registered Trademark will be determined by the Trademark Opposition Board on delegated authority from the Registrar of Trademarks.
49. In addition, without in any way accepting the Applicant's submission, the declaratory relief sought by the Applicant would be sufficient remedy for any alleged conduct. Given the extremely limited evidence, there is no basis to conclude that the Trademark Application was made in bad faith. There is no logical connection between the evidence and compelling SMI to withdraw or cancel its application. Such an order, compelling a party to forego its legal rights, extends far beyond the bounds of what is reasonably or rationally connected to what the evidence indicates occurred. It goes beyond any curative measure into the realm of punitive without any evidentiary basis.
50. Based on the foregoing, the Applicant's proposed order for a mandatory injunction compelling SMI to withdraw or cancel its Trademark Application, is not "appropriate in the circumstances" and should be dismissed.

V. CONCLUSION

51. Based on the foregoing, it is submitted that the Applicants application should be dismissed with costs.

ALL OF WHICH is respectfully submitted at Regina, Saskatchewan, this 18th day of February, 2021.

MLT Aikins LLP

Per 

Tristan Culham, Counsel for the Respondent,

CONTACT INFORMATION AND ADDRESS FOR SERVICE

If prepared by a lawyer for the party:

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VI. LIST OF AUTHORITIES

LEGISLATION	TAB
<i>Bankruptcy and Insolvency Act</i> , RSC 1984, c B-3.	1.
<i>The Business Names Registration Act</i> , RSS 1978, c B-11.	2.
<i>Trademarks Act</i> , RSC 1985, c T-13.	3.
JURISPRUDENCE	
<i>Bacardi & Co v Havana Club Holding SA</i> , 2004 FCA 220.	4.
<i>Copperhead Brewing Co. v John Labatt Ltd./John Labatt Ltée</i> , [1995] FCJ No 668, 95 FTR 146.	5.
<i>Elrose, School Division No. 33 v Stoneouse</i> , 78 Sask R 278.	6.
<i>Rothmans, Benson & Hedges Inc. v Imperial Tobacco Ltd.</i> , 1997 CarswellNat 1171, [1997] FCJ No 840.	7.
<i>Westfair Foods Ltd. v Derby Holdings Ltd.</i> , 1987 CanLII 4707 (SK QB).	8.
SECONDARY SOURCES	
<i>Fox on the Law of Trademarks and Unfair Competition</i> , 4th ed (Toronto: Carswell, 2002).	9.



CANADA

CONSOLIDATION

CODIFICATION

Bankruptcy and Insolvency Act

Loi sur la faillite et l'insolvabilité

R.S.C., 1985, c. B-3

L.R.C. (1985), ch. B-3

Current to January 28, 2021

À jour au 28 janvier 2021

Last amended on November 1, 2019

Dernière modification le 1 novembre 2019

persons are, in the absence of evidence to the contrary, deemed not to deal with each other at arm's length.

R.S., 1985, c. B-3, s. 4; 2000, c. 12, s. 9; 2004, c. 25, s. 9(F); 2005, c. 47, s. 5; 2007, c. 36, s. 2.

Her Majesty

Binding on Her Majesty

4.1 This Act is binding on Her Majesty in right of Canada or a province.

1992, c. 27, s. 4.

Duty of Good Faith

Good faith

4.2 (1) Any interested person in any proceedings under this Act shall act in good faith with respect to those proceedings.

Good faith — powers of court

(2) If the court is satisfied that an interested person fails to act in good faith, on application by any interested person, the court may make any order that it considers appropriate in the circumstances.

2019, c. 29, s. 133.

PART I

Administrative Officials

Superintendent

Appointment

5 (1) The Governor in Council shall appoint a Superintendent of Bankruptcy to hold office during good behaviour for a term of not more than five years, but the Superintendent may be removed from office by the Governor in Council for cause. The Superintendent's term may be renewed for one or more further terms.

Salary

(1.1) The Superintendent shall be paid the salary that the Governor in Council may fix.

Extent of supervision

(2) The Superintendent shall supervise the administration of all estates and matters to which this Act applies.

Duties

(3) The Superintendent shall, without limiting the authority conferred by subsection (2),

de même, sauf preuve contraire, pour l'application des alinéas 95(1)b) ou 96(1)b).

L.R. (1985), ch. B-3, art. 4; 2000, ch. 12, art. 9; 2004, ch. 25, art. 9(F); 2005, ch. 47, art. 5; 2007, ch. 36, art. 2.

Sa Majesté

Obligation de Sa Majesté

4.1 La présente loi lie Sa Majesté du chef du Canada ou d'une province.

1992, ch. 27, art. 4.

Obligation d'agir de bonne foi

Bonne foi

4.2 (1) Tout intéressé est tenu d'agir de bonne foi dans le cadre d'une procédure intentée au titre de la présente loi.

Bonne foi — pouvoirs du tribunal

(2) S'il est convaincu que l'intéressé n'agit pas de bonne foi, le tribunal peut, à la demande de tout intéressé, rendre toute ordonnance qu'il estime indiquée.

2019, ch. 29, art. 133.

PARTIE I

Fonctionnaires administratifs

Surintendant

Nomination

5 (1) Le gouverneur en conseil nomme à titre inamovible un surintendant des faillites pour un mandat renouvelable d'au plus cinq ans, sous réserve de révocation motivée de la part du gouverneur en conseil.

Traitement

(1.1) Le surintendant des faillites reçoit le traitement que fixe le gouverneur en conseil.

Surveillance

(2) Le surintendant contrôle l'administration des actifs et des affaires régis par la présente loi.

Fonctions

(3) Le surintendant, sans que soit limitée l'autorité que lui confère le paragraphe (2) :

The Business Names Registration Act

being

[Chapter B-11](#) of *The Revised Statutes of Saskatchewan, 1978* (effective February 26, 1979) as amended by the *Statutes of Saskatchewan*, 1980-81, c.3 and 21; 1986-87-88, c.40; [2006, c.14](#); [2010, c.B-12](#); [2012, c.21](#); [2013, c.O-4.2](#), [2015, c.21](#); and [2018, c.42](#).

NOTE:

This consolidation is not official. Amendments have been incorporated for convenience of reference and the original statutes and regulations should be consulted for all purposes of interpretation and application of the law. In order to preserve the integrity of the original statutes and regulations, errors that may have appeared are reproduced in this consolidation.

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CHAPTER B-11

An Act respecting the Registration of Business Names

PART I

Short Title, Interpretation and Administration

Short title

- 1 This Act may be cited as *The Business Names Registration Act*.

INTERPRETATION

Interpretation

- 2 In this Act:

- (a) **“application”** means an application for registration of a business name and includes an application for renewal of registration;
- (b) **“business”** includes every trade, occupation, profession or venture carried on by one or more persons with the object of acquiring gain or profit;
- (c) **“business name”** means:
 - (i) in the case of a sole proprietor who is an individual, a name or style, including his own family name or surname or a name or style comprising his own family name or surname with the addition of some other word or phrase indicating a plurality of persons, under which he carries on or intends to carry on business;
 - (ii) in the case of a sole proprietor that is a corporation, a name or style other than its corporate name under which it carries on or intends to carry on business;
 - (ii.1) in the case of a sole proprietor that is an Indian band, a name or style, other than the name of the Indian band, under which the Indian band carries on or intends to carry on business;
 - (iii) in the case of two or more persons associated in a partnership, joint venture or syndicate, the name or style under which the partnership, joint venture or syndicate carries on or intends to carry on business;

and includes a declaration, in a form that complies with the requirements of this Act, of the use of a name or style;

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BUSINESS NAMES REGISTRATION

- (d) **“firm”** means:
 - (i) a person who is sole proprietor of a business carried on under a registered business name; or
 - (ii) the persons who are associated in a business carried on as a partnership, joint venture or syndicate under a registered business name; and includes:
 - (iii) a sole proprietor who has declared the sole proprietor’s intention to carry on business under a registered business name; and
 - (iv) the persons described in subclause (ii) who have declared their intention to carry on business under a registered business name;
- (d.1) **“Indian band”** means an Indian band within the meaning of the *Indian Act* (Canada) and includes the council of a band;
- (d.2) **“person”** includes an individual, a limited partnership, a body corporate or an Indian band;
- (e) **“registrar”** means the Director of Corporations;
- (f) **“registration”** means registration of a business name under this Act and includes renewal of registration, and the verb **“register”** has a corresponding meaning.

1976-77, c.11, s.2; R.S.S. 1978, c.B-11, s.2; 1980-81, c.3, s.3, 1986-87-88, c.40, s.3; 2006, c.14, s.4; 2010, c.B-12, s.15.

ADMINISTRATION

Administration

- 3** This Act shall be administered by the member of the Executive Council to whom the administration of this Act is assigned.

1976-77, c.11, s.3; R.S.S. 1978, c.B-11, s.3; 1980-81, c.21, s.7.

PART II Registration

Business name to be registered

4(1) Subject to subsection (3), every person who carries on business under a business name shall cause the business name to be registered under this Act.

(2) Every person who intends to carry on business under a business name may cause the business name to be registered under this Act.

(2.1) The business names registered pursuant to subsections (1) and (2) form a public registry of the people of Saskatchewan.

(2.2) All information in the registry is the property of the Government of Saskatchewan.

(3) Subsection (1) does not apply to:

(a) a person practising a profession if the right to practise the profession is regulated by the governing body of that profession pursuant to an Act; or

(b) a person or class of persons exempted from the provisions of this Act in the regulations.

(4) Notwithstanding clause (3)(a), subsection (1) applies to a business that is a profession regulated by the governing body of that profession if the firm name of that business does not include:

(a) the person's own family name or surname or the family name or surname of a person who is associated or was formerly associated with that person in that business; or

(b) a name or style comprising the person's own family name or surname, or the family name or surname of a person who is associated or was formerly associated with that person in that business, with the addition of some other word or phrase indicating a plurality of persons.

1976-77, c.11, s.4; R.S.S. 1978, c.B-11, s.4; 1986-87-88, c.40, s.4; 2006, c.14, s.6; 2013, c.O-4.2, s.39.

5 Repealed. 2006, c.14, s.7.

Application for registration of business name

6(1) Every application for registration of a business name must be made to the registrar by:

(a) in the case of a sole proprietorship, the sole proprietor; or

(b) in the case of two or more persons associated in a partnership, joint venture or syndicate, those persons.

(2) An application shall consist of a declaration in a form prescribed in the regulations or, in the case of a limited partnership, in a form containing the information mentioned in section 16.

(3) Notwithstanding subsection (2), the registrar may accept an application in any form that, in his opinion, complies substantially with the requirements of this Act.

1976-77, c.11, s.6; R.S.S. 1978, c.B-11, s.6; 2006, c.14, s.8.

Registration

7 Subject to sections 8 and 8.1, the registrar shall, upon receipt of an application duly completed, register the business name.

1976-77, c.11, s.7; R.S.S. 1978, c.B-11, s.7; 1986-87-88, c.40, s.5; 2013, c.O-4.2, 40.

Business name

8(1) No business name shall be registered if it:

(a) in the opinion of the registrar:

(i) is the same as or similar to the name of any other corporation, or to the name of any association, partnership or firm, if the use of that name would be likely to confuse or mislead, unless the corporation, association, partnership or firm consents in writing to the use of the name in whole or in part and, if required by the registrar:

(A) in the case of a corporation, undertakes to dissolve or change its name to a dissimilar name within six months after the filing of the articles by which the name is acquired;

(B) in the case of an association, partnership or firm, undertakes to cease to carry on its business or activities, or to change its name to a dissimilar name, within six months after the filing of the articles by which the name is acquired;

(ii) suggests or implies a connection with the Crown or the Government of Canada or of any province or territory of Canada or any department, branch, bureau, service, agency or activity of any such government or municipality, unless the concerned authority consents in writing to the proposed name;

(iii) suggests or implies a connection with a political party or a leader of a political party; or

(iv) suggests or implies a connection with a university or a professional association recognized by the laws of Canada or of a province of Canada, unless the university or professional association concerned consents in writing to the use of the proposed name;

Signature

9.2 Where this Act requires or authorizes the registrar to issue a certificate, certify a fact or place his signature on a document for the purposes of this Act, the registrar's signature may be printed or otherwise mechanically produced on the certificate, certification or document.

1986-87-88, c.40, s.9.

