

Federal Court



Cour fédérale

Date: 20220513

Docket: T-969-21

Citation: 2022 FC 721

Ottawa, Ontario, May 13, 2022

PRESENT: THE CHIEF JUSTICE

BETWEEN:

TECHNO-PIEUX INC.

Plaintiff

and

**TECHNO PILES INC., TECHNO METAL POST MEDECINE HAT INC.,
TECHNO METAL POST FORT MCMURRAY INC.,
MATHIEU BERGEVIN, AND RONDA BERTRAM**

Defendants

AND BETWEEN:

**TECHNO PILES INC., TECHNO METAL POST MEDECINE HAT INC.,
TECHNO METAL POST FORT MCMURRAY INC.,
MATHIEU BERGEVIN, AND RONDA BERTRAM**

Plaintiffs by Counterclaim

and

TECHNO-PIEUX INC.

Defendant by Counterclaim

ORDER AND REASONS

I. Introduction

[1] The Court is committed to reducing the time and costs associated with disputes it is called upon to adjudicate. To this end, two important procedural mechanisms that are available are: (i) a motion for summary judgment, and (ii) a motion for summary trial. Parties are well advised to carefully think about the relative merits of each.

[2] These reasons concern two Motions for summary judgment. They each relate to a dispute regarding trademarks and trade names.

[3] In the first Motion, the Plaintiff, Techno-Pieux Inc. [**Techno-Pieux**], seeks a broad range of declaratory, injunctive and other relief against the Defendants. In addition, it seeks an Order directing that the issues of its entitlement to monetary relief, and the quantum of such relief, be referred to a trial of those issues or a reference under Rule 153 of the *Federal Courts Rules*, SOR/98-106 [the **Rules**]. Those issues arise in relation to alleged violations of the Plaintiff's rights under the *Trademarks Act*, RSC 1985, c T-13 and the *Copyright Act*, RSC 1985, c C-42.

[4] In the second Motion [the **Cross-Motion**], the Defendants seek an Order declaring that the trademarks asserted by Techno-Pieux are invalid and should therefore be expunged from the Register of Trademarks. The Defendants also seek an Order dismissing Techno-Pieux's underlying action in its entirety, and granting them their costs on a solicitor-client basis. In the alternative, they seek an order dismissing the action as against the Defendants Techno Piles Inc.,

Ronda Bertram and Mathieu Bergevin. I pause to observe that they do not seek any relief under the *Copyright Act*.

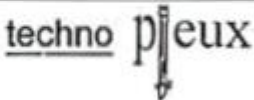

[5] I have concluded that the parties have failed to satisfy the test to be met on a Motion for summary judgment. In brief, they have failed to demonstrate that there is no genuine issue for trial in relation to the substantive relief they seek in their respective Motions. Accordingly, both Motions will be dismissed.

II. The Parties and Their Disputed Marks/Copyrighted Works

A. *Techno-Pieux*

[6] Techno-Pieux is a Quebec-based supplier of helical piles and associated materials and machinery for residential and industrial applications. It markets and sells its products throughout Canada and abroad.

[7] Techno-Pieux is the owner of the following registered Canadian Trademarks [the **Registered Marks**]:

<u>Registration Number</u>	<u>Registration Date</u>	<u>Trademark</u>
TMA562798	May 29, 2002	
TMA596228	December 2, 2003	TECHNO METAL POST
TMA638884	May 3, 2005	
TMA950281	September 23, 2016	TECHNO PIEUX

[8] The first three of the above-mentioned marks are registered in respect of the following goods and services: (i) goods – foundations pillars, foundations posts, foundations stake, foundations piles; and instruments to determine the load-bearing capacity of foundations footings and piles; (ii) services – engineering services in the design of foundations and performance of test for foundations.

[9] The fourth mark, TECHNO PIEUX, is registered for the same services as the first three, but for goods that are very different and not within the purview of the parties' dispute. Accordingly, that trademark will not be further discussed in respect of the goods identified immediately above.

[10] Techno-Pieux also asserts copyright in the Techno-Pieux logo (TMA562798), Techno Metal Post logo (TMA638884) and the following post design [collectively, the **Copyrighted Works**]:



[11] Through its network of licensees and distributors, Techno-Pieux has offered its goods and services in association with the trade names “Techno Pieux” and “Techno Metal Post” and the Registered Marks since at least 2002.

[12] In Alberta, Techno-Pieux operates through its affiliate Techno Metal Post Alberta Inc., which in turn sells to licensees and distributors in that province.

B. *The Defendants*

[13] Techno Metal Post Medicine Hat Inc. [**TMP Medicine Hat**] is an Alberta-based company that began distributing Techno-Pieux’s goods and services soon after its incorporation in the fall of 2015, pursuant to a Distributorship and Procurement Agreement dated October 9, 2015. At that time, TMP Medicine Hat was owned and operated by Rosaire Belisle. However, in the fall of 2018 it was sold to the two individual Defendants, Mr. Bergevin and Ms. Bertram. They have owned and operated it as the sole shareholders, directors, executives and employees

(with one unimportant exception) since that time, although they also work with independent contractors.

[14] Techno Metal Post Fort McMurray Inc. [**TMP Fort McMurray**] is an Alberta-based company that began distributing Techno-Pieux's goods and services soon after its incorporation in late 2016, pursuant to a Distributorship and Procurement Agreement dated November 28, 2016. From the outset, TMP Fort McMurray has been owned and operated by Mr. Bergevin and Ms. Bertram, who have also been the sole shareholders, directors, executives and employees (with one unimportant exception). As with TMP Medicine Hat, it works with independent contractors.

[15] Techno Piles Inc. is an Alberta-based entity that was incorporated in January 2020. According to the Defendants, it has not yet operated in any meaningful manner. However, it was used to register the domain name <http://www.technopilesinc.com>, which is linked to email accounts and a website used by some or all of the Defendants.

