

Federal Court



Cour fédérale

Date: 20141014

Docket: T-790-14

Citation: 2014 FC 967

Ottawa, Ontario, October 14, 2014

PRESENT: The Honourable Madam Justice Mactavish

BETWEEN:

Yael COHEN

Applicant

and

SUSAN FIEDLER INCORPORATED

Respondent

JUDGMENT AND REASONS

[1] Yael Cohen applied to register the ‘F CANCER & Design’ trade-mark shown below.



[2] Ms. Cohen’s application was based on her use of the mark in Canada since September 28, 2009 in association with apparel, specifically t-shirts and the operation of a charitable foundation concerned with the detection and prevention of cancer.

[3] Following advertisement of the mark for opposition purposes, the respondent, Susan Fiedler Incorporated, filed a statement of opposition, asserting unregistered trade-mark rights to ‘F CANCER’, ‘FUCK CANCER’, ‘F* CANCER’, and ‘F--- CANCER’ (collectively the Fiedler marks). The Fiedler marks had allegedly been used in Canada since May of 2008 in association with jewellery and fundraising charities relating to cancer.

[4] In dismissing Ms. Cohen’s application for registration, the Trade-Marks Opposition Board (TMOB) found that the respondent had established that the Fiedler marks had been used in Canada prior to the claimed date of first use of Ms. Cohen’s mark. The TMOB further found that the parties’ marks shared a significant degree of similarity in sound, appearance and idea suggested, concluding that Ms. Cohen had not demonstrated that there was no reasonable likelihood of confusion between the parties’ marks. Ms. Cohen does not now take issue with these findings.

[5] Instead, Ms. Cohen advances an entirely new argument in this Court, one that was never put before the TMOB, and one which, had it been accepted, would have been fatal to her application for registration. That is, Ms. Cohen now argues that the TMOB erred in recognizing the respondent’s common law rights to marks using the word “Fuck”, which, she says, is obscene, and therefore prohibited by paragraph 9(1)(j) of the *Trade-marks Act*, R.S.C. 1985, c. T-13.

[6] Paragraph 9(1)(j) of the *Trade-marks Act* states that “No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for ... any scandalous, obscene or immoral word or device”.

[7] It may appear somewhat counter-intuitive that Ms. Cohen would want to advance an argument that would, if accepted, be fatal to her own application for registration. However, she conceded at the hearing that what she hopes to achieve through this application is not the registration of her own 'F CANCER' mark, but a ruling from this Court that the respondent has no enforceable common law rights to its Fiedler marks.

[8] That this is what Ms. Cohen is seeking is confirmed by her request in her memorandum of fact and law that this Court issue an order that recognizes "that the phrase 'fuck cancer' and any variation thereof are prohibited marks to which no one can claim an enforceable right, whether registered or unregistered".

[9] This Court has the discretion not to consider an issue raised for the first time on judicial review where it would be inappropriate to do so. In my view, this is such a case. Consequently, Ms. Cohen's application for judicial review will be dismissed.

I. The Scope of the Court's Discretion not to Entertain a New Argument on Judicial Review

[10] In *Alberta (Information and Privacy Commissioner) v. Alberta Teachers' Association*, 2011 SCC 61, at para. 22, [2011] 3 S.C.R. 654, the Supreme Court of Canada observed that a party does not have the right to require the Court to consider an argument raised for the first time on judicial review.

[11] In support of this contention, the Court referred to its earlier decision in *Canadian Pacific Ltd. v. Matsqui Indian Band*, [1995] 1 S.C.R. 3, at para. 30, [1995] S.C.J. No. 1, where it observed that "[t]here is a long-standing general principle that the relief which a court may grant

by way of judicial review is, in essence, discretionary”, a principle that “flows from the fact that the prerogative writs are extraordinary remedies”.

[12] The Supreme Court held in *Alberta Teachers* that, as a general rule, the Court’s discretion will not be exercised in favour of an applicant “where the issue could have been but was not raised before the tribunal”: at para. 23.