Powers of attorney - non-Saskatchewan applicants

9.3(1) In this section:

- (a) **“applicant”** means a person who or that:
 - (i) applies pursuant to section 6 to register a business name; and
 - (ii) either:
 - (A) in the case of a sole proprietorship, is not a resident of Saskatchewan; or
 - (B) in the case of a partnership, joint venture or syndicate, has no partner or member who is a resident of Saskatchewan;
- (b) **“resident of Saskatchewan”** means:
 - (i) in the case of a corporation, a corporation that is incorporated or continued pursuant to an Act or is registered pursuant to an Act to carry on business in Saskatchewan;
 - (ii) in the case of an Indian band, an Indian band that has reserve land in Saskatchewan;
 - (iii) in the case of an individual, an individual who is a resident of Saskatchewan as determined in accordance with the regulations.

(2) Every applicant must, before registration, file with the registrar a duly executed power of attorney in the form prescribed in the regulations appointing the person named in the power of attorney to be the attorney and representative in Saskatchewan of the applicant for the purpose of receiving all lawful notices.

2006, c.16, s.10.

Appeal to judge of Court of Queen's Bench

10(1) A person who is dissatisfied with a decision of the registrar under this Act may, within one year from the date of the decision, appeal to a judge of the Court of Queen's Bench who may, upon hearing the appeal, make any one or more of the following orders:

- (a) an order dismissing the appeal;
- (b) an order allowing the appeal;
- (c) an order allowing the appeal subject to terms and conditions;

c. B-11**BUSINESS NAMES REGISTRATION**

- (d) an order varying the decision appealed against;
 - (e) an order referring the matter back to the registrar for further consideration and decision;
 - (f) an order awarding costs of the appeal;
 - (g) such other order as to him seems just.
- (2) The appeal shall be by notice of motion and a copy thereof shall be served on the registrar and any other person or firm that is interested in the matter not less than ten days before the day on which the motion is returnable.
- (3) There shall be no further appeal.

1976-77, c.11, s.10; R.S.S. 1978, c.B-11, s.10;
1986-87-88, c.40, s.10.

When registration may be cancelled

- 11(1) If a firm ceases to carry on business and gives notice of that fact in writing to the registrar, the registrar may, on receipt of the written notice, cancel the registration.
- (2) The registrar may cancel the registration of a corporation in the following circumstances:
- (a) in the case of a corporation incorporated or continued pursuant to *The Business Corporations Act*, if a certificate of dissolution has been issued to the corporation in accordance with that Act or the name of the corporation has been struck off the register kept pursuant to that Act;
 - (b) in the case of a corporation other than one described in clause (a), if the registrar has received notice that the corporation is dissolved or the name of the corporation has been struck off the register kept pursuant to *The Business Corporations Act*.
- (3) The registrar may send to a firm at its last known business address a letter enquiring whether or not the firm is carrying on business under its registered name if the registrar has reasonable cause to believe that the firm:
- (a) has ceased to carry on business; or
 - (b) is not carrying on business under that name.
- (4) The registrar may cancel a registration of a firm mentioned in subsection (3) if, within one month after the date the letter mentioned in that subsection is received, the registrar:
- (a) does not receive a reply; or
 - (b) receives a reply stating that the firm:
 - (i) is not carrying on business; or
 - (ii) is not carrying on business under that name.
- (5) Every firm shall notify the registrar of any change in its business address.

2006, c.14, s.11.



CANADA

CONSOLIDATION

CODIFICATION

Trademarks Act

Loi sur les marques de commerce

R.S.C., 1985, c. T-13

L.R.C. (1985), ch. T-13

Current to January 28, 2021

À jour au 28 janvier 2021

Last amended on July 1, 2020

Dernière modification le 1 juillet 2020

(b) a certification mark; (*marque de commerce*)

trade name means the name under which any business is carried on, whether or not it is the name of a corporation, a partnership or an individual; (*nom commercial*)

use, in relation to a trademark, means any use that by section 4 is deemed to be a use in association with goods or services; (*emploi* ou *usage*)

wares [Repealed, 2014, c. 32, s. 7]

WTO Agreement has the meaning given to the word *Agreement* by subsection 2(1) of the *World Trade Organization Agreement Implementation Act*; (*Accord sur l'OMC*)

WTO Member means a Member of the World Trade Organization established by Article I of the WTO Agreement. (*membre de l'OMC*)

R.S., 1985, c. T-13, s. 2; 1993, c. 15, s. 57; 1994, c. 47, s. 190; 2014, c. 20, ss. 319, 361(E), 362(E), 367, 369, c. 32, ss. 7, 53; 2017, c. 6, s. 60.

Reference to person

2.1 Unless the context requires otherwise, a reference to **person** in this Act, in relation to a trademark, includes two or more persons who, by agreement, do not have the right to use the trademark in Canada except on behalf of both or all of them.

2014, c. 20, s. 320.

When deemed to be adopted

3 A trademark is deemed to have been adopted by a person when that person or his predecessor in title commenced to use it in Canada or to make it known in Canada or, if that person or his predecessor had not previously so used it or made it known, when that person or his predecessor filed an application for its registration in Canada.

R.S., 1985, c. T-13, s. 3; 2014, c. 20, s. 361(E).

When deemed to be used

4 (1) A trademark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association

prescrit Prescrit par les règlements ou sous leur régime. (*prescribed*)

propriétaire Relativement à une marque de certification, la personne qui a établi la norme définie. (*owner*)

registraire Le titulaire du poste de registraire des marques de commerce institué par le paragraphe 63(1). (*Registrar*)

registre Le registre tenu selon l'article 26. (*register*)

représentant pour signification [Abrogée, 2014, ch. 20, art. 319]

signe Vise notamment les mots, les noms de personne, les dessins, les lettres, les chiffres, les couleurs, les éléments figuratifs, les formes tridimensionnelles, les hologrammes, les images en mouvement, les façons d'emballer les produits, les sons, les odeurs, les goûts et les textures ainsi que la position de tout signe. (*sign*)

signe distinctif [Abrogée, 2014, ch. 20, art. 319]

usager inscrit [Abrogée, 1993, ch. 15, art. 57]

L.R. (1985), ch. T-13, art. 2; 1993, ch. 15, art. 57; 1994, c. 47, art. 190; 2014, ch. 20, art. 319, 361(A), 362(A), 367 et 369, ch. 32, art. 7 et 53; 2017, ch. 6, art. 60.

Mention de personne

2.1 Sauf indication contraire du contexte, la mention de **personne** dans la présente loi vise, relativement à une marque de commerce, deux ou plusieurs personnes ayant conclu un accord leur interdisant, si ce n'est en leurs deux noms ou au nom de l'ensemble de ces personnes, selon le cas, d'employer la marque de commerce au Canada.

2014, ch. 20, art. 320.

Quand une marque de commerce est réputée adoptée

3 Une marque de commerce est réputée avoir été adoptée par une personne, lorsque cette personne ou son prédécesseur en titre a commencé à l'employer au Canada ou à l'y faire connaître, ou, si la personne ou le prédécesseur en question ne l'avait pas antérieurement ainsi employée ou fait connaître, lorsque l'un d'eux a produit une demande d'enregistrement de cette marque au Canada.

L.R. (1985), ch. T-13, art. 3; 2014, ch. 20, art. 361(A).

Quand une marque de commerce est réputée employée

4 (1) Une marque de commerce est réputée employée en liaison avec des produits si, lors du transfert de la propriété ou de la possession de ces produits, dans la pratique normale du commerce, elle est apposée sur les produits mêmes ou sur les emballages dans lesquels ces produits sont distribués, ou si elle est, de toute autre

is then given to the person to whom the property or possession is transferred.

Idem

(2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

Use by export

(3) A trademark that is marked in Canada on goods or on the packages in which they are contained is, when the goods are exported from Canada, deemed to be used in Canada in association with those goods.

R.S., 1985, c. T-13, s. 4; 2014, c. 20, s. 361(E), c. 32, ss. 53, 54(F).

When deemed to be made known

5 A trademark is deemed to be made known in Canada by a person only if it is used by that person in a country of the Union, other than Canada, in association with goods or services, and

(a) the goods are distributed in association with it in Canada, or

(b) the goods or services are advertised in association with it in

(i) any printed publication circulated in Canada in the ordinary course of commerce among potential dealers in or users of the goods or services, or

(ii) radio broadcasts ordinarily received in Canada by potential dealers in or users of the goods or services,

and it has become well known in Canada by reason of the distribution or advertising.

R.S., 1985, c. T-13, s. 5; 2014, c. 20, s. 361(E), c. 32, s. 53.

When mark or name confusing

6 (1) For the purposes of this Act, a trademark or trade name is confusing with another trademark or trade name if the use of the first mentioned trademark or trade name would cause confusion with the last mentioned trademark or trade name in the manner and circumstances described in this section.

Confusion — trademark with other trademark

(2) The use of a trademark causes confusion with another trademark if the use of both trademarks in the same

manière, liée aux produits à tel point qu'avis de liaison est alors donné à la personne à qui la propriété ou possession est transférée.

Idem

(2) Une marque de commerce est réputée employée en liaison avec des services si elle est employée ou montrée dans l'exécution ou l'annonce de ces services.

Emploi pour exportation

(3) Une marque de commerce mise au Canada sur des produits ou sur les emballages qui les contiennent est réputée, quand ces produits sont exportés du Canada, être employée dans ce pays en liaison avec ces produits.

L.R. (1985), ch. T-13, art. 4; 2014, ch. 20, art. 361(A), ch. 32, art. 53 et 54(F).

Quand une marque de commerce est réputée révélée

5 Une personne est réputée faire connaître une marque de commerce au Canada seulement si elle l'emploie dans un pays de l'Union, autre que le Canada, en liaison avec des produits ou services, si, selon le cas :

a) ces produits sont distribués en liaison avec cette marque au Canada;

b) ces produits ou services sont annoncés en liaison avec cette marque :

(i) soit dans toute publication imprimée et mise en circulation au Canada dans la pratique ordinaire du commerce parmi les marchands ou usagers éventuels de ces produits ou services,

(ii) soit dans des émissions de radio ordinairement captées au Canada par des marchands ou usagers éventuels de ces produits ou services,

et si la marque est bien connue au Canada par suite de cette distribution ou annonce.

L.R. (1985), ch. T-13, art. 5; 2014, ch. 20, art. 361(A), ch. 32, art. 53.

Quand une marque ou un nom crée de la confusion

6 (1) Pour l'application de la présente loi, une marque de commerce ou un nom commercial crée de la confusion avec une autre marque de commerce ou un autre nom commercial si l'emploi de la marque de commerce ou du nom commercial en premier lieu mentionnés cause de la confusion avec la marque de commerce ou le nom commercial en dernier lieu mentionnés, de la manière et dans les circonstances décrites au présent article.

Marque de commerce créant de la confusion avec une autre

(2) L'emploi d'une marque de commerce crée de la confusion avec une autre marque de commerce lorsque

the decision is made or, if an appeal is taken, on which final judgment in the appeal upholding the decision is given.

2014, c. 32, s. 28; 2014, c. 20, s. 361(E).

Applications for Registration of Trademarks

Requirements for application

30 (1) A person may file with the Registrar an application for the registration of a trademark in respect of goods or services if they are using or propose to use, and are entitled to use, the trademark in Canada in association with those goods or services.

Contents of application

(2) The application shall contain

(a) a statement in ordinary commercial terms of the goods or services in association with which the trademark is used or proposed to be used;

(b) in the case of a certification mark, particulars of the defined standard that the use of the certification mark is intended to indicate and a statement that the applicant is not engaged in the manufacture, sale, leasing or hiring of goods or the performance of services such as those in association with which the certification mark is used or proposed to be used;

(c) a representation or description, or both, that permits the trademark to be clearly defined and that complies with any prescribed requirements; and

(d) any prescribed information or statement.

Nice Classification

(3) The goods or services referred to in paragraph (2)(a) are to be grouped according to the classes of the Nice Classification, each group being preceded by the number of the class of the Nice Classification to which that group of goods or services belongs and presented in the order of the classes of the Nice Classification.

Disagreement

(4) Any question arising as to the class within which any goods or services are to be grouped shall be determined

Demandes d'enregistrement de marques de commerce

Demande

30 (1) Une personne peut produire auprès du registraire une demande en vue de l'enregistrement d'une marque de commerce à l'égard de produits ou services si elle emploie ou projette d'employer — et a droit d'employer — la marque de commerce au Canada en liaison avec ces produits ou services.

Contenu de la demande

(2) La demande contient :

a) un état, dressé dans les termes ordinaires du commerce, des produits ou services en liaison avec lesquels la marque de commerce est employée ou en liaison avec lesquels on projette de l'employer;

b) dans le cas d'une marque de certification, les détails de la norme définie que son emploi est destiné à indiquer et une déclaration portant que le requérant ne se livre pas à la fabrication, à la vente, à la location à bail ou au louage de produits ni à l'exécution de services, tels que ceux en liaison avec lesquels elle est employée ou en liaison avec lesquels on projette de l'employer;

c) une représentation, une description ou une combinaison des deux qui permettent de définir clairement la marque de commerce et qui sont conformes à toute exigence prescrite;

d) toute déclaration ou tout renseignement prescrits.