III. Factual Background

[16] The relationship between the parties took a significant turn for the worse in June 2020, when the Plaintiff wrote to Mr. Bergevin to summarize various difficulties that had arisen in their dealings. At that time, the Plaintiff informed Mr. Bergevin that it had decided that it was impossible to continue working with him and that, therefore, its distribution agreements with TMP Medicine Hat and TMP Fort McMurray [together, the **Disputed Distribution Agreements**] would be terminated in December of that year.

[17] In February 2021, the Plaintiff sent another letter to Mr. Bergevin to provide notice of the termination of the Disputed Distribution Agreements, effective August 16, 2021.

[18] After further correspondence between the parties, the Plaintiff advised Mr. Bergevin on May 20, 2021 that such termination would be effective at the end of that month.

[19] On May 30, 2021, TMP Medicine Hat and TMP Fort McMurray [the “Principal Corporate Defendants”] announced a “rebranding”. Among other things, that announcement stated: “[W]e are shutting down our Techno Metal Post Fort McMurray and Medicine Hat email and moving everything over to Techno Piles Inc. Our personal emails and info email will no longer be valid after today.” After listing the new email addresses, the announcement stated, “We still have our same great companies only the name is changing.” It appears to be common ground between the parties that the Principal Corporate Defendants have been using the trade names TECHNO PILES MEDICINE HAT and TECHNO PILES FORT MCMURRAY, respectively, as well as TECHNO PILES (Corporate Registration #TN23307416 and #TN23307374, respectively) since approximately that time.

[20] In June 2021, the Plaintiff initiated an action for breach of contract in the Court of Queen’s Bench of Alberta [the **Alberta Action**], followed by its underlying action in the present proceeding.

[21] In the Alberta Action, the Defendants maintain that the Plaintiff had no right to terminate the Disputed Distribution Agreements and that therefore those agreements remain in force.

IV. The Plaintiff's Motion

A. *Summary of Relief Sought*

[22] In its Amended Notice of Motion, the Plaintiff seeks extensive declaratory, injunctive and other relief against the Defendants.

[23] In summary, the Plaintiff seeks declarations that the Defendants have:

- i. infringed the four Registered Trademarks, contrary to sections 19 and 20 of the *Trademarks Act*;
- ii. used those marks in a manner likely to have the effect of depreciating the value of the goodwill attached thereto, contrary to section 22 of that legislation;
- iii. directed attention to their goods, services and business in such a way as to be likely to cause confusion in Canada between their goods, services and business and those of the Plaintiff, contrary to section 7(b) of the legislation;
- iv. used and continue to use, in connection with the goods and services in question, a description that is false in a material respect and is of such a nature as to mislead the public as regards to the character or quality of such goods and services, contrary to section 7(d) of the legislation; and

- v. infringed and are deemed to have infringed their copyright in the Copyrighted Works, contrary to sections 3 and 27 of the *Copyright Act*.

[24] In essence, the injunctive relief sought by the Plaintiff corresponds to the alleged contraventions of the *Trademarks Act* and the *Copyright Act*, described above.

[25] The other relief sought by the Plaintiff consists largely of directive relief, including the destruction of all allegedly contravening articles in the Defendants' possession, custody or power, the change of the names of the three corporate Defendants, and the relief regarding damages that is described at paragraph 3 above.

B. *Preliminary Issue*

[26] The Defendants maintain that the issue of the Plaintiff's right to terminate the Disputed Distribution Agreements needs to be determined in the Alberta Action before the Plaintiff's allegations in this Court can be addressed. In support of this position, they assert that if they are successful with their position that Disputed Distribution Agreements have not been legitimately terminated, "then a license has been in place for the entire period of time at issue, and there can be no trademark infringement." I disagree.

[27] During the hearing of this Motion, the Plaintiff represented to the Court that it is not alleging any infringements under the *Trademarks Act* or the *Copyright Act* in the Alberta Action. It added that the present Motion is limited to the Defendants' use of the trade names that include the words "TECHNO PILES," and that it has not made any allegations regarding the

Defendants' use of those trade names in the Alberta Action. These representations were not contested by the Defendants.

[28] With one exception, the references to the words "TECHNO PILES" in the Alberta Action pleadings have nothing to do with the allegations and representations made before this Court. The one exception pertains to the Defendants' position that Techno Piles Inc. is a dormant company. In addition, the only references to the words "trademark" or "trademarks" refer to the Plaintiff's trademarks. They do not relate to the TECHNO PILES trade names/marks that are the focus of the proceeding in this Court.

[29] Notwithstanding the foregoing, the Defendants maintain that the issue of whether they have the right to use TECHNO PILES as a trade name or trademark remains a contractual interpretation issue that ought to be determined in the Alberta Action, together with the other contractual issues that the Plaintiff brought before that Court. In support of this position, they note that the Plaintiff's Statement of Claim in the Alberta Action references sections 6.3 and 6.5 of the Disputed Agreements. Those sections state:

6.3 All of the Dealer's business vehicles shall be painted in the White Color with approved trademark lettering from [Techno-Pieux Inc.]

...

6.5 The dealer [*sic*] recognizes that valuable goodwill is associated with these trademarks, and, consequently, the Dealer agrees to use said trademarks in any manner, provided that the trademark is not altered in any way, shape or form, and is expressly authorized by TPI.

[30] However, the foregoing provisions are mentioned in the Statement of Claim filed in that proceeding solely as part of an overview of the Disputed Distribution Agreements. There is no mention of them, or of the words “trademark,” or “trademarks,” in the sections of the Statement of Claim dealing with the alleged breaches of the agreements between the parties, or the relief sought. The Statement of Claim also does not mention the word “copyright”. For greater certainty, there are no references to the *Trademarks Act* or the *Copyright Act*.

[31] The Defendants further maintain that the Disputed Distribution Agreements do in fact provide the right to use the TECHNO PILES trade name and trademark, “either through the interpretation of the contractual license, or as mitigation based on the Plaintiff’s contractual breach.” They therefore assert that this Court should wait for the Alberta Court to address this issue, before dealing with the present Motion. However, once again, there is no reference whatsoever to this allegation in the pleadings in the Alberta Action that are attached at Exhibits C, D and E, respectively, to Ms. Bertram’s Affidavit in this proceeding [the **Bertram Affidavit**]. Indeed, this alleged right is not apparent from a plain reading of the Disputed Distribution Agreements.

