Federal Court of Appeal  Cour d'appel fédérale

Date: 20170509

Docket: A-338-16

Citation: 2017 FCA 98

CORAM: **PELLETIER J.A.**
WEBB J.A.
NEAR J.A.

BETWEEN:

TRADEMARK TOOLS INC.

Appellant

and

MILLER THOMSON LLP

Respondent

Heard at Toronto, Ontario, on May 9, 2017.

Judgment delivered from the Bench at Toronto, Ontario, on May 9, 2017.

REASONS FOR JUDGMENT OF THE COURT BY: PELLETIER J.A.

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REASONS FOR JUDGMENT OF THE COURT
(Delivered from the Bench at Toronto, Ontario, on May 9, 2017)

PELLETIER J.A.

[1] This is an appeal from a decision of the Federal Court, reported as 2016 FC 971, sitting on appeal from the registrar of Trademarks in a proceeding under s. 45 of the *Trade-marks Act*, RSC 1985 c. T-13. As the appellant did not lead any evidence of use before the Registrar, the Federal Court heard and decided the question of use within the relevant period at first instance.

[2] The standard of review is out in *Housen v. Nikolaisen*, 2002 SCC 33, correctness for questions of law and palpable and overriding error for questions of fact and questions of mixed fact and law, in the absence of an extricable question of law.

[3] The Federal Court found that use of the registered design mark had not been shown because the goods with which the design mark was used were not within the goods described in the registration. More specifically the Federal Court found that a tire gauge was not sufficiently similar to the kinds of tools listed in the registration.

[4] The Federal Court described the listed tools as carpentry tools. While this classification is perhaps unfortunate, it does not detract from the Federal Court's determination that the use of the registered mark in association with a tire gauge was not of a kind with use of the mark with the types of tools listed in the registration. This is not a palpable and overriding error.

[5] The Federal Court also found that the use of the word "logix" with variations from the registered design mark was not use of the registered mark. The appellant says that the Federal Court erred in law in not identifying the dominant feature of the registered which it says is the word "logix".

[6] We are unable to agree with this submission. A design mark has a specificity which distinguishes it from a word mark. Here, the Federal Court found that the use of "logix" with other characteristics than those described and shown in the registration was not use of the registered design mark. The use of comparisons drawn from other cases does not assist the appellant as each case must be decided on its merits. In addition, the Federal Court must be taken

to have considered the dominant feature of the registered trade-mark when it listed all the variations from the registered trade-mark and concluded that the mark as used did not retain the dominant feature of the registered trade-mark. We have not been persuaded that the Federal Court committed a palpable and overriding error in its treatment of this issue.

[7] For these reasons, the appeal will be dismissed with costs.

"J.D. Denis Pelletier"

J.A.

FEDERAL COURT OF APPEAL

NAMES OF COUNSEL AND SOLICITORS OF RECORD

DOCKET:	A-338-16
APPEAL FROM AN ORDER OF THE HONOURABLE MADAM JUSTICE MCDONALD OF THE FEDERAL COURT DATED AUGUST 26, 2016, DOCKET NO. T-1958-15.	
STYLE OF CAUSE:	TRADEMARK TOOLS INC. v. MILLER THOMSON LLP
PLACE OF HEARING:	Toronto, Ontario
DATE OF HEARING:	MAY 9, 2017
REASONS FOR JUDGMENT OF THE COURT BY:	PELLETIER J.A. WEBB J.A. NEAR J.A.
DELIVERED FROM THE BENCH BY:	PELLETIER J.A.

APPEARANCES:

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