Classification de Nice

(3) Les produits ou services visés à l'alinéa (2)a) sont groupés selon les classes de la classification de Nice, chaque groupe étant précédé du numéro de la classe de cette classification à laquelle il appartient et étant présenté dans l'ordre des classes de cette classification.

Désaccord

(4) Toute question soulevée à propos de la classe dans laquelle un produit ou un service doit être groupé est tranchée par le registraire, dont la décision est sans appel.

L.R. (1985), ch. T-13, art. 30; 1993, ch. 15, art. 64; 1994, ch. 47, art. 198; 2014, ch. 20, art. 339, ch. 32, art. 53.

by the Registrar, whose determination is not subject to appeal.

R.S., 1985, c. T-13, s. 30; 1993, c. 15, s. 64; 1994, c. 47, s. 198; 2014, c. 20, s. 339, c. 32, s. 53.

Standard characters

31 An applicant who seeks to register a trademark that consists only of letters, numerals, punctuation marks, diacritics or typographical symbols, or of any combination of them, without limiting the trademark to any particular font, size or colour shall

- (a) file a representation under paragraph 30(2)(c) that consists only of characters for which the Registrar has adopted standard characters;
- (b) include in their application a statement to the effect that they wish the trademark to be registered in standard characters; and
- (c) comply with any prescribed requirements.

R.S., 1985, c. T-13, s. 31; 2014, c. 20, s. 339.

Further evidence in certain cases

32 (1) An applicant shall furnish the Registrar with any evidence that the Registrar may require establishing that the trademark is distinctive at the filing date of the application for its registration, determined without taking into account subsection 34(1), if any of the following apply:

- (a) the applicant claims that their trademark is registrable under subsection 12(3);
- (b) the Registrar's preliminary view is that the trademark is not inherently distinctive;
- (c) the trademark consists exclusively of a single colour or of a combination of colours without delineated contours;
- (d) the trademark consists exclusively or primarily of one or more of the following signs:
 - (i) the three-dimensional shape of any of the goods specified in the application, or of an integral part or the packaging of any of those goods,
 - (ii) a mode of packaging goods,
 - (iii) a sound,
 - (iv) a scent,
 - (v) a taste,

Caractères standard

31 Le requérant, s'il veut enregistrer une marque de commerce qui consiste uniquement en des lettres, des chiffres, des signes de ponctuation, diacritiques ou typographiques ou en une combinaison de ces choses et qui n'est pas limitée à une police, une taille ou une couleur précises, est tenu :

- a) de fournir, en application de l'alinéa 30(2)c), une représentation qui consiste uniquement en des caractères pour lesquels le registraire a adopté des caractères standard;
- b) de fournir, dans sa demande, une déclaration portant qu'il souhaite que la marque de commerce soit enregistrée en caractères standard;
- c) de se conformer à toute exigence prescrite.

L.R. (1985), ch. T-13, art. 31; 2014, ch. 20, art. 339.

Autres preuves dans certains cas

32 (1) Le requérant fournit au registraire toute preuve que celui-ci peut exiger établissant que la marque de commerce est distinctive à la date de production de la demande d'enregistrement, déterminée compte non tenu du paragraphe 34(1), si selon le cas :

- a) le requérant prétend qu'elle est enregistrable en vertu du paragraphe 12(3);
- b) elle n'a pas, selon l'avis préliminaire du registraire, de caractère distinctif inhérent;
- c) elle consiste exclusivement en une seule couleur ou en une combinaison de couleurs sans contour délimité;
- d) elle consiste exclusivement ou principalement en l'un ou plusieurs des signes suivants :
 - (i) la forme tridimensionnelle de tout produit spécifié dans la demande ou d'une partie essentielle ou de l'emballage d'un tel produit,
 - (ii) la façon d'emballer un produit,
 - (iii) un son,
 - (iv) une odeur,
 - (v) un goût,

Notice to applicant

(2) The Registrar shall not refuse any application without first notifying the applicant of his objections thereto and his reasons for those objections, and giving the applicant adequate opportunity to answer those objections.

Doubtful cases

(3) Where the Registrar, by reason of a registered trademark, is in doubt whether the trademark claimed in the application is registrable, he shall, by registered letter, notify the owner of the registered trademark of the advertisement of the application.

Withdrawal of advertisement

(4) If, after the application has been advertised but before the trademark is registered, the Registrar is satisfied that the application should not have been advertised or was incorrectly advertised and the Registrar considers it reasonable to do so, the Registrar may withdraw the advertisement. If the Registrar withdraws the advertisement, the application is deemed never to have been advertised.

R.S., 1985, c. T-13, s. 37; 2014, c. 20, ss. 342, 361(E).

Statement of opposition

38 (1) Within two months after the advertisement of an application for the registration of a trademark, any person may, on payment of the prescribed fee, file a statement of opposition with the Registrar.

Grounds

(2) A statement of opposition may be based on any of the following grounds:

(a) that the application does not conform to the requirements of subsection 30(2), without taking into account if it meets the requirement in subsection 30(3);

(a.1) that the application was filed in bad faith;

(b) that the trademark is not registrable;

(c) that the applicant is not the person entitled to registration of the trademark;

(d) that the trademark is not distinctive;

(e) that, at the filing date of the application in Canada, determined without taking into account subsection 34(1), the applicant was not using and did not propose

Lorsque le registraire n'est pas ainsi convaincu, il fait annoncer la demande de la manière prescrite.

Avis au requérant

(2) Le registraire ne peut rejeter une demande sans, au préalable, avoir fait connaître au requérant ses objections, avec les motifs pertinents, et lui avoir donné une occasion convenable d'y répondre.

Cas douteux

(3) Lorsque, en raison d'une marque de commerce déposée, le registraire a des doutes sur la question de savoir si la marque de commerce indiquée dans la demande est enregistrable, il notifie, par courrier recommandé, l'annonce de la demande au propriétaire de la marque de commerce déposée.

Retrait de l'annonce

(4) Si, après l'annonce de la demande, mais avant l'enregistrement de la marque de commerce, il est convaincu que la demande n'aurait pas dû être annoncée ou l'a été incorrectement, le registraire peut, s'il l'estime raisonnable, retirer l'annonce; le cas échéant la demande est réputée ne jamais avoir été annoncée.

L.R. (1985), ch. T-13, art. 37; 2014, ch. 20, art. 342 et 361(A).

Déclaration d'opposition

38 (1) Toute personne peut, dans le délai de deux mois à compter de l'annonce de la demande, et sur paiement du droit prescrit, produire au bureau du registraire une déclaration d'opposition.

Motifs

(2) Cette opposition peut être fondée sur l'un des motifs suivants :

a) la demande ne satisfait pas aux exigences du paragraphe 30(2), compte non tenu de la conformité au paragraphe 30(3) de l'état que contient celle-ci;

a.1) la demande a été produite de mauvaise foi;

b) la marque de commerce n'est pas enregistrable;

c) le requérant n'est pas la personne ayant droit à l'enregistrement;

d) la marque de commerce n'est pas distinctive;

e) à la date de production de la demande au Canada, déterminée compte non tenu du paragraphe 34(1), le requérant n'employait pas ni ne projetait d'employer

to use the trademark in Canada in association with the goods or services specified in the application; or

(f) that, at the filing date of the application in Canada, determined without taking into account subsection 34(1), the applicant was not entitled to use the trademark in Canada in association with those goods or services.

Content

(3) A statement of opposition shall set out

(a) the grounds of opposition in sufficient detail to enable the applicant to reply thereto; and

(b) the address of the opponent's principal office or place of business in Canada, if any, and if the opponent has no office or place of business in Canada, the address of his principal office or place of business abroad and the name and address in Canada of a person or firm on whom service of any document in respect of the opposition may be made with the same effect as if it had been served on the opponent himself.

Frivolous opposition

(4) If the Registrar considers that the opposition does not raise a substantial issue for decision, he shall reject it and shall give notice of his decision to the opponent.

Substantial issue

(5) If the Registrar considers that the opposition raises a substantial issue for decision, he shall forward a copy of the statement of opposition to the applicant.

Power to strike

(6) At the applicant's request, the Registrar may — at any time before the day on which the applicant files a counter statement — strike all or part of the statement of opposition if the statement or part of it

(a) is not based on any of the grounds set out in subsection (2); or

(b) does not set out a ground of opposition in sufficient detail to enable the applicant to reply to it.

Counter statement

(7) The applicant shall file a counter statement with the Registrar and serve a copy on the opponent in the prescribed manner and within the prescribed time after a copy of the statement of opposition has been forwarded to the applicant. The counter statement need only state that the applicant intends to respond to the opposition.

la marque de commerce au Canada en liaison avec les produits ou services spécifiés dans la demande;

f) à la date de production de la demande au Canada, déterminée compte non tenu du paragraphe 34(1), le requérant n'avait pas le droit d'employer la marque de commerce au Canada en liaison avec ces produits ou services.

Teneur

(3) La déclaration d'opposition indique :

a) les motifs de l'opposition, avec détails suffisants pour permettre au requérant d'y répondre;

b) l'adresse du principal bureau ou siège d'affaires de l'opposant au Canada, le cas échéant, et, si l'opposant n'a ni bureau ni siège d'affaires au Canada, l'adresse de son principal bureau ou siège d'affaires à l'étranger et les nom et adresse, au Canada, d'une personne ou firme à qui tout document concernant l'opposition peut être signifié avec le même effet que s'il était signifié à l'opposant lui-même.

Opposition futile

(4) Si le registraire estime que l'opposition ne soulève pas une question sérieuse pour décision, il la rejette et donne avis de sa décision à l'opposant.

Objection sérieuse

(5) Si le registraire est d'avis que l'opposition soulève une question sérieuse pour décision, il fait parvenir une copie de la déclaration d'opposition au requérant.

Pouvoir du registraire

(6) Avant le jour où le requérant produit la contre-déclaration, le registraire peut, à la demande de celui-ci, radier tout ou partie de la déclaration d'opposition dans l'un ou l'autre des cas suivants :

a) la déclaration ou la partie en cause de celle-ci n'est pas fondée sur l'un des motifs énoncés au paragraphe (2);

b) la déclaration ou la partie en cause de celle-ci ne contient pas assez de détails au sujet de l'un ou l'autre des motifs pour permettre au requérant d'y répondre.

Contre-déclaration

(7) Le requérant produit auprès du registraire une contre-déclaration et en signifie, dans le délai prescrit après qu'une déclaration d'opposition lui a été envoyée, copie à l'opposant de la manière prescrite. La contre-déclaration peut se limiter à énoncer l'intention du requérant de répondre à l'opposition.

(7.1) [Repealed, 2014, c. 20, s. 343]

(7.2) [Repealed, 2014, c. 20, s. 343]

Evidence and hearing

(8) Both the opponent and the applicant shall be given an opportunity, in the prescribed manner and within the prescribed time, to submit evidence and to make representations to the Registrar unless

(a) the opposition is withdrawn or deemed under subsection (10) to have been withdrawn; or

(b) the application is abandoned or deemed under subsection (11) to have been abandoned.

Service

(9) The opponent and the applicant shall, in the prescribed manner and within the prescribed time, serve on each other any evidence and written representations that they submit to the Registrar.

Deemed withdrawal of opposition

(10) The opposition is deemed to have been withdrawn if, in the prescribed circumstances, the opponent does not submit and serve either evidence under subsection (8) or a statement that the opponent does not wish to submit evidence.

Deemed abandonment of application

(11) The application is deemed to have been abandoned if the applicant does not file and serve a counter statement within the time referred to in subsection (7) or if, in the prescribed circumstances, the applicant does not submit and serve either evidence under subsection (8) or a statement that the applicant does not wish to submit evidence.

Decision

(12) After considering the evidence and representations of the opponent and the applicant, the Registrar shall refuse the application, reject the opposition, or refuse the application with respect to one or more of the goods or services specified in it and reject the opposition with respect to the others. He or she shall notify the parties of the decision and the reasons for it.

R.S., 1985, c. T-13, s. 38; 1992, c. 1, s. 134; 1993, c. 15, s. 66; 2014, c. 20, ss. 343, 361(E); 2018, c. 27, ss. 220, 233.