[32] Even if, as the Defendants assert, the general issue of their need to take mitigation measures in the face of the Plaintiff’s purported termination of the Disputed Distribution Agreements is before the Alberta Court of Queen’s Bench, it does not appear that this extends to the narrower issues that have been raised on this Motion. Those issues concern the Defendants’ use of trademarks, trade names, logos and designs that are alleged to violate the *Trademarks Act* and the *Copyright Act*. It is one thing to mitigate one’s losses by rebranding. It is quite another to

do so in a manner that may be found to have violated the *Trademarks Act* and/or the *Copyright Act*.

[33] I agree with the Plaintiff that it cannot reasonably be suggested that the Disputed Distribution Agreements permit or contemplate the use of the TECHNO PILES trade names, marks, logo or design.

[34] Consequently, I do not see material scope for potential overlap between the issues that have been raised in the Alberta Action and those that have been raised on the present Motion. It follows that I also do not see material scope for potentially inconsistent decisions to be made in the two proceedings.

[35] Having regard to the foregoing, I disagree with the Defendants' position that the present Motion cannot be considered before the contractual disputes that are at issue in the Alberta Action have been determined. For greater certainty, I consider that the issues raised on this Motion can be determined without having to address any of the contractual interpretation issues that are in dispute in the Alberta Action, and without having to address sections 6.3 and 6.5 of the Disputed Distribution Agreements.

[36] I will pause to observe that, on cross-examination on her affidavit, Ms. Bertram acknowledged that the Plaintiff never gave permission to the Principal Corporate Defendants to operate as TECHNO PILES.

C. *Analysis*

(1) The Test for Summary Judgment

[37] The Court may grant summary judgment where it is satisfied that there is no genuine issue for trial: Rule 215(1). This test must be interpreted broadly, favouring proportionality and fair access to the affordable, timely and just adjudication of claims that have been made: *Hryniak v Mauldin*, 2014 SCC 7 at para 5 [*Hryniak*].

[38] Where the Court is able to make the necessary findings of fact, apply the law to those facts, and achieve a fair and just determination on the merits, it would ordinarily be appropriate to grant a Motion for summary judgment: *Hryniak*, above, at paras 4 and 49.¹ In this regard, the standard for fairness is not whether the procedure is as exhaustive as a trial, but whether it gives the Court confidence that it can make the requisite factual findings and apply the relevant legal principles so as to resolve the dispute: *Hryniak*, above, at para 50.

[39] This will be the case when the Court is satisfied that “the case is clearly without foundation, or is so doubtful that it does not deserve consideration by the trier of fact at a future trial”: *Canmar Foods Ltd. v TA Foods Ltd.*, 2021 FCA 7 at para 24 [*Canmar*].

¹Although this principle was stated in connection with the more liberal test for summary judgment that exists in Ontario, I consider that it would ordinarily apply to this Court’s consideration of motions brought under Rule 215. The test in Ontario is more liberal because it requires the court to grant summary judgment if, among other things, “the court is satisfied that there is no genuine issue requiring a trial with respect to a claim or defence”: *Rules of Civil Procedure*, RRO 1990, Reg 194, Rule 20.04(2)(a) [emphasis added]; see *Hryniak*, above, at paras 42–43.

[40] Although the burden falls on the moving party, both parties must put their best foot forward. Among other things, this requires the responding party to “come up with specific facts showing that there is a genuine issue for trial”: *Canmar*, above, at para 27

(2) Trademark Infringement (s. 20(1)(a))

(a) *Introduction and Applicable Legal Principles*

[41] In its Motion, the Plaintiff seeks a declaration that the Defendants have infringed and are deemed to have infringed its Registered Marks, contrary to sections 19 and 20 of the *Trademarks Act*. In furtherance of that request, the Plaintiff’s written submissions focus on its allegation that the TECHNO PILE tradenames/marks are confusingly similar to the Registered Marks, as contemplated by section 20(1)(a) of that legislation. The Plaintiff has not alleged that those tradenames/marks are identical to the Registered Marks, as required by section 19: *Sandhu Singh Hamdard Trust v Navsun Holdings Ltd.*, 2019 FCA 295 at para 20 [*Sandhu*]. Consequently, the focus of the discussion below will be on section 20(1)(a).² The full text of section 20(1)(a) and the other provisions discussed below is set forth in Appendix 1 hereto.

[42] Paragraph 20(1)(a) deems the exclusive right to use a registered trademark throughout Canada to be infringed by any person who is not entitled to use that trademark and who sells, distributes or advertises any goods or services in association with a *confusing* trademark or trade name.

²Section 19 remains relevant to this Motion, because it provides the Plaintiff with the exclusive right to use the Registered Trademarks throughout Canada, in respect of the goods and services described in the trademark registration.

[43] In considering whether a trademark or trade name is confusing, section 6 of the legislation provides some important parameters. In particular, subsection 6(2) states as follows:

Confusion – trademark with other trademark

6 (2) The use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

Marque de commerce créant de la confusion avec une autre

6 (2) L'emploi d'une marque de commerce crée de la confusion avec une autre marque de commerce lorsque l'emploi des deux marques de commerce dans la même région serait susceptible de faire conclure que les produits liés à ces marques de commerce sont fabriqués, vendus, donnés à bail ou loués, ou que les services liés à ces marques sont loués ou exécutés, par la même personne, que ces produits ou services soient ou non de la même catégorie générale ou figurent ou non dans la même classe de la classification de Nice.

[44] Subsection 6(3) articulates essentially the same test with respect to confusion caused by the use of a trademark, relative to an existing trade name. The same is true regarding subsection 6(4), albeit in relation to the confusion caused by the use of a trade name, relative to an existing trademark.

