

Federal Court



Cour fédérale

Date: 20101130

Docket: T-104-10

Citation 2010 FC 1207

Ottawa, Ontario, November 30, 2010

PRESENT: The Honourable Mr. Justice Zinn

BETWEEN:

**VANCOUVER ASSOCIATION FOR
INJURED MOTORCYCLISTS**

Applicant

and

**ALLIANCE FOR INJURED
MOTORCYCLISTS CANADA**

Respondent

REASONS FOR JUDGMENT AND JUDGMENT

[1] This is an application by the Vancouver Association for Injured Motorcyclists (AIM) seeking an order striking out from the Register of Trade-marks Trade-mark Registration No. TMA 631,011 (the impugned registration), which is held by the Alliance for Injured Motorcyclists Canada (AIMCan).

[2] AIM is an organization dedicated to assisting injured motorcyclists and promoting road safety for motorcyclists, and is a not-for-profit society under the British Columbia *Society Act*,

R.S.B.C. 1996, c. 433, and is a registered charity under the federal *Income Tax Act*, R.S.C. 1985, c. 1. AIM has been in continuous operation since 1983, and provides assistance to motorcycle accident victims through vocational assistance, rehabilitation, moral support, legal referrals and public awareness campaigns. AIM has used the following trade-mark in association with the services it provides since 1983:



[3] AIM has used the trade-mark in its publications and on a variety of paraphernalia, including bumper stickers, pins, clothing and pens. AIM has a number of chapters throughout British Columbia and it has permitted them to use the trade-mark.

[4] In or around 1996, members of AIM and the AIM Chapters began discussing the potential for a national organization which would coordinate the provision of services across Canada. To this end, AIMCan was incorporated on September 20, 2002. Around this time, AIMCan adopted the following trade-mark logo:



[5] AIMCan applied for registration of the AIMCan trade-mark (the impugned registration) and it was registered to AIMCan on January 25, 2005.

[6] AIM brought this application on January 22, 2010, alleging that the impugned registration was invalid on the grounds that:

1. the impugned registration is invalid under s. 18(1) of the *Trade-marks Act* because on the date of first use of the impugned trade-mark, it was confusing with the AIM trade-mark, which had been previously used in Canada by AIM, and accordingly AIMCan was not entitled to use the impugned trade-mark as per s. 16(1)(a) of the *Trade-marks Act*; and
2. the impugned registration is invalid under s. 18(1)(b) of the *Trade-marks Act* because at the time the application was brought, the impugned trade-mark did not distinguish the wares and services in association with which it was used by AIMCan from the wares and services of AIM, and the impugned trade-mark was not adapted so as to distinguish them.

[7] On March 17, 2010, Prothonotary Lafrenière dismissed AIMCan's motion for leave of the Court to allow its officers to represent the corporation without counsel. Prothonotary Lafrenière's Order was appealed, and Justice Gauthier dismissed the appeal on April 30, 2010. AIMCan was not represented in this application and other than filing a Notice of Appearance, it has not filed any responding materials.

[8] The applicant sets out three issues in its Memorandum of Fact and Law:

1. Whether AIM is a "person interested" under s. 57(1) of the *Trade-marks Act*, and thus whether AIM has standing to bring the application;
2. When AIMCan or its predecessor first used the AIMCan trade-mark; and

3. Whether the impugned registration should be struck out from the Register of Trade-Marks under s. 57 of the *Trade-marks Act* because it does not accurately express or define the rights of AIMCan.

[9] AIM submits that where an applicant for expungement claims that a trade-mark registered by another is confusing with a trade-mark previously used by the applicant, that applicant is a “person interested” within the meaning of s. 2 of the *Trade-marks Act*, R.S.C. 1985, c. T-13. AIM submits that it used the AIM trade-mark before the use of the AIMCan trade-mark, that the AIMCan trade-mark is confusing with the AIM trade-mark, that the continued registration of the AIMCan trade-mark will likely prevent registration of the AIM trade-mark, and that the use and registration of the AIMCan trade-mark may erode the distinctiveness of the AIM trade-mark and depreciate the goodwill and reputation of the AIM trade-mark.

[10] The applicant is clearly a “person interested.” In my view, it has provided strong reasons why it is affected by the registration of the AIMCan trade-mark. I agree with the applicant that *John Labatt Ltd. v. Carling Breweries Ltd.* (1974), 18 C.P.R. (2d) 15 (F.C.T.D.), provides that the term “person interested” is very broad. Further, support for the ease with which the threshold of “person interested” can be met is provided by Justice Phelan’s recent interpretation of *John Labatt Ltd.* as setting out a “*de minimis*” threshold for standing: *CIBC World Markets Inc. v. Stenner Financial Services Ltd.*, 2010 FC 397.