Divisional application

39 (1) After having filed an application for the registration of a trademark, an applicant may limit the original application to one or more of the goods or services that were within its scope and file a divisional application for

(7.1) [Abrogé, 2014, ch. 20, art. 343]

(7.2) [Abrogé, 2014, ch. 20, art. 343]

Preuve et audition

(8) Il est fourni, selon les modalités prescrites, à l'opposant et au requérant l'occasion de soumettre la preuve sur laquelle ils s'appuient et de se faire entendre par le registraire, sauf dans les cas suivants :

a) l'opposition est retirée ou, au titre du paragraphe (10), réputée l'être;

b) la demande est abandonnée ou, au titre du paragraphe (11), réputée l'être.

Signification

(9) L'opposant et le requérant signifient à l'autre partie, selon les modalités prescrites, la preuve et les observations écrites qu'ils ont présentées au registraire.

Retrait de l'opposition

(10) Si, dans les circonstances prescrites, l'opposant omet de soumettre et de signifier la preuve visée au paragraphe (8) ou une déclaration énonçant son désir de ne pas soumettre de preuve, l'opposition est réputée retirée.

Abandon de la demande

(11) Si le requérant omet de produire et de signifier une contre-déclaration dans le délai visé au paragraphe (7) ou si, dans les circonstances prescrites, il omet de soumettre et de signifier la preuve visée au paragraphe (8) ou une déclaration énonçant son désir de ne pas soumettre de preuve, la demande est réputée abandonnée.

Décision

(12) Après avoir examiné la preuve et les observations des parties, le registraire rejette la demande, rejette l'opposition ou rejette la demande à l'égard de l'un ou plusieurs des produits ou services spécifiés dans celle-ci et rejette l'opposition à l'égard des autres. Il notifie aux parties sa décision motivée.

L.R. (1985), ch. T-13, art. 38; 1992, ch. 1, art. 134; 1993, ch. 15, art. 66; 2014, ch. 20, art. 343 et 361(A); 2018, ch. 27, art. 220 et 233.

Demande divisionnaire

39 (1) Après avoir produit la demande d'enregistrement d'une marque de commerce, le requérant peut restreindre cette demande originale à l'un ou plusieurs des produits ou services visés par celle-ci et produire une demande divisionnaire pour l'enregistrement de la même

the registration of the same trademark in association with any other goods or services that were

(a) within the scope of the original application on its filing date, determined without taking into account subsection 34(1); and

(b) within the scope of the original application on the day on which the divisional application is filed, if the divisional application is filed on or after the day on which the original application is advertised under subsection 37(1).

Identification

(2) A divisional application shall indicate that it is a divisional application and shall, in the prescribed manner, identify the corresponding original application.

Separate application

(3) A divisional application is a separate application, including with respect to the payment of any fees.

Filing date

(4) A divisional application's filing date is deemed to be the original application's filing date.

Division of divisional application

(5) A divisional application may itself be divided under subsection (1), in which case this section applies as if that divisional application were an original application.

R.S., 1985, c. T-13, s. 39; 1993, c. 15, s. 67; 2014, c. 20, s. 344; 2018, c. 27, s. 234.

Registration of Trademarks

Registration of trademarks

40 When an application for the registration of a trademark either has not been opposed and the time for the filing of a statement of opposition has expired, or has been opposed and the opposition has been decided in favour of the applicant, the Registrar shall register the trademark in the name of the applicant and issue a certificate of its registration or, if an appeal is taken, shall act in accordance with the final judgment given in the appeal.

R.S., 1985, c. T-13, s. 40; 1993, c. 15, s. 68, c. 44, s. 231; 1999, c. 31, s. 210(F); 2014, c. 20, s. 345, c. 32, ss. 37(F), 53(E).

marque de commerce en liaison avec d'autres produits ou services qui étaient visés par la demande originale à la date de sa production, déterminée compte non tenu du paragraphe 34(1), et, si la demande divisionnaire est produite le jour où la demande originale est annoncée en application du paragraphe 37(1) ou après ce jour, visés par celle-ci le jour où la demande divisionnaire est produite.

Précisions

(2) La demande divisionnaire précise qu'il s'agit d'une demande divisionnaire et indique, de la façon prescrite, la demande originale correspondante.

Demande distincte

(3) La demande divisionnaire constitue une demande distincte, notamment pour le paiement des droits.

Date de la demande divisionnaire

(4) La date de production de la demande divisionnaire est réputée être celle de la demande originale.

Division d'une demande divisionnaire

(5) La demande divisionnaire peut elle-même être divisée en vertu du paragraphe (1), auquel cas, le présent article s'applique au même titre que si cette demande était la demande originale.

L.R. (1985), ch. T-13, art. 39; 1993, ch. 15, art. 67; 2014, ch. 20, art. 344; 2018, ch. 27, art. 234.

Enregistrement des marques de commerce

Enregistrement des marques de commerce

40 Lorsqu'une demande d'enregistrement d'une marque de commerce n'a pas fait l'objet d'une opposition et que le délai prévu pour la production d'une déclaration d'opposition est expiré, ou lorsqu'il y a eu opposition et que celle-ci a été décidée en faveur du requérant, le registraire enregistre la marque de commerce au nom du requérant et délivre un certificat de son enregistrement ou, en cas d'appel, se conforme au jugement définitif rendu en l'espèce.

L.R. (1985), ch. T-13, art. 40; 1993, ch. 15, art. 68, ch. 44, art. 231; 1999, ch. 31, art. 210(F); 2014, ch. 20, art. 345, ch. 32, art. 37(F) et 53(A).

deceiving the public and inducing them to believe that the goods were made with the consent of the owner.

Removal of trademark

(2) Subsection (1) also applies with respect to goods for which the only alteration is the removal of the trademark.

1993, c. 44, s. 234; 2014, c. 20, s. 361(E), c. 32, s. 45.

Evidence

54 (1) Evidence of any document in the official custody of the Registrar or of any extract therefrom may be given by the production of a copy thereof purporting to be certified to be true by the Registrar.

Idem

(2) A copy of any entry in the register purporting to be certified to be true by the Registrar is evidence of the facts set out therein.

Idem

(3) A copy of the record of the registration of a trademark purporting to be certified to be true by the Registrar is evidence of the facts set out therein and that the person named therein as owner is the registered owner of the trademark for the purposes and within the territorial area therein defined.

Idem

(4) A copy of any entry made or documents filed under the authority of any Act in force before July 1, 1954 relating to trademarks, certified under the authority of that Act, is admissible in evidence and has the same probative force as a copy certified by the Registrar under this Act as provided in this section.

R.S., 1985, c. T-13, s. 54; 2014, c. 20, s. 361(E).

Jurisdiction of Federal Court

55 The Federal Court has jurisdiction to entertain any action or proceeding, other than a proceeding under section 51.01, for the enforcement of any of the provisions of this Act or of any right or remedy conferred or defined by this Act.

R.S., 1985, c. T-13, s. 55; 2014, c. 32, s. 46.

Appeal

56 (1) An appeal lies to the Federal Court from any decision of the Registrar under this Act within two months from the date on which notice of the decision was dispatched by the Registrar or within such further time as the Court may allow, either before or after the expiration of the two months.

croire que les produits ont été fabriqués avec le consentement du propriétaire.

Retrait de la marque de commerce

(2) Le paragraphe (1) s'applique également à l'égard des produits modifiés uniquement de façon à ce qu'ils ne portent plus la marque de commerce.

1993, ch. 44, art. 234; 2014, ch. 20, art. 361(A), ch. 32, art. 45.

Preuve

54 (1) La preuve d'un document, ou d'un extrait d'un document, en la garde officielle du registraire peut être fournie par la production d'une copie du document ou de l'extrait, donnée comme étant certifiée conforme par le registraire.

Idem

(2) Une copie de toute inscription dans le registre, donnée comme étant certifiée conforme par le registraire, fait foi des faits y énoncés.

Idem

(3) Une copie de l'inscription de l'enregistrement d'une marque de commerce, donnée comme étant certifiée conforme par le registraire, fait foi des faits y énoncés et de ce que la personne y nommée comme propriétaire est le propriétaire inscrit de cette marque de commerce aux fins et dans la région territoriale qui y sont indiquées.

Idem

(4) Une copie d'une inscription faite ou de documents produits sous l'autorité de toute loi relative aux marques de commerce jusqu'ici en vigueur, certifiée en vertu d'une telle loi, est admissible en preuve et a la même force probante qu'une copie certifiée par le registraire aux termes de la présente loi, ainsi qu'il est prévu au présent article.

L.R. (1985), ch. T-13, art. 54; 2014, ch. 20, art. 361(A).

Compétence de la Cour fédérale

55 La Cour fédérale connaît de toute action ou procédure liée à l'application de la présente loi — à l'exception de l'article 51.01 — ou liée à l'exercice d'un droit ou recours conféré ou défini par celle-ci.

L.R. (1985), ch. T-13, art. 55; 2014, ch. 32, art. 46.

Appel

56 (1) Appel de toute décision rendue par le registraire, sous le régime de la présente loi, peut être interjeté à la Cour fédérale dans les deux mois qui suivent la date où le registraire a expédié l'avis de la décision ou dans tel délai supplémentaire accordé par le tribunal, soit avant, soit après l'expiration des deux mois.

Procedure

(2) An appeal under subsection (1) shall be made by way of notice of appeal filed with the Registrar and in the Federal Court.

Notice to owner

(3) The appellant shall, within the time limited or allowed by subsection (1), send a copy of the notice by registered mail to the registered owner of any trademark that has been referred to by the Registrar in the decision complained of and to every other person who was entitled to notice of the decision.

Public notice

(4) The Federal Court may direct that public notice of the hearing of an appeal under subsection (1) and of the matters at issue therein be given in such manner as it deems proper.

Additional evidence

(5) On an appeal under subsection (1), evidence in addition to that adduced before the Registrar may be adduced and the Federal Court may exercise any discretion vested in the Registrar.

R.S., 1985, c. T-13, s. 56; 2014, c. 20, s. 361(E).

Exclusive jurisdiction of Federal Court

57 (1) The Federal Court has exclusive original jurisdiction, on the application of the Registrar or of any person interested, to order that any entry in the register be struck out or amended on the ground that at the date of the application the entry as it appears on the register does not accurately express or define the existing rights of the person appearing to be the registered owner of the trademark.

Restriction

(2) No person is entitled to institute under this section any proceeding calling into question any decision given by the Registrar of which that person had express notice and from which he had a right to appeal.

R.S., 1985, c. T-13, s. 57; 2014, c. 20, s. 354.

How proceedings instituted

58 An application under section 57 shall be made either by the filing of an originating notice of motion, by counter-claim in an action for the infringement of the trademark, or by statement of claim in an action claiming additional relief under this Act.

R.S., 1985, c. T-13, s. 58; 2014, c. 20, s. 361(E).

Procédure

(2) L'appel est interjeté au moyen d'un avis d'appel produit au bureau du registraire et à la Cour fédérale.

Avis au propriétaire

(3) L'appelant envoie, dans le délai établi ou accordé par le paragraphe (1), par courrier recommandé, une copie de l'avis au propriétaire inscrit de toute marque de commerce que le registraire a mentionnée dans la décision sur laquelle porte la plainte et à toute autre personne qui avait droit à un avis de cette décision.

Avis public

(4) Le tribunal peut ordonner qu'un avis public de l'audition de l'appel et des matières en litige dans cet appel soit donné de la manière qu'il juge opportune.

Preuve additionnelle

(5) Lors de l'appel, il peut être apporté une preuve en plus de celle qui a été fournie devant le registraire, et le tribunal peut exercer toute discrétion dont le registraire est investi.

L.R. (1985), ch. T-13, art. 56; 2014, ch. 20, art. 361(A).

Compétence exclusive de la Cour fédérale

57 (1) La Cour fédérale a une compétence initiale exclusive, sur demande du registraire ou de toute personne intéressée, pour ordonner qu'une inscription dans le registre soit biffée ou modifiée, parce que, à la date de cette demande, l'inscription figurant au registre n'exprime ou ne définit pas exactement les droits existants de la personne paraissant être le propriétaire inscrit de la marque de commerce.

Restriction

(2) Personne n'a le droit d'intenter, en vertu du présent article, des procédures mettant en question une décision rendue par le registraire, de laquelle cette personne avait reçu un avis formel et dont elle avait le droit d'interjeter appel.

L.R. (1985), ch. T-13, art. 57; 2014, ch. 20, art. 354.

Comment sont intentées les procédures

58 Une demande prévue à l'article 57 est faite par la production d'un avis de requête, par une demande reconventionnelle dans une action pour usurpation de la marque de commerce ou par un exposé de réclamation dans une action demandant un redressement additionnel en vertu de la présente loi.

L.R. (1985), ch. T-13, art. 58; 2014, ch. 20, art. 361(A).