[45] The factors to be assessed in determining whether trademarks or trade names are confusing are set forth in subsection 6(5), which states as follows:

What to be considered

6 (5) In determining whether trademarks or trade names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including

(a) the inherent distinctiveness of the trademarks or trade names and the extent to which they have become known;

(b) the length of time the trademarks or trade names have been in use;

(c) the nature of the goods, services or business;

(d) the nature of the trade; and

(e) the degree of resemblance between the trademarks or trade names, including in appearance or sound or in the ideas suggested by them.

Éléments d'appréciation

6 (5) En décidant si des marques de commerce ou des noms commerciaux créent de la confusion, le tribunal ou le registraire, selon le cas, tient compte de toutes les circonstances de l'espèce, y compris :

a) le caractère distinctif inhérent des marques de commerce ou noms commerciaux, et la mesure dans laquelle ils sont devenus connus;

b) la période pendant laquelle les marques de commerce ou noms commerciaux ont été en usage;

c) le genre de produits, services ou entreprises;

d) la nature du commerce;

e) le degré de ressemblance entre les marques de commerce ou les noms commerciaux, notamment dans la présentation ou le son, ou dans les idées qu'ils suggèrent.

[46] Some of the foregoing factors may not be particularly relevant in a specific case. In any event, their weight will vary with “all the surrounding circumstances”: *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 27 [*Veuve Clicquot*].

[47] In considering the relevant factors and the other surrounding circumstances, the Court's perspective must be that of a casual consumer, somewhat in a hurry. More specifically:

The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the name [TECHNO PILES on the Defendants'] storefront or invoice, at a time when he or she has no more than an imperfect recollection of the [Techno-Pieux/Techno Metal Post] trade-marks, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

Veuve Clicquot, above, at para 20.

[48] Stated differently, the issue to be determined is whether, as a matter of first impression, the "casual consumer somewhat in a hurry" who sees the TECHNO PILES tradenames/marks would likely be confused. In making this determination, it should be assumed that the consumer in question has the additional attributes described in the passage quoted immediately above: see also *Masterpiece Inc. v Alavida Lifestyles Inc.*, 2011 SCC 27 at paras 40–41 [*Masterpiece*].

[49] For greater certainty, the relevant consumer is the consumer in the market in question. Where, as in the present case, the goods and services are expensive or important, the Court must be alive to the possibility that the relevant consumer may "be somewhat more alert and aware of" the defendant's marks: *Masterpiece*, above, at paras 69–70. Nevertheless, that consumer must still be considered to have the attributes described in the two immediately preceding paragraphs. The fact that they may be likely to engage in subsequent careful research and deliberation to dispel any confusion that may have arisen on first impression is not germane: *Masterpiece*, above, at paras 72–73.

[50] The relevant confusion is with respect to the *source* of the goods in question, rather than with respect to the trademarks, trade names, or goods that are being used in association with the trademark(s) being asserted: *Masterpiece*, above, at paras 41, 67, 73 and 104–105.

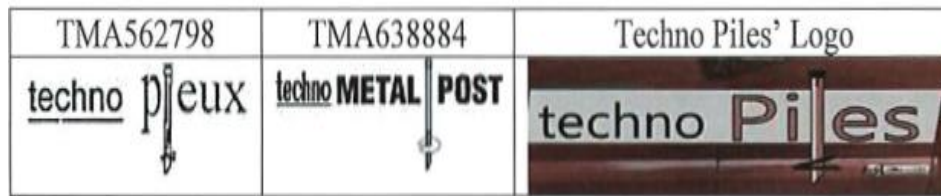
[51] The evidentiary burden is upon the Plaintiff to establish a likelihood – rather than a mere possibility – of confusion, on a balance of probabilities: *Loblaws Inc. v Columbia Insurance Company*, 2019 FC 961 at para 44 [*Loblaws*], aff'd 2021 FCA 29; *Toys “R” Us (Canada) Ltd. v Herbs “R” Us Wellness Society*, 2020 FC 682 at para 6 [*Toys “R” Us*]. However, it is not necessary for the Plaintiff to demonstrate actual confusion: *Mattel, Inc. v 3894207 Canada Inc.*, 2006 SCC 22 at paras 55 and 89 [*Mattel*]; *Veuve Clicquot*, above, at para 6.

[52] In *Masterpiece*, it was suggested that an assessment of the various factors set forth in subsection 6(5) of the *Trademarks Act* should begin with the “degree of resemblance” factor set forth in paragraph 6(5)(e). This is because “if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion”: *Masterpiece*, above, at para 49.

(b) *Degree of resemblance (s. 6(5)(e))*

[53] An assessment of the degree of resemblance between the disputed marks and trade names must include the appearance and sound of these words, as well as the ideas suggested by them: *Trademarks Act*, s 6(5)(e).

[54] The Plaintiff submits that there is a high degree of resemblance between the following design marks:



[55] In addition, the Plaintiff maintains that the words TECHNO PILES are strikingly similar to its registered word marks TECHNO PIEUX and TECHNO METAL POST.

[56] In response, the Defendants submit that the “casual consumer somewhat in a hurry” is unlikely to consider their tradename and logo to resemble the Plaintiff’s Registered Marks to a degree that might be potentially confusing. In support of this position, the Defendants rely on three arguments.

[57] First, they assert that the prefix “Techno” is used too commonly to be distinctive. In support of this position, they rely on Ms. Bertram’s evidence that hundreds of registered marks in Canada use the term “Techno,” and that some competitors in the helical piles market use the term “Tech” or “tech” in their names and logos. These include Postech and Goliath Tech. However, the Defendants have not provided any evidence of any trademarks or trade names, registered or otherwise, that contain the word “Techno” and are used in connection with the sale of helical piles in Canada or the other products at issue in this proceeding. Indeed, Ms. Bertram conceded that she did not know what those other marks were registered for.

