

Federal Court



Cour fédérale

**Date: 20101004**

**Docket: T-1304-10**

**Citation: 2010 FC 986**

**BETWEEN:**

**BBM CANADA**

**Applicant**

**and**

**RESEARCH IN MOTION LIMITED**

**Respondent**

**REASONS FOR ORDER**

**HUGHES J.**

[1] These are the reasons for the Order issued in these proceedings on September 27, 2010. No reasons were provided at the time that the Order was granted since it was expected that the parties had essentially consented to the Order and would get on with the matter. However, I have since been advised that the Applicant has filed an appeal, therefore these reasons are provided to assist the parties and the Court that may hear the appeal.

[2] These proceedings were commenced as an application, a Notice of Application and two supporting affidavits were filed. The Notice of Application was quite detailed and set out a claim based on alleged infringement of several registered trade-marks owned by the Applicant and based on allegations of unfair competition arising out of section 7 of the *Trade-Marks Act*, RSC 1985, c. T-13. The relief claimed included an injunction, damages and other relief.

[3] The Respondent brought the motion at issue here objecting to the form in which these proceedings had been taken, taking the position that the proceedings should be taken by way of an action, not an application.

[4] This motion was heard before me on Monday, September 27, 2010. It had been placed first on the list of motions because I had understood that the Registry had been advised that the motion could be dealt with briefly. It was expected that most, if not all, matters had been settled. At the outset of the hearing Counsel advised that the matter had not been settled.

[5] I had read the materials submitted by both parties and was satisfied that these proceedings should proceed by way of an action. Rule 61(1) of this Court provides that all proceedings shall be commenced by way of an action unless, in accordance with Rule 61(4) there is specific statutory provision that a proceeding can be commenced otherwise, for instance by way of an application. An example of such a specific provision can be found in the *Copyright Act*, RSC 1985, c. C-42, section 34(4):

**Summary proceedings**

(4) *The following proceedings may be commenced or proceeded with by way of application or action and shall, in the case of an application, be heard and determined without delay and in a summary way:*

- (a) *proceedings for infringement of copyright or moral rights;*
- (b) *proceedings taken under section 44.1, 44.2 or 44.4; and*
- (c) *proceedings taken in respect of*

- (i) *a tariff certified by the Board under Part VII or VIII, or*

- (ii) *agreements referred to in section 70.12.*

**Requête ou action**

(4) *Les procédures suivantes peuvent être engagées ou continuées par une requête ou une action :*

- a) *les procédures pour violation du droit d'auteur ou des droits moraux;*
- b) *les procédures visées aux articles 44.1, 44.2 ou 44.4;*
- c) *les procédures relatives aux tarifs homologués par la Commission en vertu des parties VII et VIII ou aux ententes visées à l'article 70.12.*

*Le tribunal statue sur les requêtes sans délai et suivant une procédure sommaire.*

[6] The *Trade-Marks Act* makes specific provision for an application to be made where there has been an interim seizure of wares by Customs Officers (section 53.2). Proceedings to expunge a registration of a trade-mark can be commenced by way of an action, counterclaim in an action or application (section 58). Section 55 gives the Federal Court jurisdiction to hear “*any action or proceeding*” for the enforcement of any right under the Act. This is the section that is applicable when proceedings are instituted that allege infringement and unfair competition. Section 55 specifically refers to an action. It also refers to a proceeding but, unlike the *Copyright Act*, makes no specific provision that the proceeding be commenced and conducted by way of an application.

[7] At the hearing of the motion I expressed to Counsel for the Applicant my belief that the proceeding should be taken by way of an action where pleadings could be exchanged, including a Defence and issues defined. I asked Counsel why he wanted to proceed by way of an application. No good answer was provided. Counsel simply said that he believed that he properly could proceed by way of an application. I asked whether he believed if an application would be quicker and if so, offered to have the action case managed to see that this could be done. I asked whether he wanted an interlocutory injunction and pointed out that this could be done within an action. No response was given.

[8] Counsel for the Respondent pointed out that the Notice of Application was very detailed and could easily be re-titled as a Statement of Claim. I asked Counsel for the Respondent whether a Defence, and counter-claim if so advanced, would be filed within a fixed period of time and he agreed that it would.

[9] At this stage I adjourned the hearing for a few minutes to allow Counsel to draft an Order consistent with these discussions. Within a few minutes the terms of an Order in handwritten form were provided to the Registrar who provided them to me in chambers. My understanding was that the parties had consented to an Order as set out therefore the Order was typed out, signed by me and issued.

[10] Later that same day the Court received a letter from Counsel for the Applicant stating that his consent was only “as to form”. Believing that, in any event, the parties were content to proceed in the manner provided by the Order, I amended the Order to state that the consent was “as to form”.

[11] The Order is consistent with my disposition of the matter, it is most appropriate to proceed by way of an action, a fixed time limit for a Defence is provided and the matter is to be case managed.

“Roger T. Hughes”

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Judge

Toronto, Ontario  
October 4, 2010

**FEDERAL COURT**

**SOLICITORS OF RECORD**

**DOCKET:** T-1304-10

**STYLE OF CAUSE:** BBM CANADA v.  
RESEARCH IN MOTION LIMITED

**PLACE OF HEARING:** Toronto, Ontario

**DATE OF HEARING:** September 27, 2010

**REASONS FOR ORDER:** HUGHES J.

**DATED:** OCTOBER 4, 2010

**APPEARANCES:**

Mr. Peter Wells FOR THE APPLICANT

Mr. Trent Horne FOR THE RESPONDENT

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