General

Administration

62 This Act shall be administered by the Minister of Industry.

R.S., 1985, c. T-13, s. 62; 1992, c. 1, s. 145(F); 1995, c. 1, s. 62.

Registrar

63 (1) There shall be a Registrar of Trademarks, who shall be the Commissioner of Patents appointed under subsection 4(1) of the *Patent Act*. The Registrar shall be responsible to the Deputy Minister of Industry.

Acting registrar

(2) When the Registrar is absent or unable to act or when the office of Registrar is vacant, his powers shall be exercised and his duties and functions performed in the capacity of acting registrar by such other officer as may be designated by the Minister of Industry.

Assistants

(3) The Registrar may, after consultation with the Minister, delegate to any person he deems qualified any of his powers, duties and functions under this Act, except the power to delegate under this subsection.

Appeal

(4) Any decision under this Act of a person authorized to make the decision pursuant to subsection (3) may be appealed in the like manner and subject to the like conditions as a decision of the Registrar under this Act.

R.S., 1985, c. T-13, s. 63; 1992, c. 1, s. 145(F); 1995, c. 1, s. 62; 2014, c. 20, ss. 361(E), 370.

Electronic form and means

64 (1) Subject to the regulations, any document, information or fee that is provided to the Registrar under this Act may be provided in any electronic form, and by any electronic means, that is specified by the Registrar.

Collection, storage, etc.

(2) Subject to the regulations, the Registrar may use electronic means to create, collect, receive, store, transfer, distribute, publish, certify or otherwise deal with documents or information.

Dispositions générales

Application

62 Le ministre de l'Industrie est responsable de l'application de la présente loi.

L.R. (1985), ch. T-13, art. 62; 1992, ch. 1, art. 145(F); 1995, ch. 1, art. 62.

Registraire

63 (1) Est institué le poste de registraire des marques de commerce, dont le titulaire est le commissaire aux brevets nommé en vertu du paragraphe 4(1) de la *Loi sur les brevets*; le registraire est responsable envers le sous-ministre de l'Industrie.

Registraire suppléant

(2) En cas d'absence ou d'empêchement du registraire ou de vacance de son poste, ses fonctions sont remplies et ses pouvoirs exercés en qualité de registraire suppléant par tel autre fonctionnaire que désigne le ministre de l'Industrie.

Adjoints

(3) Le registraire peut, après consultation avec le ministre, déléguer à toute personne qu'il estime compétente les pouvoirs et fonctions que lui confère la présente loi, sauf le pouvoir de déléguer prévu au présent paragraphe.

Appel

(4) Il peut être interjeté appel d'une décision rendue en vertu de la présente loi par une personne autorisée conformément au paragraphe (3) de la même façon et aux mêmes conditions que d'une décision du registraire rendue en vertu de la présente loi.

L.R. (1985), ch. T-13, art. 63; 1992, ch. 1, art. 145(F); 1995, ch. 1, art. 62; 2014, ch. 20, art. 361(A) et 370.

Moyens et forme électroniques

64 (1) Sous réserve des règlements, les documents, renseignements ou droits fournis au registraire sous le régime de la présente loi peuvent lui être fournis sous la forme électronique — ou en utilisant les moyens électroniques — qu'il précise.

Collecte, mise en mémoire, etc.

(2) Sous réserve des règlements, le registraire peut faire usage d'un moyen électronique pour créer, recueillir, recevoir, mettre en mémoire, transférer, diffuser, publier, certifier ou traiter de quelque autre façon des documents ou des renseignements.

Most Negative Treatment: Distinguished

Most Recent Distinguished: [Molson Canada 2005 v. Anheuser-Busch Inc.](#) | 2008 CarswellNat 4577, 2008 CarswellNat 5336 | (T.M. Opp. Bd., Nov 28, 2008)

2004 CAF 220, 2004 FCA 220

Federal Court of Appeal

Bacardi & Co. v. Havana Club Holding S.A.

2004 CarswellNat 1798, 2004 CarswellNat 4029, 2004 CAF 220, 2004 FCA 220,
[2004] F.C.J. No. 1001, 132 A.C.W.S. (3d) 145, 323 N.R. 365, 32 C.P.R. (4th) 306

**Bacardi & Company Limited, Appellant and
Havana Club Holdings S.A., Respondent**

Nadon J.A., Noël J.A., Richard C.J.

Heard: May 25, 2004

Judgment: June 8, 2004

Docket: A-447-03, A-448-03

Proceedings: affirming *Bacardi & Co. v. Havana Club Holding S.A.* (2003), 2003 FC 939, 2003 CarswellNat 2337, 2003 CF 939, 2003 CarswellNat 2603 (F.C.); and affirming *Bacardi & Co. v. Havana Club Holding S.A.* (2003), 2003 FC 938, 2003 CF 938, 2003 CarswellNat 2555, 2003 CarswellNat 2401 (F.C.)

Counsel: Mr. Robert MacDonald, Ms Monique Couture, for Appellant, Bacardi & Co.
Mr. Barry Gamache, for Respondent, Havana Club Holding S.A.

Subject: Intellectual Property; Property

Headnote

Intellectual property --- Trade marks — Opposition — Practice and procedure — Jurisdiction — Registrar

H applied to register trade-mark "Havana Club Design" in association with rum, based on use of trade-mark in Canada since 1990 by it or its predecessors in title — B Ltd. alleged invalidity of title of H and that of its predecessors because original 1934 registrant's assets were nationalized in 1960 Republic of Cuba by forced expropriation without compensation — Registrar concluded that pursuant to s. 57 of Federal Court Act, he had no jurisdiction to determine validity of registration other than to recognize H as current owner — Registrar reviewed evidence and rejected opposition — B Ltd.'s appeal was dismissed — Federal court judge held registrar correctly concluded that Federal Court has exclusive jurisdiction to determine validity of registration of registered mark — On opposition application, registrar may only refuse application or reject opposition, but cannot make amendments to register — Federal court judge held, on evidence before him, registrar could reasonably conclude H's application complied with Act, that mark was registrable, that H was entitled to registration and that new mark was distinctive — B Ltd. appealed further — Appeals dismissed — B Ltd. ought to have proceeded under s. 57(1) of Act to achieve alteration of register — Federal court judge was correct in upholding decision of registrar.

Intellectual property --- Trade marks — Opposition — Grounds — Miscellaneous grounds

H applied to register trade-mark "Havana Club Design" in association with rum, based on use of trade-mark in Canada since 1990 by it or its predecessors in title — B Ltd. filed opposition alleging nonuse since at least 1990 by H, that H was not person entitled to use mark in Canada, that mark was confusing with registered trade-mark "Havana Club", and that mark was not distinctive — B Ltd. alleged invalidity of title of H and that of its predecessors because original 1934 registrant's assets were nationalized in 1960 Republic of Cuba by forced expropriation without compensation — Registrar concluded that pursuant to s. 57 of Federal Court Act, he had no jurisdiction to determine validity of registration other than to recognize H as current owner — Registrar reviewed evidence and rejected opposition — B Ltd.'s appeal was dismissed — Federal court judge held registrar

21 The respondent's submissions focus on the question of jurisdiction. Simply stated, the respondent's position is that the Registrar had no authority, in the context of an opposition proceeding, to make any changes to the trade-mark register. Subsection 57(1) of the Act confers sole jurisdiction to the Federal Court to strike out or modify entries on the register.

22 Further, the respondent argues that because the Registrar has no power to amend the register, Justice Martineau was correct to state that any commentary by the Registrar concerning the alleged error committed in 1963 has no bearing on the current proceedings.

The Standard of Review

23 In the course of prior proceedings, the parties correctly identified the standard of review applicable to decisions within the Registrar's scope of jurisdiction as that of reasonableness *simpliciter* (*Molson Breweries, A Partnership v. John Labatt Ltd.*, [2000] 3 F.C. 145 (Fed. C.A.)). The standard of review applicable to the reviewing judge's decision derives from *Housen v. Nikolaisen*, [2002] 2 S.C.R. 235 (S.C.C.), which dictates that errors of law are reviewable on the correctness standard whereas factual findings, inferences or conclusions attract the palpable and overriding error standard.

The Issue

24 Notwithstanding the interesting historical backdrop of these proceedings, the issue is straightforward - the jurisdiction of the Registrar of Trade-Marks in this opposition proceeding.

25 The appellant sought to challenge the validity of the Havana Club registration in an opposition proceeding by disputing the ownership of the mark as entered on the register. The appellant characterizes inquiries into ownership as within the statutory domain of the Registrar. By disputing the validity of the ownership of the trade-mark as found on the register, the appellant claims it can prevent the respondent from relying on subsection 15(1) of the Act.

26 Clearly, the appellant is attempting to impugn an extant registration. By attacking the ownership of the mark, the appellant seeks to evacuate the 1963 registration of effect, which is tantamount to amending or striking out this registration.

27 The legislation and case law make it clear that the appellant cannot achieve this result in a section 38 opposition proceeding. Subsection 38(8) of the Act delineates the powers of the Registrar in such a proceeding:

38. (8) After considering the evidence and representations of the opponent and the applicant, the Registrar shall refuse the application or reject the opposition and notify the parties of the decision and the reasons for the decision.

38.(8) Après avoir examiné la preuve et les observations des parties, le registraire repousse la demande ou rejette l'opposition et notifie aux parties sa décision ainsi que ses motifs.

28 As was pointed out by Justice Martineau, the statutory options available to the Registrar in an opposition proceeding are tightly circumscribed. The Registrar has the authority to either refuse the application or reject the opposition but has no power to make any amendments to the register.

29 The narrow ambit of subsection 38(8) can be contrasted with subsection 57(1) of the Act, which reads as follows:

57. (1) The Federal Court has exclusive original jurisdiction, on the application of the Registrar or of any person interested, to order that any entry in the register be struck out or amended on the ground that at the date of the application the entry as it appears on the register does not accurately express or define

57. (1) La Cour fédérale a une compétence initiale exclusive, sur demande du registraire ou de toute personne intéressée, pour ordonner qu'une inscription dans le registre soit biffée ou modifiée, parce que, à la date de cette demande, l'inscription figurant au registre n'exprime ou ne définit pas exactement les droits

the existing rights of the person appearing to be the registered owner of the mark.

existants de la personne paraissant être le propriétaire inscrit de la marque.

30 This section grants the Federal Court sole and exclusive jurisdiction to alter the register, to the exclusion of all other courts and tribunals. As stated in Fox (Kelly Gill & R. Scott Jolliffe, eds., *Fox on Canadian Law of Trade-Marks and Unfair Competition*, 4th ed., looseleaf (Toronto: Carswell, 2003) at 2-28):

...the Federal Court has exclusive original jurisdiction in all cases of conflicting applications for registration of any trade-mark and in all cases where it is sought to have any entry in the register of trade-marks made, expunged, varied or rectified.

31 Clearly, this provision also applies to the Registrar. To allow the Registrar to effectively alter the register in the context of an opposition proceeding, as suggested by the appellant, deprives the Federal Court of its exclusive jurisdiction in this regard, contrary to the intention of Parliament.

32 Section 41 of the Act recites circumstances in which the Registrar may amend the register. None apply in this case.

33 To obtain its desired remedy, the appellant ought to have proceeded under subsection 57(1) of the Act. Indeed, counsel for the appellant acknowledged before this Court that his client could have resorted to this subsection. No explanation was offered to the Court as to why the appellant had not pursued this avenue, particularly when the underlying facts have been known to it for many years.

34 The procedure under subsection 57(1) of the Act is available to a broad range of persons. The subsection stipulates that "any person interested" may apply. Section 2 of the Act defines "person interested" expansively:

"person interested" includes any person who is affected or reasonably apprehends that he may be affected by any entry in the register, or by any act or omission or contemplated act or omission under or contrary to this Act, and includes the Attorney General of Canada;

« personne intéressée » Sont assimilés à une personne intéressée le procureur général du Canada et quiconque est atteint ou a des motifs valables d'appréhender qu'il sera atteint par une inscription dans le registre, ou par tout acte ou omission, ou tout acte ou omission projeté, sous le régime ou à l'encontre de la présente loi.

35 The subsection also provides that the Registrar, himself, can apply to the Federal Court at any time to have an entry on the register struck.

36 The comprehensiveness of this section affirms that it would have been the appropriate avenue for the appellant's complaint.

37 The appropriateness of proceeding by way of subsection 57(1) of the Act is further reinforced by the nature of the proceedings therein envisaged - a hearing before the court where all parties can give evidence and make submissions on potentially complex legal issues.