[58] I do not accept the Defendants' position that the term "Tech" is highly similar to the term "Techno". In my view, the casual consumer in this market who is somewhat in a hurry is likely to consider the term "Techno" to be distinctive, even in relation to the word "Tech", at least as a matter of first impression. As such, the fact that the disputed trademarks/trade names both contain the term TECHNO is a factor that weighs in favour of a finding of likely confusion, even in an industry where the term "Tech" is used by some market participants.

[59] Second, the Defendants submit that the terms "Metal Post" and "Pile" are widely used by numerous competitors of the parties, and that they mean the same thing as the French term "Pieux". Consequently, they maintain that this consideration weighs in favour of placing little weight on the similarity of the words in the confusion analysis. They state that this is particularly so given the widespread use of the helical pile imagery in the industry. In my view, these considerations do not assist the Defendants at this stage of the analysis. That is to say, they do not weigh in favour of the Defendants in the assessment of the degree of resemblance between their marks/names and the Plaintiff's Registered Marks, as contemplated by section 6(5)(e).

[60] Third, the Defendants state that the terms "Metal Post", "Pile" and "Pieux" are sufficiently different to preclude any likelihood of confusion for the average consumer in a hurry, especially in light of the differences in languages used.

[61] I accept that the differences in appearance and sound between, on the one hand, the terms "Pieux" and "Metal Post", and on the other hand "Pile", weigh in favour of the Defendants. However, for the purposes of the assessment contemplated by section 6(5)(e), two other factors

tip the balance in favour of the Plaintiff. These are: (i) the fact that the first word in the parties' trademarks/trade names (TECHNO) is identical and particularly striking: *Masterpiece*, above, at paras 63–64; and (ii) the ideas suggested by the remaining words in those trademarks/trade names are also identical. In this latter regard, as noted above, the Defendants acknowledge that those words all mean the same thing. They also recognize that the term “Pieux” has “a strong French ‘flavor’.” Consequently, the average consumer in this market who is in a hurry may very well (correctly) assume that “Pile” means “Pieux”, and that therefore the disputed trademarks/trade names have the same source.

[62] These considerations distinguish the case at bar from the situation that existed in *Compulife Software Inc. v Compuoffice Software Inc.*, 2001 FCT 559 at paragraph 33, where the Court found that the differences in the suffixes were such as to make it unlikely that purchasers of COMPULIFE or COMPUOFFICE software products would be confused as to the source of those products, notwithstanding the identical “COMPU” prefixes. Likewise, for the reasons discussed above, the situation at hand is also distinguishable from the dispute in *Ikea Ltd./Ikea Ltée v Idea Design Ltd.* (1987), 13 CPR (3d) 476 at 477–478. There, the Court found that the letter “k” in the term IKEA gave that mark a very strong Scandinavian flavour, such that consumers seeing the defendant’s IDEA mark or design would not likely be confused. There is no similarly distinctive visual, phonetic or other difference in the present case that would tip the balance in favour of the Defendants.

[63] For greater certainty, the fact that the Plaintiff uses its TECHNO METAL POST marks, rather than its TECHNO PIEUX marks, in the region of the country where the Defendants

operate is of little consequence: *Masterpiece*, above, at para 30. This is because the Court is required to consider the hypothetical scenario in which the Defendants' trademarks/trade names are being used in the same area as the Plaintiff's Registered Marks: *Trademarks Act*, ss 6(2)–(4).

[64] In summary, for the reasons provided above, I consider that a casual consumer who is somewhat in a hurry and has an imperfect recollection is likely to perceive the disputed trademarks/trade names to have a degree of resemblance that is confusing. This finding weighs in favour of the Plaintiff. For greater certainty, there is no genuine issue for trial in respect of this factor.

(c) *The inherent distinctiveness of the trademarks or trade names and the extent to which they have become known (s. 6(5)(a))*

[65] The Plaintiff concedes that the terms “Pieux” and “Metal Post” are descriptive of its products. However, it maintains that, taken as a whole, each of the Registered Marks is distinctive because of (i) the presence of the striking first word “TECHNO”, and (ii) in the case of its design logos, the combination of that word and its original helical post design. The Plaintiff adds that its Registered Marks have also become known internationally, and have acquired distinctiveness over time.

[66] The Defendants disagree. They assert that the Registered Marks are generic, descriptive, lack inherent distinctiveness, and have not acquired any distinctiveness over time.

[67] In support of their position, the Defendants assert that the use of the word TECHNO, in conjunction with the words “METAL POST” or “PIEUX”, conveys an impression to consumers that the Plaintiff provides piles or metal posts, and/or services related to piles or metal posts, through the use of technology. As such, those words are merely descriptive.

[68] I disagree. In my view, the word “TECHNO” has a certain degree of distinctiveness in connection with the goods and services for which the Registered Marks are registered. I consider this degree of distinctiveness to be greater, and less descriptive, than what this Court found to be the case in respect of both (i) the term SUPERWASH, as used in connection with certain washable wool products ; and, (ii) the term SUPERSET, as used in connection with telephones: *Wool Bureau of Canada Ltd. v Canada (Registrar of Trademarks)* (1978), 40 CPR (2d) 25; *Mitel Corporation v Canada (Registrar of Trademarks)* (1984), 79 CPR (2d) 202.

[69] I acknowledge that the terms “TECH”, “TECHNO”, “METAL POST” and “PIEUX” may be widely used in the broader construction industry. However, there is no evidence that anyone other than the Plaintiff uses or has used the word “TECHNO” in combination with either “METAL POST” or “PIEUX”, and in relation to goods and services for which the Registered Marks were registered: *McDowell v Laverana GmbH & Co. KG*, 2017 FC 327 at paras 43–46; *Eclectic Edge Inc. v Gildan Apparel (Canada) LP*, 2015 FC 1332 at paras 82–84. As discussed above, I consider the word “TECHNO” to have a degree of strikingness, particularly given that it is the first word in the Registered Trademarks. This strikingness is not likely to be materially reduced by virtue of the fact that some of the parties’ competitors use the words “Tech”, “Technology” or “Technologies” in their trademarks or trade names. My finding in this regard is

reinforced by Ms. Bertram's statement, when cross-examined on her affidavit, that when she was a distributor for the Plaintiff, she considered the "brand" to be "Techno", as opposed to the full name of the company: Bertram Cross-Examination Transcript, November 22, 2021, at 109.

