

Federal Court



Cour fédérale

Date: 20190528

Docket: T-1715-18

Citation: 2019 FC 745

Ottawa, Ontario, May 28, 2019

PRESENT: The Honourable Madam Justice McVeigh

BETWEEN:

FCA US LLC

Applicant

and

PENTASTAR TRANSPORTATION LTD.

Respondent

JUDGMENT AND REASONS

I. Introduction

[1] FCA US LLC [the “Applicant”] seeks to appeal a decision of the Registrar of Trademarks under section 56 of the *Trade-marks Act*, RSC 1985, c T-13 [the “Act”], dated July 19, 2018 [the “Decision”]. In the Decision, the Registrar held that Pentastar Transportation Ltd’s registration of the trademark ‘PENTASTAR’ [the “Mark”] be partially maintained on the Trademarks Register pursuant to section 45 of the Act.

II. Background

[2] The Applicant, (formerly known as Chrysler LLC), is an American manufacturer of automobiles and owner of the pending Canadian trademark application PENTASTAR No. 1432154 for passenger vehicles amongst others goods.

[3] Pentastar Transportation Ltd [the “Respondent”, or “Pentastar”] is the Alberta-based owner of the Registration (Canadian trademark Registration No. TMA 635,037) for the Mark, which was issued on March 11, 2005. The Registration was for use in association with goods (now expunged) and the following services: movement and erection of oil and gas drilling rigs; light oil field construction.

[4] On December 29, 2015, at the request of the Applicant, the Registrar sent a notice under section 45 of the Act to the Respondent. The section 45 notice required the Respondent to furnish evidence showing that the Mark had been used in Canada in association with each of the goods and services specified in the Registration during the three-year period immediately preceding the date of the notice (namely, the period from December 29, 2012 to December 29, 2015 [the “Relevant Period”]). If the Mark had not been so used, the Respondent was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[5] In response to the section 45 notice, the Respondent furnished an affidavit from Gary Gurba [“Gurba”]. Gurba is the Respondent’s Chief Financial Officer, and swore an

affidavit on personal knowledge of the facts. Gurba has been the Chief Financial Officer since June 1, 2014 and prior to that was the Controller since June 1, 2005.

[6] On July 19, 2018, the officer with the Trade-marks Opposition Board issued the Decision, which maintained the Registration with respect to the services only in compliance with the provisions of section 45 of the Act, and expunged the goods.

[7] The Federal Court of Appeal issued *Cosmetic Warriors Limited v Riches, McKenzie & Herbert LLP*, 2019 FCA 48 [*“Lush”*] on March 11, 2019. *Lush* was issued after the parties to this application had filed their submissions. The parties addressed *Lush* in their oral submissions. I wish to acknowledge and recognize the remarkable capacity of the parties’ counsel to adapt the arguments to reflect the new jurisprudence.

[8] For the reasons that follow, I find that the evidence relied upon by Pentastar does establish the use of the Mark during the relevant period. The Decision of the Registrar is upheld and the application is dismissed.

III. Issues

[9] The issues are:

- (i) What is the applicable standard of review?
- (ii) Did the Registrar improperly admit hearsay evidence?
- (iii) Was the Registrar’s Decision reasonable in finding use of the Mark in association with services?

IV. Standard of Review

[10] At the hearing of this matter, the Applicant characterized the issues to be determined as being questions of law which would be determined on a correctness standard in accordance with the decision in *Lush*. The previous position of both parties was that I was to use the reasonableness standard.

[11] In *Lush*, Justice Laskin outlined that in section 56 appeals, the standard of review ordinarily depends on whether new material evidence is adduced on appeal. If no new material evidence is adduced on appeal, decisions of the Registrar within the Registrar's area of expertise, whether on issues of fact, law or discretion, are ordinarily to be reviewed on the reasonableness standard.

[12] However, Justice Laskin went on to outline an exception to this general rule (paras 15-17):

[15] The applicability of the reasonableness standard is subject to an exception. Where the Act gives concurrent jurisdiction to the Registrar and the Federal Court to decide a question of statutory interpretation at first instance, the rationale set out in *Rogers Communications Inc. v. Society of Composers, Authors and Music Publishers of Canada*, 2012 SCC 35, [2012] 2 S.C.R. 283, calls for application of the correctness standard to the Registrar's decision on that question.