38 The current situation is analogous to that before Mr. Justice Cattanach in *Sunshine Biscuits Inc. v. Corporate Foods Ltd.* (1982), 61 C.P.R. (2d) 53 (Fed. T.D.). In that case, also in the context of an opposition proceeding, the applicant urged the Registrar to disregard the applicant's trade-mark. Cattanach J. refused, recognizing that the appellant was asking for a *de facto* expungement of an extant trade-mark. There, as here, the appropriate avenue for the appellants to pursue would have been expungement proceedings before the Federal Court. Regardless of how the request is framed, an opposition proceeding is not the appropriate forum for tacit or manifest amendments to the register.

39 I would note further in this regard that I cannot accept the appellant's unduly restrictive interpretation of the *Sunshine Biscuits* case. Although that case did not touch on subsection 15(1) of the Act, Justice Cattanach's determination (at page 62)

1995 CarswellNat 1863
Federal Court of Canada — Trial Division

Copperhead Brewing Co. v. John Labatt Ltd./John Labatt Ltée

1995 CarswellNat 1863, [1995] F.C.J. No. 668, 55 A.C.W.S. (3d) 223, 61 C.P.R. (3d) 317, 95 F.T.R. 146

**Copperhead Brewing Co. Ltd., Plaintiff and John Labatt
Limited/John Labatt Limitee and Labatt Breweries of
Canada and Labatt Brewing Company Limited, Defendants**

Teitelbaum J.

Heard: March 21, 1995

Judgment: May 2, 1995

Docket: T-191-95

Counsel: *Mr. Allen D. Israel* for Plaintiff.

Mr. Steven B. Garland for Defendant.

Subject: Intellectual Property; Property

Teitelbaum, J:

1 This is an application by the defendants to strike out paragraphs 9, 10, 13, 17(c), 17(d), 18(b), 18(c) and Schedule "A" of the Amended Statement of Claim pursuant to Rule 419 of the *Federal Court Rules*, C.R.C. 1978, c.663, as amended, on the grounds that the aforementioned paragraphs and Schedule:

- i) disclose no reasonable cause of action;
- ii) are immaterial or redundant;
- iii) are frivolous or vexatious;
- iv) may prejudice, embarrass or delay the fair trial of the action; or
- v) are an abuse of the process of the Court.

2 In the alternative, the defendants have applied for an Order pursuant to Rule 415(3) requiring the plaintiff to supply particulars with respect to paragraphs 13, 14 and 15 of the Amended Statement of Claim.

3 According to the Notice of Motion, the defendants applied to have paragraph 18(f) of the Amended Statement of Claim struck out. However, counsel for the defendants advised the Court that the defendants would not be seeking to have this paragraph struck as part of the application before me.

4 At the outset of the application, the plaintiff argued that the defendants have not provided any grounds in support of the motion for particulars and on that basis alone the motion for particulars must be dismissed. According to the grounds outlined in the Notice of Motion, the Statement of Claim was filed on January 30, 1995 and served on the defendants on February 13, 1995. By letter dated February 17, 1995, the defendants requested particulars with respect to the allegations set out in paragraphs 7, 8, 13, 14 and 15 of the Statement of Claim; and an Amended Statement of Claim wherein paragraphs 9, 17(c), 17(d), 18(b), 18(c), 18(f) and Schedule "A" of the original Statement of Claim were to be deleted. This letter is exhibit "A" attached to the affidavit of Claire Gorden and filed in support of the defendants' motion. By letter dated March 2, 1995, the defendants were

10 More specifically, the defendants argue that paragraphs 9, 18(b) and 18(c) of the Amended Statement of Claim are irrelevant to the determination of the issues in dispute, namely the passing off action and that registrability of the plaintiff's trade mark is a question for the Registrar of Trade Marks. Paragraph 9 reads as follows:

On January 19, 1995 **COPPERHEAD** filed an application to register the trade mark **COPPERHEAD** in association with beer based on use since at least as early as October 8, 1993. A copy of the application as filed on January 19, 1995 is attached hereto as Schedule A and forms part of this Statement of Claim.

11 The defendants submit that the mere fact that the plaintiff has filed a trade mark application is irrelevant to a passing off action, as there are no rights that flow to the plaintiff.

12 The plaintiff argues that its application to register the trade mark *COPPERHEAD* is material and relevant to the action, which it claims is based on acts of unfair competition by the defendants, namely the adoption of the allegedly confusing trade mark "copper" for beer. The plaintiff maintains that on the basis of section 20 of the *Federal Court Act* and section 53.2 of the *Trade Marks Act* the Court has the power to grant the plaintiff relief in cases where any act has been done contrary to the *Trade Marks Act*. The plaintiff alleges that not only will the plaintiff suffer damage in terms of lost sales and profits but in the context of its application to register the trade mark *COPPERHEAD*, the trade mark may lose its distinctiveness. As such, the plaintiff submits that the Court is entitled to consider the plaintiff's application to register the mark in the context of the impact the defendants' action may have on the plaintiff's ability to register its mark.

13 I agree that as this is a passing off action, the parties must rely on the law of unfair competition, namely sections 7(b) and (c) to obtain their relief and that the question of the status of a trade mark registration must first be dealt with in the proper forum, that is to say by the Registrar of Trade Marks. While I also agree that whether or not the plaintiff has made an application to register the trade mark *COPPERHEAD* may not be entirely relevant to the passing off action, the jurisprudence is consistent that under Rules 419(1)(b) through (f) it must be established that the pleading is so clearly immaterial, frivolous, embarrassing or abusive that it is obviously forlorn and futile (*Burnaby Machine & Mill Equipment v. Berglund Industrial Supply Co.* (1982), 64 C.P.R.(2d) 206 (FCTD)) and that the Court will not strike mere surplus statements where no prejudice flows from them (*Pater Int. Automotive Franchising Inc. v. Mister Mechanic Inc.*, [1990] 1 F.C. 237 (TD)). As I am not entirely satisfied that the defendants will suffer prejudice if paragraph 9 is not struck, I will allow paragraph 9 and Schedule "A" to remain in the Amended Statement of Claim.

14 The defendants further submit that the purpose of paragraph 9 is to link it to the declarations for relief that the plaintiff is seeking under paragraph 18. In other words, by virtue of paragraphs 18 (b) and (c) the plaintiff is seeking declaratory relief with respect to the pending trade mark application. Paragraph 18 outlines the plaintiff's prayer for relief. Paragraph 18(a) deals with a declaration pursuant to subsection 7(b) of the *Trade Marks Act* and is not in issue. Paragraph 18(d) is a request to injunctive relief and is also not in issue. However, in paragraphs 18(b) and (c) the plaintiff claims the following:

By reason of the activities of the Defendants as aforesaid, the Defendants have and will make a profit and the Plaintiff, **COPPERHEAD**, has and will suffer damage, including loss of goodwill, loss of reputation and loss of distinctiveness.

The Plaintiff Therefore Claims:

.....

(b) a Declaration that the Plaintiff as against the Defendants and each of them was first to adopt a trade mark and/or trade name which includes the element **COPPER** in association with the operation of a brewery business and in association with the offering for sale and sale of alcoholic brewery beverages.

(c) a Declaration that the Plaintiff is entitled to state on its application to register the trade mark **COPPERHEAD** that the Plaintiff has used the trade mark in Canada in association with beer since at least as early as October 8, 1993.

15 The declaration requested under paragraph 18(c) is not inter parties and I agree with the defendants that any application for a trade mark can state any date of first use it chooses, however, it is the applicant who must establish that date to the satisfaction of the Registrar of Trade Marks.

16 The defendants maintain that the Federal Court does not, in a passing off action, have the power to grant the relief sought in paragraphs 18(b) and (c). The defendants' position is based on the argument that pursuant to the statutory and regulatory scheme of the *Trade Marks Act* as it relates to trade mark applications, any issues related to the plaintiff's trade mark application are to be addressed at the first instance by the Registrar of Trade Marks. The defendants also argue that the kind of declaration sought in paragraph 18(b) would be prejudicial to the defendants' right to apply for a trade mark involving an element of "copper" or oppose a trade mark filed by the plaintiff involving a trade mark with an element of "copper".

17 In response, counsel for the plaintiff agrees that the pending application does not support a cause of action under subsection 7(b) of the *Trade Marks Act* per se (page 73 of the transcript) but argues that subsection 7(b) gives the plaintiff the right to prevent the adoption of a confusingly similar mark, which in turn will have an impact on the plaintiff's abilities to expand its business. The plaintiff submits this Court is entitled to consider the application in terms of remedies sought and the basis of those remedies. Moreover, in terms of general principles, the plaintiff argues that the mention of the application is not futile but material and relevant in the context of what is going on in the marketplace.

18 The plaintiff referred me to this Court's decision in *Royal Doulton Tableware Ltd. v. Cassidy's Ltd.* (1985), 1 C.P.R.(3d) 214 (FCTD) and Strayer J.'s (as he then was) comments at pages 227, 228 and 229 that the Federal Court has jurisdiction in equity to issue a declaration as to ownership of a trade mark. The relevant passages are reproduced below:

The plaintiffs further request a declaration that Paragon "is the owner of the trade mark 'Victoriana Rose' for use in association with china tableware. It is to be noted that as framed the relief requested does not involve entitlement to registration. In my view, it would be open to this court to make such a declaration if it had before it all the necessary evidence. I believe that this court has jurisdiction to make such a declaration pursuant to s.20 of the *Federal Court Act* which give it concurrent jurisdiction ... (emphasis added)

Here the *Trade Marks Act* in ss.1 to 11 defines and prescribes a number of rules concerning trade marks and the adoption thereof, without reference to registration. Thereafter, the Act only deals with registered trade marks. Within the context of s.20 of the *Federal Court Act*, the declaration is a remedy "in equity" and in this case with respect to a trade mark. The requirements of s. 101 of the *Constitution Act, 1867* are also met since Parliament by ss. 1 to 11 of the Trade Marks Act has prescribed a regime concerning what constitutes a trade mark and the adoption thereof, whether registered or not.

.....

While then it would, in my view, be legally possible to issue a declaration as to ownership of an unregistered trade mark, I believe in this case I should confine myself to the evidence before me relating to the use of the trade mark VICTORIANA ROSE.

... At the same time I believe it could be useful that the use issue be clarified in this way for whatever relevance it may have to the future conduct of the parties. It may also provide assistance to the registrar should Paragon seek registration of this mark, but it does not usurp the functions of the registrar who must consider many other matters before reaching a decision as to registration.

19 Given Strayer J.'s comments I have no dispute with the concept that the plaintiff may, in certain circumstances, be entitled to a declaration as to ownership of the unregistered mark "Copperhead". However, it is also clear that such a declaration must not relate to the question of entitlement. After a closer reading of paragraph 18(b) it is my opinion that the plaintiff is seeking a declaration that he was first to adopt any trade mark or trade name with the element of "copper" as a finding of fact, which in my view is quite a different situation than in the one before Justice Strayer in the *Royal Doulton* case. Further, by seeking such a declaration, the plaintiff is in effect providing the Registrar with directions from the Court as to facts which the Registrar is required to find or determine at the first instance with respect to the registrability of a trade mark. I agree, at this point in time, that

it is not the place of this Court to make such a finding or determination in a passing off action, nor would such a finding serve a useful purpose to resolve the issue of the alleged passing off between the parties. Similarly with paragraph 18(c), the question of when the plaintiff was first to use the trade mark and/or trade name is a matter for the Registrar to determine at the first instance.

20 *Friendly Ice Cream Corp. v. Friendly Ice Cream Shops Ltd.* (1972), 7 C.P.R. (2d) 35 (FCTD) also dealt with a cause of action under section 7 of the *Trade Marks Act* and a motion to strike out the statement of claim on the grounds that it did not disclose a reasonable cause of action. Heald J. (as he then was) found that the plaintiff had not pleaded facts that its trade mark or get up was distinctive in the defendant's market or that there was likelihood of confusion in that market place. The plaintiff also asked for a declaration "that the defendant is not entitled to seek and shall not be granted registration of the words "Big Beef" or the word and design "Fribble" as trade marks under the *Trade Marks Act* under its pending application" (pages 39-40). In terms of the declaration sought, the Court made the following comment at page 40:

I have no difficulty whatsoever in concluding that this portion of the statement of claim must be struck out. Section 37 of the *Trade Marks Act* provides the way in which applications for trade marks may be opposed. Said section contains a complete code of procedure in such circumstances which has to be followed. I know of no authority which would allow the Court to abridge or by-pass these statutory provisions. This, in effect, is what the plaintiff is asking the Court to do in para. 16(d) of the statement of claim.