[70] I also disagree with the Defendants' position that the Registered Marks have not acquired any distinctiveness over time. In my view, the evidence of the Plaintiff's substantial sales, combined with the extensive advertising and promotion activities that it and its distributors have made over many years, reasonably supports the conclusion that the Registered Marks have acquired meaningful distinctiveness over time: *H-D U.S.A., LLC v Varzari*, 2021 FC 620 at para 26; *Toys "R" Us*, above, at paras 24 and 27; *Micro Focus (IP) Limited v Information Builders Inc.*, 2014 FC 632 at para 5.

[71] Among other things, the evidence demonstrates the following:

- i. The Plaintiff's total global revenues for goods and services associated with the Registered Marks have grown consistently over the course of the last several years, from over \$16 million to over \$32 million. During this period, its total Canadian revenues have also grown consistently, from over \$11.5 million to over \$18 million; and its revenues within Alberta have grown from over \$600,000 to over \$1.6 million.
- ii. Over the same period, the Plaintiff's total marketing and advertising expenditures have consistently increased, from over \$350,000 to over \$660,000. Those

expenditures include advertisements in magazines and newspapers, as well as on radio stations.

- iii. The Registered Marks have been prominently displayed on the Plaintiff's website since at least 2002;
- iv. The Registered Marks have been prominently featured on the Plaintiff's Facebook page since early 2010. As of October 18, 2021, that Facebook page had 5,911 "followers".
- v. The Registered Marks have also been displayed in association with the Plaintiff's products on its Instagram account and on its Twitter page, which had 555 and 195 "followers", respectively, as of October 18, 2021.
- vi. The Plaintiff has also advertised and promoted its products in association with the Registered Marks on its YouTube account, which has been active since March 2010.
- vii. TMP Fort McMurray gained significant business at trade shows and from advertising on its trucks (using one or more of the Registered Marks), while it was a distributor for the Plaintiff.

[72] Turning to the Defendants' TECHNO PILES trademarks/trade names, there is no material evidence of their inherent or acquired distinctiveness, relative to the Registered Marks. As is self-evident, the word TECHNO is identical in all of the disputed marks, and it appears to be common ground that the word PILES is merely descriptive – for the same reason that the words METAL POST and PIEUX are descriptive.

[73] Having regard to all of the foregoing, I find that the factor of inherent/acquired distinctiveness weighs in favour of the Plaintiff. For greater certainty, there is no genuine issue for trial in respect of this factor.

(d) *The length of time the trademarks or trade names have been in use (s. 6(5)(b))*

[74] As previously indicated, the Plaintiff has used its TECHNO METAL POST word mark (TMA596228) since 2003. It has also used its two design marks (TMA562798 and TMA638884) since 2002 and 2005, respectively, in connection with the registered goods and services. In addition, it has used its TECHNO PIEUX word mark (TMA950281) since 2016.

[75] By comparison, the Defendants have only used their TECHNO PILES marks in the marketplace since approximately May 2021.³

³I recognize that the Defendants registered Techno Piles Inc. in January 2020. However, the uncontested evidence is that this entity has not yet operated in any meaningful manner and has only been used to register the domain name <http://www.technopilesinc.com>. That domain began to be used as the Defendants' "landing page" and for their email on or about May 30, 2021. I also recognize that the TECHNO PILES trade name was registered in March 2021.

[76] The Defendants maintain that any distinctiveness the Registered Marks may have had in the past has been eroded over time to the point that the weight given to the length of time in use should be reduced. In support of this position, they reiterate their argument that the word TECHNO is used by several other companies in the broader construction industry, while marks using highly similar words such as “Tech” and “Technology” are used by multiple competitors in the “screw pile sub-industry”. For essentially the same reasons provided at paragraphs 68-69 above, I reject this argument. For those same reasons, I do not accept the Defendants’ suggestion that the Plaintiff’s failure to take action against those competitors and against participants in the broader construction industry who use the term “Techno”, should give rise to a finding that the Registered Marks have lost any distinctiveness that they may have had in the past.

[77] Given the foregoing, this factor favours the Plaintiff. For greater certainty, there is no serious issue to be tried in connection with this factor.

(e) *The nature of the goods, services or business (s. 6(5)(c))*

[78] The Plaintiff maintains that the goods and services sold, offered for sale, and advertised by it and by the Defendants are effectively the same.

[79] In her affidavit, Ms. Bertram acknowledged that the Principal Corporate Defendants offer the following goods in respect of which the Plaintiff’s TECHNO METAL POST word mark and its two design marks are registered: “Foundations pillars, foundations posts, foundations stake, foundations piles”. She also acknowledged that those Defendants provide the following engineering services in respect of which all four of the Plaintiff’s Registered Marks are

registered: “Engineering services in the design of foundations and performance of test for foundations”: see generally paragraphs 7–8 above.

[80] Accordingly, it is common ground that there is direct overlap among the parties in respect of a broad range of the goods and services in association with which the Registered Marks are registered.

[81] This direct and broad overlap is a factor that weighs in favour of the Plaintiff. This is so despite the fact that this overlap does not extend to the goods for which the TECHNO PIEUX word mark is registered (see paragraph 9 above), and may not extend to “instruments to determine the load-bearing capacity of foundations, footings and piles”: see paragraph 8 above.

[82] For greater certainty, there is no serious issue to be tried in connection with this factor.

(f) *The nature of the trade (s. 6(5)(d))*

[83] The Plaintiff submits that this factor weighs in its favour because the allegedly infringing goods and services of the Principal Corporate Defendants are offered and sold in the same channels of trade as its own goods and services. The Plaintiff maintains that this is so because the parties’ respective goods and services are targeted and sold to the same end consumers, namely, builders and contractors who require helical piles and/or installations for their construction projects.