[16] In *Rogers*, the Supreme Court held, in the context of proceedings under the *Copyright Act*, R.S.C. 1985 c. C-42, that "[i]t would be inconsistent for the court to review a legal question on judicial review of a decision of the [Copyright] Board on a deferential standard and decide exactly the same legal question de novo if it arose in an infringement action in the court at first instance" (at para. 14). The Court added that the conferral of concurrent jurisdiction on the Copyright Board and the court

required the inference “that the legislative intent was not to recognize superior expertise of the Board relative to the court with respect to such legal questions” (at para. 15).

[17] The *Trade-marks Act* assigns jurisdiction at first instance to the Court in relation to “use” in a variety of contexts, including in infringement and invalidity proceedings. In my view, therefore, the same inconsistency referred to in *Rogers* arises, and the same inference as in *Rogers* is required, with respect to the Registrar’s decisions on the meaning of “use” within the meaning of the Act. These decisions are accordingly subject to review on the correctness standard.

[13] In my opinion, to fall within this exception, two requirements must be met. There must be both:

- (1) a question of statutory interpretation,
- (2) for which the Act gives concurrent jurisdiction to the Registrar and the Federal Court to decide at first instance.

[14] If these two requirements are not satisfied, then, in the absence of new evidence adduced on appeal, decisions of the Registrar within the Registrar’s area of expertise, whether on issues of fact, law or discretion, are to be reviewed on the reasonableness standard.

[15] The Applicant specifically argues that there are two issues in the Decision which must be reviewed on the correctness standard:

- (i) the question of whether three statements in the affidavit of Gurba dated July 27, 2017 [the Gurba Affidavit] are inadmissible hearsay [the “Hearsay Issue”]; and
- (ii) the Registrar’s interpretation of how one must furnish evidence to show use within the meaning of section 45 of the Act [the “Use Issue”].

[16] The Applicant's position is that both of these issues are questions of law which should be reviewed on the correctness standard.

[17] The Respondent agrees that in reviewing extricable questions of law, this Court should apply the correctness standard. However, the Respondent argues that neither of the above issues are questions of law.

[18] The Respondent distinguishes between (i) factual findings of the Registrar as to whether use is established based on the evidence before the Registrar; and (ii) an extricable question of law, such as whether profit is required to constitute use (as was at issue in *Lush*) which is a statutory interpretation. The Respondent argues that what is in dispute in this matter is not the legal meaning of use, but rather whether the facts as found by the Registrar were sufficient to constitute use.

[19] The Respondent did not address the appropriate standard of review for the Hearsay Issue.

A. *Use Issue*

[20] The Applicant frames this issue as whether the Registrar erred in interpreting what evidence can show use within the meaning of section 45 of the Act. I disagree, and would substantially adopt the Respondent's submissions on this point.

[21] In my opinion, the issue is whether the evidence contained in the Gurba Affidavit is sufficient to show use. This is not a question of law, but a question of mixed law and fact. The reasonableness standard should apply.

B. *Hearsay Issue*

[22] The admissibility of hearsay evidence is a question of law (*R v Youvarajah*, 2013 SCC 41 at para 31). Therefore, the issue of whether the statements contained in the Gurba Affidavit constitute inadmissible hearsay evidence is a question of law.

[23] However, this is not enough to attract the correctness standard of review. As outlined above, to fall within the exception outlined in *Lush*, there must be both:

- (1) a question of statutory interpretation,
- (2) for which the Act gives concurrent jurisdiction to the Registrar and the Federal Court to decide at first instance.

[24] The second prong of this test is met. Under the Act this Court has jurisdiction at first instance to rule on hearsay evidence, such as in infringement proceedings. However, the first prong is not met. Determining whether evidence is inadmissible hearsay is not a question of statutory interpretation.

[25] In *Lush*, the issue attracting the correctness standard was whether “use” under subsection 4(1) of the Act required actual profit. This was a question of statutory interpretation for which the Act gave concurrent jurisdiction to the Registrar and the Federal Court.