[13] One of the rationales cited by the Supreme Court for this is that legislatures entrust the determination of particular issues to administrative tribunals: *Alberta Teachers*, above, at para. 24. Indeed, as the Supreme Court previously noted in *Dunsmuir v. New Brunswick*, 2008 SCC 9, at para. 27, [2008] 1 S.C.R. 190, “[c]ourts ... must be sensitive ... to the necessity of avoiding undue interference with the discharge of administrative functions in respect of the matters delegated to administrative bodies by Parliament and legislatures”.

[14] The result of this is that “courts should respect the legislative choice of the tribunal as the first instance decision maker by giving the tribunal the opportunity to deal with the issue first and to make its views known”: *Alberta Teachers*, above, at para. 24. This is especially so where, as here, the issue raised for the first time on judicial review relates to the TMOB’s specialized function and area of expertise: *Alberta Teachers*, above, at para. 25.

II. Should the Court Exercise its Discretion to Entertain a New Argument in this Case?

[15] Ms. Cohen has not provided a valid reason as to why she could not have raised her section 9 argument before the TMOB. According to her memorandum of fact and law, her change in position “arises on further reflection”: at para. 2. In other words, she did not think of it before.

[16] Ms. Cohen also suggests that her new argument arises out of the TMOB's reasons for refusing the application: Cohen memorandum, at paras. 2 and 10. I also do not accept this argument. Ms. Cohen knew from the outset what words were used in the marks in issue, and she is deemed to have knowledge of section 9 of the *Trade-marks Act*.

[17] It is, moreover, clear that Ms. Cohen is bringing this application for a collateral purpose. Despite the wording of her Notice of Application, she confirmed at the hearing that she is no longer seeking to have the TMOB's decision reversed, and her F CANCER mark registered. What she really wants is for this Court to re-write the TMOB's reasons for coming to the decision that it did as to the registrability of Ms. Cohen's 'F CANCER' mark.

[18] Ms. Cohen's argument is also based upon a flawed premise: namely, that all of the Fiedler marks are necessarily prohibited by operation of paragraph 9(1)(j) of the *Trade-marks Act*, and should not therefore have been considered by the TMOB.

[19] In support of her argument, Ms. Cohen relies upon the statement at paragraph 20 of the TMOB's reasons, where it states "The Opponent submits that the only purpose of the horizontal line in the trade-mark F--- CANCER is to truncate the word 'fuck' which is offensive to some and *itself not registrable as a trade-mark*" [my emphasis]. From this, Ms. Cohen says, it necessarily follows that none of the Fiedler marks are enforceable.

[20] If I were to accept this argument, it would, of course, leave Ms. Cohen at liberty to continue using her own 'F CANCER' mark and design in Canada.

[21] I do not, however, accept that by refusing to entertain Ms. Cohen's new argument, the respondent will end up with enforceable rights to the Fiedler marks to which it was not otherwise

lawfully entitled. Even if paragraph 9(1)(j) of the *Trade-marks Act* does potentially call into question the enforceability of the 'FUCK CANCER' Fiedler mark, it does not necessarily follow that the 'F CANCER', 'F* CANCER', and '--- CANCER' Fiedler marks are also unenforceable. Indeed, the fact that Ms. Cohen's 'F CANCER' mark made it through the approvals process suggests that such a mark may in fact be registrable.

[22] At the end of the day, however, that is a question that could, and should have been decided by the TMOB, the expert tribunal charged by Parliament with the authority to decide questions such as this.

III. Conclusion

[23] For these reasons, I decline to consider Ms. Cohen's section 9 argument, and her application for judicial review is dismissed.

[24] As was noted earlier, had Ms. Cohen's argument been accepted by this Court, it would have led to the conclusion that her own 'F CANCER' mark was not registrable. I agree with the respondent that for Ms. Cohen to argue that the trade-mark she herself applied to register is scandalous, obscene and/or immoral only *after* she has been unsuccessful in the opposition proceedings justifies an elevated award of costs.

JUDGMENT

THIS COURT ORDERS AND ADJUDGES that:

1. This application is dismissed, with costs to the respondent fixed in the amount of \$5,000.

"Anne L. Mactavish"

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-790-14

STYLE OF CAUSE: YAEL COHEN v SUSAN FIEDLER INCORPORATED

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