[84] In response, the Defendants maintain that this factor weighs in their favour and should be given significant weight. In support of this position, they state that the Plaintiff sells its products primarily to dealers who deal exclusively in those products. They add that those “customers” are unlikely to ever be confused about the source of the parties’ respective products. They further emphasize that the same is also true for their own customers, namely, builders and contractors, to whom they sell directly. In this regard, Ms. Bertram’s uncontested affidavit evidence is that most of the Defendants’ sales are through personal contacts or recommendations made by people with whom she and Mr. Bergevin have directly worked. In this context, branding or advertising is comparatively less important and customer confusion regarding the source of the goods and services offered by the Principal Corporate Defendants is “highly unlikely”. Ms. Bertram’s affidavit evidence on this point is supported by her evidence on cross-examination, to the effect that a lot of customers come to the Defendants as a result of personal contacts and referrals, rather than as a result of advertising: Bertram Cross-Examination Transcript, November 22, 2021, at 26–29.

[85] I consider that the evidence provided by Ms. Bertram raises a genuine issue for trial. Based on that evidence, I am not satisfied that the Defendants’ position on the “nature of the trade” assessment factor “is clearly without foundation, or so doubtful that it does not deserve consideration by the trier of fact at a future trial”: *Canmar*, above, at para 24. This evidence has potentially important implications for the Court’s assessment of the likelihood of confusion, *as a matter of first impression*, on the part of the casual consumer *in this market* who is somewhat in a hurry. This is particularly so given certain evidence provided by the Plaintiff’s principal affiant, Mr. Jérôme Chabot, on cross-examination. Specifically, he agreed that a lot of the Plaintiff’s

referrals normally come from personal connections. I recognize that Ms. Bertram has not provided much support for her statements, and that the Defendants (like the Plaintiff) are required to put their best foot forward. However, notwithstanding the shortcomings in Ms. Bertram's evidence, it meets the low bar to survive a Motion for summary judgment, as described above.

[86] I will pause to make two observations in passing. First, while I acknowledge Ms. Bertram's affidavit evidence that "Screw Pile installation is a matter that is generally extensively researched by [the Defendants'] clientele, due to the cost and importance of the product," the test to be applied focuses "on the first impression of consumers when they encounter the marks in question": *Masterpiece*, above, at para 70 [emphasis in original]. Therefore, the fact that customers may subsequently conduct extensive research before making a final purchase decision is not relevant: *Masterpiece*, above, at para 71. To the extent that this Court's statements in *Atomic Energy of Canada Ltd. v AREVA NP Canada Ltd.*, 2009 FC 980 at paragraphs 24–25, may be interpreted as being inconsistent with this principle, they should be considered to have been overtaken by *Masterpiece*. For greater certainty, I will note for the record that I am alive to the possibility that the ultimate consumers of helical piles and related products may be somewhat more alert and aware of the competing products in the marketplace.

[87] Second, I agree with the Plaintiff's position that the fact that its dealers supply the Plaintiff's products in the same downstream market as the market in which the Defendants offer and sell their products is a factor that creates scope for some confusion for builders, contractors and other purchasers of goods and services within that market. Implicit in this is that I also agree

with the Plaintiff's more general position that the Defendants can be found to have infringed the Registered Marks, even if the Plaintiff does not currently sell directly to those builders and contractors. This is because the Court's ultimate focus must be upon the entire scope of exclusive rights that were granted to the Plaintiff in connection with the Registered Marks, rather than simply upon the Plaintiff's actual use of that trademark: *Masterpiece*, above, at paras 53–59. Nevertheless, in assessing the likelihood of confusion, actual use is not irrelevant: *Masterpiece*, above, at para 59. So, it is appropriate to consider the scope of the parties' actual activities and the extent to which they are likely to evolve over time: *Distribution Prosol PS Ltd. v Custom Building Products Ltd.*, 2015 FC 1170 at paras 70–71.

(g) *Alleged additional relevant surrounding circumstances*

[88] For the purposes of the present Motion, it is unnecessary to proceed further with the confusion analysis, given my findings that (i) the Defendants have raised a genuine issue for trial in connection with the nature of the trade, and (ii) the Court's further assessment of this factor (section 6(5)(d)) may have a potentially important impact on its overall confusion analysis.

[89] However, in view of the fact that this proceeding may well proceed to trial, I consider it to be appropriate to observe that the Defendants' conduct after they began to use their TECHNO PILES trade name and marks in the marketplace will be relevant to the Court's ultimate assessment of the likelihood of confusion. In brief, that conduct includes:

- i. Sending an email blast on May 30, 2021 from "Techno Metal Post Fort McMurray and Medicine Hat," entitled "Spreading the Word – New Contact

Information for Techno Metal Post Fort McMurray and Medicine Hat”. Among other things, that email stated, “We still have the same great companies only the name is changing.” It then listed the same addresses and telephone numbers previously used by the Defendants in their capacity as distributors of the Plaintiff’s products. After also stating that their personal and “info” emails would no longer be valid, the announcement provided new emails with the suffix @technopilesinc.com.

- ii. Announcing a “rebranding” and posting a video on Techno Piles’ Facebook page entitled “Rebranding”.
- iii. Rebranding a number of social media accounts that had been used when they were still going to market as distributors of the Plaintiff’s products, and that continued to display pictures or other material containing one or more of the Registered Marks, including on the Plaintiff’s equipment, which is described as “our unique helical screw pile installation equipment”.
- iv. Stating on Ms. Bertram’s LinkedIn profile: “Ronda Bertram, Senior Project Manager at techno Piles previously known as Techno Metal Post Fort McMurray and Techno Metal Post Medicine Hat Inc. ... Same great company, same great people just a name change.”