[26] Similarly, in *Rogers Communications Inc v Society of Composers, Authors and Music Publishers of Canada*, 2012 SCC 35, the issue was the meaning of the phrase “to the public” in paragraph 3(1)(f) of the *Copyright Act*, RSC 1985, c C-42 [“*Copyright Act*”]. Again, this was an

issue of statutory interpretation for which the *Copyright Act* gave concurrent jurisdiction to the underlying decision-maker and the Federal Court.

[27] The parties focused their submissions on whether the issues raised by the Applicant were questions of law – this is not the test. An issue of the admissibility of hearsay evidence, while a question of law, is not a question of statutory interpretation, and therefore does not fall within the exception articulated in the *Lush* decision. As a result, the reasonableness standard should apply.

V. Legislative Authority (Appendix A)

[28] The relevant provisions are exerted below in Appendix A.

VI. Analysis

A. *Applicant's arguments*

[29] The Applicant argues that the Respondent did not provide the information required by section 45 to show use of the Mark with respect to the services for which it was registered during the Relevant Period. The Applicant's position is that the evidence in support of use must be more than mere assertions of use, and requires the Registrar to ensure that reliable evidence is received and that ambiguous statements in an affidavit are not accepted.

[30] The Gurba Affidavit includes quotations from, and exhibits to, a letter to the Registrar of Trade-marks dated March 16, 2011, written by a colleague of Applicant's counsel and related to an application (No. 1432154) by the Applicant to register the trademark 'PENTASTAR'. This

letter was in response to an objection letter filed by the Respondent, based on Registration No. TMA635037 registered by the Respondent.

[31] As the Applicant cannot file evidence or cross-examine the Respondent on the Applicant's own evidence, the Applicant argues that the Decision is unreasonable in accepting the sworn statements as Gurba's evidence with no appropriately substantiating exhibits or evidence. By accepting the statements at face value without explanation, there is no demonstration of use, as required under the Act. Rather, the sworn statements simply state use or facts relating to use. Thus, the Applicant's position is that the Decision lacks transparency.

[32] Further, the Applicant argues that other exhibit evidence is also problematic. Starting with the photographs, there is no way to time stamp the photographs to ensure that the Mark was displayed in the performance of the services in Canada during the Relevant Period. The only reason that the Registrar accepted that the photos represented trademark usage in the Relevant Period was because of the statement in the affidavit by Gurba.

[33] The Applicant's position is that the Gurba Affidavit relied on hearsay evidence without explanation of necessity and reliability, and that the hearsay evidence was unreliable and unnecessary so should not be considered.

[34] The Applicant indicates that the evidence is also deficient for other reasons:

- (i) the evidence did not contain any documents to evidence a sale or performance of services in Canada or elsewhere — e.g., an invoice — during the Relevant Period, or at all;

- (ii) the evidence did not contain any summary or quantification (in dollars or volume) of the amount of sales of the services in Canada or elsewhere during the Relevant Period, or at all;
- (iii) the evidence did not address the normal commercial or other nature of the services purportedly performed;
- (iv) the evidence did not contain documents expressly showing use of the Mark with the services purportedly performed in Canada during the Relevant Period;
- (v) the evidence did not contain documents showing use of the Mark in the advertisement of the services during the Relevant Period;
- (vi) the evidence did not show use of the Mark in association with each of the services during the Relevant Period, nor did it explain the absence of use during this period;
- (vii) the Gurba Affidavit was little more than a bald allegation of use and was hearsay; and
- (viii) there was more evidence concerning goods than services, yet goods was expunged so clearly services should also have been expunged.

[35] Thus, the Applicant submits that the evidence was incomplete and ambiguous and does not meet the Respondent's onus, and therefore the Decision should be reviewed.