[11] The impugned registration claims the use of the AIMCan trade-mark since May 24, 1996, and June 1, 1999, in respect of the various wares and services it provides. AIM submits that AIMCan could not have been using the trade-mark since those dates since AIMCan was not even incorporated until 2002. Further, there is no evidence before the Court that there was a predecessor in title to AIMCan that first used the impugned trade-mark. I agree with the applicant that as there is no evidence of any use of the impugned trade-mark prior to AIMCan's incorporation in 2002, the date of incorporation should be the relevant date of use.

[12] The applicant has presented evidence that it has used the AIM trade-mark in Canada since at least 1983, this includes evidence relating to:

- use on the AIM website since June 2003, and statistics tracking visits to the site;
- goods bearing the AIM trade-mark, including pins and bumper stickers since 1985;
- printed publications such as newsletters distributed to the public since 1984;
- brochures, calendars and membership cards distributed since 1984, trip logs since 2008 or 2009, and recovery journals since 2009;
- details of expenditures on printing the various materials;
- events organized by AIM to raise funds and awareness, at which the AIM trade-mark is prominently displayed, since 1983; and
- in-person hospital visitations to motorcycle accident victims since the early 1980s, during which time materials bearing the AIM trade-mark were distributed.

This evidence satisfies the Court that AIM used the AIM trade-mark in Canada well before AIMCan used the AIMCan trade-mark.

[13] The applicant also provides significant evidence of the use of the AIM trade-mark by chapters of AIM established by AIM or with its agreement. Because AIM has satisfied the Court that its own use of the trade-mark pre-dates the use by AIMCan of the AIMCan trade-mark, it is unnecessary to consider this additional evidence.

[14] The Court finds that AIM has gained reputation and goodwill, especially in British Columbia. In order to support its operation AIM recruits members who contribute membership fees and donations and receive newsletters and membership cards bearing the AIM trade-mark. AIM has received public recognition and been the subject of media reports.

[15] I find that AIMCan makes use of the AIMCan trade-mark in the same area as the AIM trade-mark, which would likely lead to the inference that the associated services are performed by the same person. Accordingly, the AIMCan trade-mark is confusing within the meaning of ss. 2 and 6(2) of the *Trade-marks Act*.

[16] Considering the factors set out in s. 6(5) of the *Trade-marks Act*, I find the marks to be confusing because:

- (i) both trade-marks have similar degrees of inherent distinctiveness, but the AIM trade-mark has become known to a significantly greater extent;
- (ii) AIM has used its trade-mark for a much longer period of time than AIMCan has (nearly 20 years longer);

- (iii) the wares and services of AIM are effectively the same as the wares and services described in the impugned registration and travel through identical channels of trade; and
- (iv) the two trade-marks have a high degree of similarity in appearance, sound, and ideas suggested, since they are both round, both include the words “injured motorcyclists” surrounding the acronym AIM, and since “alliance” and “association” both suggest the same idea.

[17] The applicant is entitled to have the impugned trade-mark struck out from the register. The respondent was not entitled to register the AIMCan trade-mark by virtue of s. 16(1)(a) of the *Trade-marks Act* because it was confusing with a trade-mark already in use in Canada. Furthermore and for many of the same reasons, the impugned trade-mark is not distinctive and is thus invalid under s. 18(1)(b) of the Act. Considering the similarities of the trade-marks, the products, and the audience being targeted, it has been established that the AIMCan trade-mark is confusing with the AIM trade-mark.

[18] For these reasons the Court grants a declaration that the impugned registration is invalid and, under s. 57 of the *Trade-marks Act*, orders the impugned registration struck from the Register of Trade-marks.

[19] The applicant is entitled to its costs, which are fixed at \$3,000.00 inclusive of fees, disbursements and taxes.

JUDGMENT

THIS COURT'S JUDGMENT IS that:

1. This application is granted;
2. The Registrar of Trade Marks is to expunge registration number TMA 631,011; and
3. The applicant is awarded costs, fixed at \$3,000.00 inclusive of fees, disbursements and taxes.

“Russel W. Zinn”

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-104-10

STYLE OF CAUSE: VANCOUVER ASSOCIATION FOR INJURED
MOTORCYCLISTS v. ALLIANCE FOR INJURED
MOTORCYCLISTS CANADA

PLACE OF HEARING: Vancouver, British Columbia

DATE OF HEARING: November 18, 2010

**REASONS FOR JUDGMENT
AND JUDGMENT:** ZINN J.

DATED: November 30, 2010

APPEARANCES:

Karen F. MacDonald FOR THE APPLICANT
Jonas H. Gifford

No Appearance FOR THE RESPONDENT

SOLICITORS OF RECORD:

SMART & BIGGAR FOR THE APPLICANT
Barristers & Solicitors
Vancouver, British Columbia

NOT APPOINTED FOR THE RESPONDENT