21 Further, in *Cellcor Corp. of Canada Ltd. v. Kotacka* (1976), 27 C.P.R. (2d) 63 (FCA), the Federal Court of Appeal held that the Court was without jurisdiction to decide ownership of an invention and entitlement to apply for a patent with respect to ownership of an invention. Although the case dealt with the *Patent Act*, I am of the view that the Court of Appeal's comments at pages 73 and 74, regarding the Court's jurisdiction under section 20 of the *Federal Court Act*, apply equally to the case before me:

The respondent's main argument was that s.22 gives jurisdiction to the Court in this matter. The main relief sought [footnote omitted], said he, is a declaration that the plaintiff, being the owner of the invention, is entitled, under the *Patent Act*, to apply for letters patent. That relief, he added, is clearly a relief "respecting a patent of invention" within the meaning of s.20 and is also a relief provided for by law since the Court is authorized to pronounce declaratory judgments ...

The respondent's contention is, in my view, ill-founded. Assuming that the declaration sought in this action is a remedy respecting a patent of invention, within the meaning of s.20, I am nevertheless of opinion that, in the circumstances of this case, it is not a relief that the Federal Court has power to grant because I agree with the appellants' view that there is no legal basis for it. Under the *Patent Act*, the official who must first decide whether a patent may issue to an applicant is the Commissioner. The Act does not empower the Courts to give him directions on the decision he should reach; it is only if he is alleged to have made a wrong decision that, under the statute, the Courts may be seized of the matter. In my view, it would be contrary to the scheme of the *Patent Act* for the Courts to assume the power, in a case like the present one, to make the declaration sought. In my opinion, the power of the Court under Rule 1723, to make "binding declarations of right" cannot be exercised in respect of letters patent of invention when its exercise is not expressly or impliedly contemplated by the *Patent Act* or another statute within the legislative jurisdiction of Parliament.

22 Therefore, in light of the above comments, I am of the opinion that paragraphs 18(b) and 18(c) of the Amended Statement of Claim must be struck out.

23 In paragraph 10 of the Amended Statement of Claim, the plaintiff alleges:

Trade mark and trade name searches normally performed by large beer manufactures and sellers, such as the Plaintiffs, typically consist of Nuans Trade Mark and Trade Name Search Reports, trade mark search reports and marketplace investigations. The Defendants jointly and severally are, and at all material times have been, aware of the office or principal place of business of Labatt's Ontario Breweries the address of which is 1779 Colonnade Road, South, Suite 800, Nepean, Ontario, K2E 7J4. Labatt's Ontario Breweries has been active at the above address since prior to October 8, 1993.

24 I must agree with the defendants' submission that the above paragraph is irrelevant to the determination of the issues in dispute in a passing off action. The plaintiff is of the view that the paragraph goes to exemplary damages and that a fair

1989 CarswellSask 154
Saskatchewan Court of Queen's Bench

Elrose, School Division No. 33 v. Stoneouse

1989 CarswellSask 154, 14 A.C.W.S. (3d) 431, 78 Sask. R. 278

**The Board of Education of the Eston — Elrose School
Division No. 33 of Saskatchewan v. Rhonda Stoneouse**

Lawton J.

Judgment: March 30, 1989

Docket: Doc. Q.B. 3367/87

Counsel: *R. D. Laing, Q.C.* for the Applicant.

H. Dahlem, Q.C. for the Respondent.

Subject: Public

Lawton J.:

1 This is an application to have an order of a Board of Reference set aside.

2 In 1985, the Board of Education of the Eston — Elrose School Division (hereinafter referred to as the "BE") adopted and implemented a new Supervision and Evaluation Policy for its teaching staff. The policy had received input from the school trustees, the administration and the teaching staff.

3 In May 1987, Rhonda Stoneouse, a teacher with 16 years' experience, was completing her 11th year as a Grade 3 teacher in the Eston Elementary School when, on May 28, she received a Notice of Termination from the BE.

4 Stoneouse applied under Section 209 of *The Education Act*, R.S.S. 1978, c. E-0.1 (all references are to that Act) to attend a meeting of the BE to show cause why her contract should not be terminated. Such a meeting was held, but the termination was confirmed.

5 Stoneouse then applied to the Minister under Section 212 for an investigation of the termination by a Board of Reference (hereinafter "BR"). Pursuant to Section 214, the Minister appointed a BR. That board held a three-day hearing in August 1987 and, after making an order which was set aside in January 1988, in November 1988 the majority ordered the continuation of Stoneouse's contract of employment.

6 The BE applies under Section 222(3) to have that order set aside. Section 222(3) says:

A board of reference shall have full power to determine any question of fact necessary to its jurisdiction, but, notwithstanding subsection (1), either party to an investigation may make an application to the Court of Queen's Bench for an order to set aside the decision of the board of reference on the grounds that:

(a) there is an error of law on the face of the record;

(b) the board of reference lacked jurisdiction to hear the matter; or

(c) the board of reference exceeded its jurisdiction.

The BE claims that there is error of law on the face of the record and that the BR exceeded its jurisdiction.

7 The Notice of Termination to Stoneouse complied with Section 210 by setting out the reasons of the dermination. It said:

Pursuant to the provisions of Section 210 of the Act, the Board informs you that the reasons for termination of the contract are:

1. You have failed to demonstrate instructional skills satisfactory to the board. Particulars have been supplied to you by the board's administrative staff, including the principal.
2. You have failed to demonstrate certain qualities and characteristics which the board expects of its professional teaching staff. Particulars have been supplied to you by the board's administrative staff, including the principal.

and that in its opinion, you are, for the reasons so stated, unsuitable for continued teaching service in your present position.

8 These reasons are important to the BR because Section 217 states:

217. The scope of the investigation and the findings of the board of reference thereon shall be limited to the reasons given of the written notice of termination of the contract of employment.

9 Section 221 sets out four powers of the BR, the second of which is that it may:

(b) order the continuation of the contract of employment.

10 During the three-day hearing, counsel for both parties referred to certain comments of Bayda J.A. (as he then was) in *Prefontaine vs. Regina (East) School Unit No. 20*, (1981) 12 Sask. R., 99. That was an action for wrongful dismissal, and the comments which are on p. 113 of the report set out tests which come into play when a court is called upon to consider a termination of a teacher.

I have concluded that where the cause specified in the notice of termination is one of the enumerated causes (e.g. professional misconduct, neglect of duty, etc.), the court has the right, in action for wrongful dismissal, to determine whether the cause so specified, in fact existed. Where the cause alleged in the notice is not one of the enumerated causes but is dependant upon the board's "opinion", as it is here, the court has not only the right to determine if the board acted in good faith in reaching its opinion but the right to review the board's decision and determine if the board had good reasons for arriving at its decision and if the decision is one a reasonable persons might reasonably reach in the circumstances. In short, two tests — a subjective and objective test — come into play.

11 The parties have accepted that those same tests are present when a board, rather than a court, is called upon to investigate a termination.

12 It appears, therefore, that in performing its duties, the BR had to decide if the BE acted in good faith, if the BE had good reasons for what it did and if its decision is reasonable. In performing my duties, I have to decide if there is an error of law on the face of the record or if the BR exceeded its jurisdiction.

13 In September 1987, the majority of the BR ordered the continuation of Stoneouse's employment contract because it concluded, giving two reasons, that the BE had acted in bad faith. The BE applied to MacLeod J. of the Court of Queen's Bench to set that order aside.

14 In his January 20, 1988 judgment (unreported), Justice MacLeod accepted the definition of bad faith in *Black's Law Dictionary*:

Bad faith. The opposite of "good faith" generally implying or involving actual or constructive fraud, or a design to mislead or deceive another, or a neglect or refusal to fulfill some duty or some contractual obligation, not prompted by an honest mistake as to one's rights or duties, but by some interested or sinister motive. Term "bad faith" is not simply judgment or negligence, but rather it implies the conscious doing of a wrong because of dishonest purpose or moral obliquity; it is

different from a negative idea of negligence in that it contemplates a state of mind affirmatively operating with furtive design or ill will.

He said:

... the majority simply cannot conclude that conduct of which it disapproves amounts to bad faith unless that conduct is inspired by a dishonest purpose or is founded on moral obliquity.

Clearly, bad faith is more than a simple mistake or error or negligence.

15 MacLeod J. concluded that the two reasons given did not support the finding of bad faith. He set aside the decision and referred the matter back to the BR.

16 Counsel reargued the matter before the BR, and in November 1988, the majority of the Board issued the order now before us. The decision is 14 ¹/₂ pages long. Four and one-half pages are prologue, nine deal with bad faith and one deals with the BE's reasons.

Bad Faith

17 The two reasons of the first decision have been expanded to five:

1. The Supervision Process;
2. Report;
3. The Grounds Evaluated;
4. Resignation Request;
5. Evidence Placed Before the Board of Education.

With the definition in mind, I examined each of the five and the transcript.

1. The Supervision Process

18 The BR contended that in the Supervision and Evaluation Policy there was a clear distinction between supervision and evaluation, that the administrators blurred that distinction and, that in doing so, they contravened the policy. The BR's main concern in this area involved the principal who, while supervising Stoneouse, received information from her and then used it in his evaluation. The BR thought this was wrong. I do not agree given the statement on p. 2 of a document entitled "Supervision and Evaluation — Teaching Staff" (Exhibit B3, Affidavit of Paul Kuch) which says: "An evaluation is a product of supervision providing information about a teacher's performance ...".

2. Report

19 The BR complained that the principal never signed the evaluation report which resulted in the dismissal. This is true, but at the hearing, he said he concurred with the report and its recommendations. He said the failure to sign was probably an oversight. I see nothing sinister in this at all.

3. The Grounds Evaluated

20 The BR noted that appended to the Supervision and Evaluation Policy was a document entitled "Indicators of Effective Teaching" and that many of the criteria set out in that document were not mentioned or used in the evaluation of Stoneouse. The principal did say that the areas of the indicators which were not negatively mentioned were "okay" or "no problem" as regards Stoneouse. Can one conclude that failure to consider those items shows bad faith? In a matter where a person's job is at stake,

Most Negative Treatment: Distinguished

Most Recent Distinguished: [Oakley Inc. v. Shoppers Drug Mart Inc.](#) | 2001 FCT 226, 2001 CFPI 226, 2001 CarswellNat 509, 2001 CarswellNat 5473, 201 F.T.R. 258, 104 A.C.W.S. (3d) 287, [2001] F.C.J. No. 415 | (Fed. T.D., Mar 22, 2001)

1997 CarswellNat 1171

Federal Court of Canada — Trial Division

Rothmans, Benson & Hedges Inc. v. Imperial Tobacco Ltd.

1997 CarswellNat 1171, [1997] F.C.J. No. 840, 72 A.C.W.S. (3d) 921, 74 C.P.R. (3d) 494

Rothmans, Benson & Hedges Inc., Plaintiff and Imperial Tobacco Limited and Imperial Brands Limited, Defendants

MacKay J.

Heard: April 22, 1997

Judgment: June 17, 1997

Docket: T-628-97

Counsel: *Mr. John Allport*, for Plaintiff.

Mr. Elliott Simcoe, for Defendants.

Subject: Intellectual Property; Property

Headnote

Trade marks --- Infringement — Practice and procedure — Pleadings — Striking out

Statement of claim — Lack of jurisdiction — Defendants moved to strike out claim for relief in which plaintiff sought injunction restraining defendants from proceeding to register any trade-mark including words "Classic" or "Classique" for tobacco products and to restrain defendants from proceeding to register trade-marks including those words as set out in their four applications — Motion granted — Trade-marks Act provides complete code of procedure for opposing trade-mark applications — No authority for court to abridge or by-pass statutory provisions — Registrar of trade-marks has jurisdiction to first decide whether trade-mark may issue — Only if registrar is alleged to have made wrong decision may court review matter — Trade-marks Act, R.S.C. 1985, c. T-13.

MOTION by defendants to strike out paragraphs in statement of claim in which plaintiff seeks injunctive relief.

MacKay J.:

Reasons for Order

1 The defendants seek an order striking certain paragraphs of the plaintiff's statement of claim, filed April 7, 1997 in this action alleging trade-mark infringement. In the action the plaintiff claims injunctive and monetary relief against the defendants for alleged infringement of its two registered trade-marks: CLASSIC, registration no. TMA 112,833, and CLASSIQUE, registration no. TMA 321,640.