B. *Purpose of section 45*

[36] Section 45 is meant to “dislodge deadwood” from the Trademarks Register, not to determine the rights of the parties to the trademark. In *The House of Kwong Sang Hong International Ltd v Gervais*, 2004 FC 554 at para 18 [*“House of Kwong”*], Justice Noël examined when section 45 and section 57 of the Act should be utilized:

[18] A useful summary of the nature of Section 45 and...Proceedings can be found starting from par. 16 of *Osler, Hoskin & Harcourt v. United States Tobacco Co. et al.*, 1997

CanLII 5927 (FC), 77 C.P.R. (3d) 475, in which Mr. Justice Richard J. (as he was then), outlined the following:

Section 45 is intended to be a simple, summary and expeditious procedure for cleaning up the trade-mark register of trade-marks that have fallen in to disuse. It is designed to clear the dead wood from the register, not to resolve issues in contention between competing commercial interests, which should be resolved in expungement proceedings under section 57 [...]

Section 45 does not contemplate a determination on the issue of abandonment, but is merely a summary procedure whereby the registered owner of a mark is required to provide either some evidence of use in Canada or evidence of special circumstances that excuse the absence of use [...].

[Emphasis added]

[37] Here, as per *House of Kwong*, we have two parties with competing commercial interests. The evidence put forward by the Respondent “need only supply facts from which, on balance, a conclusion of use may follow as a logical inference” (*House of Kwong* at para 18).

[38] Similar language was used by then Chief Justice Lutfy in *1459243 Ontario Inc v Eva Gabor International, Ltd*, 2011 FC 18 at paras 4 and 5 [*Eva Gabor*]:

[4] The purpose of s. 45 is to provide a simple and expeditious method of expunging marks which have fallen into disuse. The provision has a public interest purpose; a person seeking an expungement under s. 45 need not have an interest in the matter. Section 45 does not finally determine rights between parties. It is not intended to create an adversarial process to determine complex issues of fact and law. Such a process is provided for in s. 57 of the Act.

[5] The burden of proof is on the applicant to establish use during the relevant time. **The threshold to establish use is relatively low. The applicant need only provide some evidence beyond a mere assertion that would allow the Registrar or the**

Court to conclude that the trade-mark was in use in the normal course of trade. There is no need or justification for “evidentiary overkill”. ...

[Emphasis added]

[39] It must be remembered that the Applicant chose section 45 rather than section 57 and that no new evidence was filed in this application.

C. *Did the Registrar improperly admit hearsay evidence?*

[40] The evidence relied on by Pentastar was supplied in the Gurba Affidavit. Mr. Gurba swore on personal knowledge as the Chief Financial Officer of Pentastar since June 1, 2014, and previously as the company’s Controller since June 1, 2005.

[41] The Applicant points out that Gurba did not even attach the company’s own website and instead attached a letter written by a colleague of counsel for the Applicant, discussed above, which included information taken from the website “companylisting.ca” and undated photographs showing use of the Mark.

[42] With regard to the website, I agree with the Applicant that this appears to be hearsay, in that it does not appear to meet the qualifications of reliability or necessity as has been the principled exceptions to hearsay. The website falls under the definition of what has been considered hearsay in *Venngo Inc v Concierge Connection Inc (Perkopolis)*, 2017 FCA 96 at para 69, “hearsay is an oral or written statement made by someone other than the witness that the witness testifies about and offers in an effort to establish that what was said is true”.

[43] However, Gurba swore personal knowledge of the information taken from the website regarding the company of which he was the Chief Financial Officer, and that was accepted by the officer as demonstrating that he would have personal knowledge. This determination did not necessitate that the officer go through the reliability and necessity evaluation.

[44] Further, Gurba, unlike in some of the other cases cited to me, did not swear the affidavit on information and belief, and this was considered by the officer at para 13 of the Decision:

[13] Mr. Gurba attests that the entity listed in the above-noted business listing printout and website is the Owner, that the descriptions in the printout of the Owner and of the information in the website are accurate, and that the activities described in the business listing extract occurred in Canada.

[45] The officer addressed the hearsay submissions at paras 19 and 20:

[19] In dealing with the hearsay submissions first, the Owner submits that the Requesting Party's submissions in this regard are irrelevant. In particular, the Owner submits that Mr. Gurba has **personal knowledge of the facts to which he attests, and he provides sworn statements to confirm that the description of the Owner contained in the website printouts included under Exhibit GG-1 is accurate.**

[20] **I agree. Given the nature of the affiant's position and tenure with the Owner, I accept that Mr. Gurba would have knowledge of the activities of the Owner, and I accept his sworn statement at face value** [*Rubicon Corp v Comalog Inc* (1990), 33 CPR (3d) 58 (TMOB)] In any event, I note that it has been held that the summary nature of cancellation proceedings are such that concerns regarding hearsay should generally only go to the weight given to evidence rather than admissibility [see *Derby Cycle Werk GmbH v Infinité Cycle Works Ltd*, 2013 TMOB 134 (CanLII), 113 CPR (4th) 412; *1459243 Ontario Inc v Eva Gabor International, Ltd et al*, 2011 FC 18 (CanLII), 90 CPR (4th) 277; and *Wishbua's Inc v Sandoz GmbH*, 2013 TMOB 208 (CanLII), 2013 CarswellNat 4700].

[Emphasis added]

[46] However, even if I am incorrect and the material attached is hearsay, the case law has generally held that a strict approach to hearsay is not appropriate in section 45 proceedings.

[47] In *Eva Gabor*, above, an affidavit was presented on information and belief and the respondent argued that the evidence should not be admitted as it was hearsay and did not meet the criteria of reliability and necessity (para 10). The affidavit was found to contain hearsay but was admitted as being reliable and necessary, as Chief Justice Lutfy stated at para 17 that admission was consistent with the nature and purpose of section 45:

[17] ... s. 45 proceedings are intended to be expeditious and straightforward. Requiring registrants to submit affidavits from several employees involved in the use of the trade-mark in addition to that of the owner, would not be keeping with the public interest purpose of s. 45, or consistent with the low threshold to establish use. Admitting Mr. Martin's evidence in this case, without requiring evidence from several employees, is consistent with the summary procedure that s. 45 is intended to create and with its public interest purpose.

[48] Chief Justice Lutfy indicated that any hearsay concerns would go to weight (para 18) and had said earlier at para 12: "Nevertheless, in the particular circumstances of this s. 45 proceeding, I would admit his evidence as reliable and necessary hearsay. A stricter approach to hearsay evidence may be appropriate under s. 57, where adversarial proceedings are intended to determine the rights of parties."

[49] In other words, the rule regarding hearsay is relaxed in the context of section 45 proceedings, which was precisely the holding in the Decision. Therefore, I will not interfere with the officer's original holding on the evidence.

[50] Additionally, even if I determined that the officer wrongly relied on hearsay evidence, this would involve the reweighing of the Gurba Affidavit evidence, which would breach the boundaries of what is generally accepted on judicial review of a section 45 analysis as courts have consistently held, including the Supreme Court of Canada in *Toronto (City) Board of Education v OSSTF, District 15*, [1997] 1 SCR 487 at para 48, that on judicial review, the court has a limited role in reweighing evidence.

D. *Was the Registrar's Decision reasonable in finding use of the Mark in association with services?*

[51] I must say it was easy when first reviewing the evidence to envision the evidence that the Respondent could have provided. But it must be kept in mind that the threshold for receipt of evidence on a section 45 proceeding is low. As I am not determining this matter *de novo*, I am reminded that the Registrar is prepared to accept evidence of that nature and in this case did.

[52] There is no particular kind or form of evidence which must be provided to satisfy the requirements of section 45 (*Sols R Isabelle Inc v Stikeman Elliott LLP*, 2011 FC 59 at para 17). The only requirement is that the registered owner must be able to establish a *prima facie* case of use.

[53] The Applicant has put forward no clear authority to demonstrate that anything further must be provided to demonstrate trademark use, other than continuously asking for substantiating and corroborating evidence, which again is not necessary.