2 The defendant Imperial Tobacco Limited has filed applications for registration of the following trade-marks in the Canadian Trade-marks Office:

- a. SMOOTH FLAVOUR, CLASSIC QUALITY, disclaiming the words SMOOTH, FLAVOUR and QUALITY, but not the word CLASSIC, for use in association with manufactured tobacco products (application no. 778,873);

b. QUALITE CLASSIQUE, UN GOUT UNIQUE, disclaiming the words QUALITE, GOUT, and UNIQUE, but not the word CLASSIQUE, for use in association with manufactured tobacco products (application no. 778,874);

c. DU MAURIER CLASSIC, for use in association with cigarettes (application no. 790,638); and

d. DU MAURIER CLASSIQUE, for use in association with manufactured tobacco products (application no. 790,639).

Reference to these applications is made in paragraph 9 of the plaintiff's statement of claim.

3 That statement also includes, in paragraph 15(a), claims for injunctive relief, including relief by way of an injunction to restrain the defendants and those associated with or controlled by them from, *inter alia*,

iii) proceeding to register any trade-mark including the words CLASSIC or CLASSIQUE, for tobacco products;

iv) proceeding to register the trade-marks as set out in applications no. 778,873; 778,874; 790,638; or 790,639.

4 By letter the defendants requested that the plaintiff file an amended statement of claim omitting subparagraphs 15(iii) and (iv). This was refused and the defendants now move the Court that those subparagraphs be struck from the plaintiff's statement of claim on the ground there is no lawful basis, no jurisdiction, for the Court to award the relief sought. If that is the case, then even assuming the facts pleaded by the plaintiff are true, there can be no doubt that a reasonable case is not made out that the Court could grant the relief sought by the subparagraphs in question.

5 For the plaintiff it is urged that the subparagraphs in question relate to relief subsidiary to general injunctive relief sought in the action, to preclude use as a trade-mark of the words CLASSIC and CLASSIQUE in association with tobacco products, and thus are to protect the plaintiff's registered trade-marks. It is said that subparagraphs 15(a)(iii) and 15(a)(iv) are not intended to by-pass procedures established under the *Trade-marks Act*, R.S.C. 1985, c. T-13 as amended, (the "*Act*"). They seek relief by orders *in personam*, not determinations *in rem* about rights to a registered trade-mark for which the *Act* provides.

6 In my opinion, the relief here questioned is within the principle of the decision of Mr. Justice Heald in *Friendly Ice Cream Corp. v. Friendly Ice Cream Shops Ltd.* (1972), 7 C.P.R. (2d) 35 (Fed. T.D.). In discussing declaratory relief there sought, that the defendant was not entitled to seek or to be granted registration of certain words as trade-marks, Heald J. wrote at p. 40:

I have no difficulty whatsoever in concluding that this portion of the statement of claim must be struck out. ... the *Trade Marks Act* provides the way in which applications for trade marks may be opposed. ... [it] contains a complete code of procedure in such circumstances which has to be followed. I know of no authority which would allow the Court to abridge or by-pass these statutory provisions. This, in effect, is what the plaintiff is asking the Court to do...

7 I agree with the defendants that the person who must first decide whether a trade-mark may issue is the Registrar of Trade-marks. Only if the Registrar is alleged to have made a wrong decision may the Court be engaged to review the matter. The defendants are entitled to apply for registration of trade-marks under the *Act*, and to have any application determined by the Registrar, after consideration of any opposition that may be advanced in accord with procedures under the *Act*. To restrain the defendants from seeking to register the trade-marks applied for, as the relief sought by subparagraphs 15(a)(iii) and 15(a)(iv) of the statement of claim would do, would deprive them of rights to apply for registration in accord with procedures established under the *Act*.

8 The Court would not grant the relief sought in subparagraphs 15(a)(iii) and 15(a)(iv), even if it had jurisdiction to do so, which in my view, it does not have. To grant the relief requested would by-pass the statutory method and the tribunal established by Parliament for determining applications for registration of trade-marks.

9 Thus, in my opinion, there is no reasonable case made out by the statement of claim for the relief sought in the provisions in question. The defendants are entitled to an order striking subparagraphs 15(a)(iii) and 15(a)(iv) of that statement filed on April 7, 1997.

**Saskatchewan Court of Queen's Bench
Judicial Centre of Saskatoon**

Citation: Westfair Foods Ltd. v. Derby Holdings Ltd.

Date: 1987-09-16

Docket: Q.B. No. 3460 A.D. 1986

Between:

Westfair Foods Ltd. (Plaintiff/Applicant)

and

Derby Holdings Ltd. (Defendant/Respondent)

Grotsky, J.

Counsel:

J.E. Seibel, for the plaintiff;

G.M. Currie, for the defendant.

NATURE OF APPLICATION

[1] Grotsky, J.: The plaintiff seeks an interim injunction restraining the defendant, its agents or servants, or any person having knowledge of this order, until the trial of this action, or until further order:

“a. From using or permitting or suffering to be used any portion of the Grosvenor Park Shopping Centre, at the City of Saskatoon, in the Province of Saskatchewan, legally described as:

Lot One (1), in Block Two Hundred and Fifty-eight (258), in the City of Saskatoon, in the Province of Saskatchewan, in the Dominion of Canada, according to a Plan of Record in the Land Titles Office for the Saskatoon Land Registration District as Plan No. G. 837.

MINERALS INCLUDED; and

Parcel Y, in the City of Saskatoon, in the Province of Saskatchewan, in the Dominion of Canada, according to a Plan of Record in the Land Titles Office for the Saskatoon Land Registration District as Plan No. G. 779, as amended by Master of Titles Order No. F.J. 6222, MINES AND MINERALS' EXCEPTED;

(the 'Shopping Centre').

save and except for that portion which comprises the premises leased by the Plaintiff from the Defendant, for the sale of food for consumption off the premises of the Shopping Centre and except as follows:

i. for an Existing Food Uses described as follows:

(3) On March 11, 1980 the defendant entered into a lease agreement with the plaintiff for a portion of the Shopping Centre premises. This lease was for an initial term of 15 years and 21 days with three further 5-year renewal terms.

(4) On October 2, 1986, this action was commenced by the plaintiff. It asserts that notwithstanding an exclusive use covenant in its lease agreement with the defendant, the defendant has permitted a portion of the lands bound by the covenant: that portion of the Shopping Centre leased to Saskatoon Drug & Stationery Co. Ltd., to be used for the sale of food for off-premises consumption, in breach of its exclusive use covenant. It further asserts that this breach is continuing. That, in consequence, it has suffered, and continues to suffer loss and damages and claims to be entitled to injunctive relief.

(5) As already observed, the statement of claim commencing this action was issued on October 2, 1986. A copy of the initiating documents was duly served on the defendant, through its solicitors, on October 6, 1986. On December 15, 1986 the defendant served its statement of defence. No reply was filed thereto. In consequence, by a combination of Q.B.R.'s 531, 108 and 110 the pleadings closed on December 24, 1986.

(6) An examination of the file reveals that to date no examinations for discovery have been held; neither party has filed their statement as to documents and no attempt appears to have been made by the applicant plaintiff to bring this matter on for trial notwithstanding there were sittings of this Court in each of the months of January, February, March, April, May and June of 1987.

(7) Further to what is observed in the immediately preceding paragraphs; and, notwithstanding injunctive relief was claimed in the statement of claim issued on October 2, 1986; and that this motion, for the relief now being specifically sought, could have been brought on pursuant to Q.B.R. 450 on "at least three days notice between the date of service of the motion and its date of return", the plaintiff did not do so. Notwithstanding its allegation that it has suffered, and continues to suffer loss and damages and its claim to be entitled to injunctive relief, it did not launch its motion for injunctive relief until June 25, 1987. Then, instead of bringing the motion on on only at least three days' notice, as was open to it under and pursuant to Q.B.R. 450, *supra*, it made its motion returnable on July 21, 1987. Then, on July 8, 1987, pursuant to Q.B.R. 460(1) the parties by consent had the application adjourned to August 4, 1987 on which date it was, again by consent, further adjourned to August 6, 1987, when it was dealt with.

THE LAW

- [6] The traditional rule is that an injunction will be granted only where damages would provide an inadequate remedy. In *London & Blackwell Ry. Co. v. Cross* (1886), 31 Ch. D. 354 (C.A.), at p. 369 Lindley, L.J., is reported as follows:

“The very first principle of injunction law is that prima facie you do not obtain injunctions to restrain actionable wrongs, for which damages are the proper remedy.”

[7] As observed by Sharpe in *Injunctions and Specific Performance* (1983), at p. 7, it is not possible to define inadequacy of damages in a precise way. It is a vague principle which takes shape depending upon the context. It means one thing when used with respect to interlocutory injunctions, another in nuisance actions, and still another where an injunction is sought to restrain a breach of contract.

[8] In its statement of claim sued out on October 2, 1986, and, as well by its notice of motion launched on June 25, 1987, the plaintiff seeks an interim injunction to restrain the defendant, its agents or servants, or any person having knowledge thereof until the trial or until further order from “using or permitting or suffering to be used” the named premises except as stated in its motion. Specifically, it seeks an interim injunction restraining the defendant, and others as indicated, until trial or other order:

“b. From using or permitting or suffering to be used that portion of the Shopping Centre leased by SASKATOON DRUG & STATIONERY CO. LTD. from the Defendant (‘the SASKATOON DRUG LEASED PREMISES’) for any business other than of a drugstore and sundries without lunch counter.

“c. From using or permitting or suffering to be used the SASKATOON DRUG LEASED PREMISES for the sale of food for off-premises consumption ...”

[9] Generally, an interim injunction is one which is granted to remain in force for a specified period of time. An interlocutory injunction, however, is generally one which (absent any other order) remains in force until the trial or other final determination of the action.

[10] Here, while the order sought is categorized as one for interim injunctive relief, in fact what is being sought is, in my respectful view, for far more: both a restrictive and mandatory interlocutory injunction. A restrictive injunction may be defined as one which prohibits an act from being done. A mandatory injunction is one which requires an act to be done.

[11] If the order sought is granted it will in fact operate to restrain the defendant, its agents or servants, and all others having knowledge thereof, from permitting Saskatoon Drug & Stationery Co. Ltd. to use its leased portion of the Shopping Centre premises in accordance with the prescriptions set forth in (b) and (c), supra. Such an order would be tantamount to a restraining order which in the terms sought would cast a net such as to amount to both a restrictive and mandatory interlocutory injunction.

[12] In the instant case, the plaintiff has not alleged in its statement of claim that it will suffer irreparable damage and loss if the injunction sought is not granted. All that

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Chapter 6 — Trade-mark Registration and Opposition Practice and Procedure**6.7 — OPPOSITION PROCEEDINGS**

Kelly Gill

6.7 — OPPOSITION PROCEEDINGS**6.7 — OPPOSITION PROCEEDINGS****(a) — Statement of Opposition**

If a person desires to stop an application for registration, the proper avenue is to institute an opposition to the application by way of a statement of opposition. It is not permissible for an opponent of a registration to commence a court proceeding to bypass the statutory authority vested in the Registrar. Only after the Registrar has made a decision as to the registrability of a trademark, can the Court review the matter.¹⁰² Similarly, it is not possible to challenge an existing registration through the opposition process. In *Bacardi & Co. v. Havana Club Holding S.A.*,¹⁰³ the appellant sought to eviscerate the 1963 registration of effect, which the Court found tantamount to amending or striking-out the registration. The Court held that the legislation and case law are clear that such an approach is not permissible pursuant to a s. 38 opposition proceeding. In contrast to the narrow ambit of s. 38(8) of the Act, which delineates the powers of the Registrar in an opposition proceeding, s. 57(1) of the Act grants the Federal Court sole and exclusive jurisdiction to alter the register, to the exclusion of all other courts and tribunals.¹⁰⁴

(i) — Filing the Statement of Opposition

Any party may, within two months from the date of advertisement of an application for registration of a trade-mark, file a statement of opposition with the Registrar. A party can also ask the Registrar for an extension of time to file its statement of opposition. If the extension is filed with the consent (“cooling-off period”) of the applicant, then the Registrar can grant an extension of up to nine months, otherwise the maximum extension of three months can be granted. The Registrar will generally only grant one “cooling-off” extension to a party, this can either be granted before or after the pleadings have completed. If request for a time extension has already been granted under s. 47, no further requests will generally be granted.¹⁰⁵

A person who corresponds with the Registrar in respect of an opposition proceeding shall clearly state that the correspondence relates to the opposition proceeding and should be addressed to the attention of the Opposition Board.¹⁰⁶ Statements of opposition shall be filed with the Registrar in duplicate.¹⁰⁷

(ii) — Who Can Oppose

Persons may oppose the registration of a trade-mark regardless of whether their businesses would be adversely affected by registration of the mark.¹⁰⁸ All that is necessary is for opponents to allege that the subject mark is unregistrable.¹⁰⁹ For example, even where an opponent may have acquiesced to the use of a mark, such does not constitute acquiescence to the