[54] The officer, after stating that the purpose and scope of section 45 is to be a “simple, summary and expeditious procedure...”, found evidence that:

- (i) Pentastar is an Alberta based company that is “a leading contractor for transportation of all types of oilfield equipment”;
- (ii) the company “has the equipment, knowledge and expertise to accomplish the tasks of moving a drilling rig or performing a difficult off-road construction project”;
- (iii) business activities are “integrated products and services for the energy industry including productions services, field construction; oil field transportation; process equipment design and manufacturing” that is provided at “locations in the oil and gas producing areas of western North America”;
- (iv) “Other services are specialized construction in remote areas and moving of oil drilling rigs and associated equipment”;
- (v) Pentastar operates in five Canadian locations to serve the province of Alberta;
- (vi) the registered services are mentioned on Pentastar’s website along with pictures of drilling and oil service rigs and oil field equipment some of which bear the PENTASTAR trademark; and
- (vii) the Mark is displayed on equipment which Pentastar used while performing the services and this is confirmed by photographs that show heavy equipment and holding tanks with the PENTASTAR on them.

[55] Turning to the evidence, Gurba offered into evidence photographs showing use of the Mark, and swears that they are from the Relevant Period. As well, Mr. Gurba stated at para 5 of his affidavit:

[5] I make this affidavit to attest to Pentastar’s advertising and affixing, as applicable of the trade-mark PENTASTAR (“Trade-mark”) in Canada in association with “All terrain and off road vehicles used in oil field and other construction” (“Goods”) and “Movement of and erection of oil and gas drilling rigs; light oil field construction” (“Services”) **between December 29, 2012 and December 28, 2015 (“Relevant Period”)**. I confirm that all of Pentastar’s activities described in this Affidavit are representative of, and the same as, Pentastar’s activities during the Relevant Period.

[Emphasis added]

[56] The officer did address the argument by the Requesting Party that there were no sales transactions to show that the services were done in Canada during the Relevant Period as well as arguments much the same as submitted in this hearing that given the hearsay nature of the evidence, the photographs do not show movement, erection or construction of the rigs and at most show trademark use.

[57] The officer specifically spoke to the lack of sales transactions, saying that Gurba made sworn statements that confirmed that the transactions took place for the services in Canada during the Relevant Period. The officer did reject the lack of evidence for goods but went on to say at para 25 that the website printout that Gurba confirmed as being accurate refers to services only and not to goods. Therefore, the lack of sales transactions regarding services was not an issue for the officer considering the totality of the evidence.

[58] The officer dealt with the arguments by confirming that Gurba provided “clear sworn statements that the equipment bearing the Mark was used in the performance of the services” (para 21). Finally, at para 22, the officer stated that when the evidence was viewed in totality, including Gurba’s sworn direct knowledge evidence and the web printouts which Gurba attested were accurate, the officer accepted that the Mark was displayed in the performance of the services in Canada during the Relevant Period.

[59] Given the consistent line of jurisprudence regarding the treatment of evidence in section 45 proceedings, including Justice Laskin in *Lush* where he summarized that the burden of proof to show “use” was “light” and that the trademark owner “must only supply facts from

which a conclusion of use may follow as a logical inference” (para 10), I find that the officer was reasonable in determining that the Registration was compliant with section 45 of the Act with respect to services.

VII. Costs

[60] The Applicant (per rule 416(5) of the *Federal Courts Rules*, SOR/98-106) paid \$3,000.00 into court as security for costs. The parties were given the opportunity to reach an agreement regarding costs and to inform the court regarding the agreement.

[61] The parties have reached an agreement as to costs and will provide written submissions regarding the agreement within seven days of the date of the decision. The submissions are limited to five pages excluding schedules. The Applicant has filed a Bill of Costs and the Respondent is asked to do so within seven days of the date of the decision. An Order regarding costs will be issued separately.

JUDGMENT IN T-1715-18

THIS COURT'S JUDGMENT is that:

1. The Appeal is dismissed.
2. The parties will provide written submissions regarding the agreement regarding costs within seven days of the date of the decision. The submissions are limited to five pages excluding schedules. The Applicant has filed a Bill of Costs and the Respondent is asked to do so within seven days of the date of the decision. An Order regarding costs will be issued separately.

“Glennys L. McVeigh”

Judge

Appendix A

Trade-marks Act, RSC 1985, c T-13

Registrar may request evidence of user

45 (1) The Registrar may at any time and, at the written request made after three years from the date of the registration of a trade-mark by any person who pays the prescribed fee shall, unless the Registrar sees good reason to the contrary, give notice to the registered owner of the trade-mark requiring the registered owner to furnish within three months an affidavit or a statutory declaration showing, with respect to each of the goods or services specified in the registration, whether the trade-mark was in use in Canada at any time during the three year period immediately preceding the date of the notice and, if not, the date when it was last so in use and the reason for the absence of such use since that date.

Form of evidence

(2) The Registrar shall not receive any evidence other than the affidavit or statutory declaration, but may hear representations made by or on behalf of the registered owner of the trade-mark or by or on behalf of the person at whose request the notice was given.

Effect of non-use

(3) Where, by reason of the evidence furnished to the Registrar or the failure to furnish any evidence, it appears to the Registrar that a trade-mark, either with respect to all of the goods or services specified in the registration or with respect to any of those goods or services, was not used in Canada at any time during the three year period immediately preceding the date of the notice and that the absence of use has not been due to special circumstances that

Le registraire peut exiger une preuve d'emploi

45 (1) Le registraire peut, et doit sur demande écrite présentée après trois années à compter de la date de l'enregistrement d'une marque de commerce, par une personne qui verse les droits prescrits, à moins qu'il ne voie une raison valable à l'effet contraire, donner au propriétaire inscrit un avis lui enjoignant de fournir, dans les trois mois, un affidavit ou une déclaration solennelle indiquant, à l'égard de chacun des produits ou de chacun des services que spécifie l'enregistrement, si la marque de commerce a été employée au Canada à un moment quelconque au cours des trois ans précédant la date de l'avis et, dans la négative, la date où elle a été ainsi employée en dernier lieu et la raison de son défaut d'emploi depuis cette date.

Forme de la preuve

(2) Le registraire ne peut recevoir aucune preuve autre que cet affidavit ou cette déclaration solennelle, mais il peut entendre des représentations faites par le propriétaire inscrit de la marque de commerce ou pour celui-ci ou par la personne à la demande de qui l'avis a été donné ou pour celle-ci.

Effet du non-usage

(3) Lorsqu'il apparaît au registraire, en raison de la preuve qui lui est fournie ou du défaut de fournir une telle preuve, que la marque de commerce, soit à l'égard de la totalité des produits ou services spécifiés dans l'enregistrement, soit à l'égard de l'un de ces produits ou de l'un de ces services, n'a été employée au Canada à aucun moment au cours des trois ans précédant la date de l'avis et que le défaut d'emploi n'a pas été attribuable à des

excuse the absence of use, the registration of the trade-mark is liable to be expunged or amended accordingly.

Notice to owner

(4) When the Registrar reaches a decision whether or not the registration of a trade-mark ought to be expunged or amended, he shall give notice of his decision with the reasons therefor to the registered owner of the trade-mark and to the person at whose request the notice referred to in subsection (1) was given.

Action by Registrar

(5) The Registrar shall act in accordance with his decision if no appeal therefrom is taken within the time limited by this Act or, if an appeal is taken, shall act in accordance with the final judgment given in the appeal.

...

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 mark.

circonstances spéciales qui le justifient, l'enregistrement de cette marque de commerce est susceptible de radiation ou de modification en conséquence.

Avis au propriétaire

(4) Lorsque le registraire décide ou non de radier ou de modifier l'enregistrement de la marque de commerce, il notifie sa décision, avec les motifs pertinents, au propriétaire inscrit de la marque de commerce et à la personne à la demande de qui l'avis visé au paragraphe (1) a été donné.

Mesures à prendre par le registraire

(5) Le registraire agit en conformité avec sa décision si aucun appel n'en est interjeté dans le délai prévu par la présente loi ou, si un appel est interjeté, il agit en conformité avec le jugement définitif rendu dans cet appel.

...

Jurisdiction 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.

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-1715-18

STYLE OF CAUSE: FCA US LLC v PENTASTAR TRANSPORTATION LTD.

PLACE OF HEARING: OTTAWA, ONTARIO

DATE OF HEARING: APRIL 29, 2019

JUDGMENT AND REASONS: MCVEIGH J.

DATED: MAY 28, 2019

APPEARANCES:

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