- v. Stating the following, in the “About Us” section of a web page that is specific to Medicine Hat: “Both Mat and Ronda work full-time in their business which is rare for Techno Metal Post dealerships ...”
- vi. Referring, on their website, to a list of “Completed Projects” that consisted primarily of projects that were completed by TMP Fort McMurray in its capacity as an authorized distributor of the Plaintiff’s products.
- vii. Posting an ad on Kijiji that, among other things, stated: “technoPILES is operating under the building code of Alberta and the CCMC Evaluation Report from ALMITA PILING, ROTERRA PILLING and TECHNO METAL POST for is [sic] BUILDING CODE COMPLIANCE”.
- viii. Stating, on their website, that Techno Piles is “Alberta Building Code CCMC Compliant”, and then referencing CCMC-13059-R, which is the Plaintiff’s CCMC registration.
- ix. Sending out one or more estimates with (i) the Plaintiff’s logo, CCMC certification number and ISO certification prominently featured at the top of the page; and (ii) the Defendants’ new email address (estimates@technopiles.com) at the bottom of the page.

(h) *Summary and conclusion regarding confusion and the alleged deemed infringement*

[90] In summary, based on the evidence adduced on this Motion, I find that four of the five specific factors to be considered in determining whether trademarks or trade names are confusing, as set forth in paragraphs 6(5)(a)–(c) and (e) of the *Trademarks Act*, weigh in favour of the Plaintiff. The Defendants have not demonstrated a genuine issue for trial in respect of those four factors. However, I find that they have met the low bar for demonstrating a genuine issue for trial in respect of the fifth factor, namely, the nature of the trade. In my view, that factor has the potential to have an important impact on the Court’s overall confusion analysis.

[91] Accordingly, the Plaintiff’s Motion for summary judgment in respect of its allegations of deemed infringement under sections 19 and 20 of the *Trademarks Act* will be dismissed.

(3) Depreciation of Goodwill (s. 22)

[92] Section 22 prohibits the use of a trademark registered by another person in a manner that is likely to have the effect of depreciating the value of the goodwill attaching thereto.

[93] To demonstrate a contravention of this prohibition, a plaintiff must demonstrate that the defendant has “made use of marks sufficiently similar to [the plaintiff’s mark] to evoke in a relevant universe of consumers a mental association of the two marks that is likely to depreciate the value of the goodwill attaching to the [plaintiff’s] mark”: *Veuve Clicquot*, above, at para 38.

[94] To meet this test, a plaintiff must demonstrate four things:

Firstly, that a claimant's registered trade-mark was used by the defendant in connection with wares or services – whether or not such wares and services are competitive with those of the claimant. Secondly, that the claimant's registered trade-mark is sufficiently well known to have significant goodwill attached to it. Section 22 does not require the mark to be well known or famous (in contrast to the analogous European and U.S. laws), but a defendant cannot depreciate the value of the goodwill that does not exist. Thirdly, the claimant's mark was used in a manner *likely* to have an effect on that goodwill (i.e. linkage) and fourthly that the *likely* effect would be to depreciate the value of its goodwill (i.e. damage).

[Emphasis in original.]

Veuve Clicquot, above, at para 46.

[95] The written and oral submissions made by the parties in respect of section 22 were very cursory in nature.

[96] In brief, the Plaintiff submits that the Defendants have violated section 22 by using a mark (TECHNO PILES) that is a literal translation of their mark (TECHNO PIEUX) and by using the TECHNO PILES marks and names in a manner that is likely to depreciate the goodwill in the Registered Marks.

[97] In response, the Defendants maintain that they have not made use of the Registered Marks in the form registered, and therefore have not contravened section 22. They add that their TECHNO PILES marks and names can be easily distinguished in their essential aspects from the Registered Marks, and that the Plaintiff has not provided any evidence to demonstrate that consumers are likely to associate the Registered Marks with the Defendants' business.

[98] In my view, the Plaintiff has failed to demonstrate that there is no genuine issue for trial in respect of the allegations it has advanced concerning section 22. In brief, while I am satisfied that there is no genuine issue for trial with respect to the first two elements of the analysis, I am unable to reach that conclusion with respect to the remaining two elements.

[99] With respect to the first element, I am satisfied that the Defendants have made use of marks and names (i.e., the TECHNO PILES marks/names) that are “sufficiently similar”, to the Registered Marks to come within the purview of section 22: *Veuve Clicquot*, above, at para 38.

[100] Turning to the second element, I am satisfied that the Registered Marks are sufficiently well known to be associated with significant goodwill.

[101] However, with respect to the third element, the evidence adduced on this Motion is not sufficient to demonstrate that the TECHNO PILES marks and names have been, or are being, used in a manner *likely* to have an effect on the Plaintiff’s goodwill. The same is true with respect to the fourth element, namely, whether the *likely* effect of the Defendants’ use of the TECHNO PILES marks and names would be to depreciate the value of the Plaintiff’s goodwill.

[102] For each of these two elements, additional evidence is required. This is particularly so with respect to the extent to which builders, contractors and others in the relevant universe of consumers are likely to make a mental association between disputed marks, such as to likely depreciate the value of the goodwill associated with the Registered Marks.

[103] Consequently, the Plaintiff's Motion for summary judgment in respect of its allegation of goodwill depreciation under section 22 of the Trademarks Act will be dismissed.

(4) Passing Off and False Representations

[104] In its Amended Notice of Motion, the Plaintiff seeks declarations that the Defendants have contravened sections 7(b) and 7(d) of the *Trademarks Act*.

[105] Those provisions state:

Unfair Competition and Prohibited Signs Prohibitions

7 No person shall

(b) direct public attention to his goods, services or business in such a way as to cause or be likely to cause confusion in Canada, at the time he commenced so to direct attention to them, between his goods, services or business and the goods, services or business of another;

[...]

(d) make use, in association with goods or services, of any description that is false in a material respect and likely to mislead the public as to

(i) the character, quality, quantity or composition,

(ii) the geographical origin, or

(iii) the mode of the manufacture, production or performance

of the goods or services.

Concurrence déloyale et signes interdits Interdictions

7 Nul ne peut :

b) appeler l'attention du public sur ses produits, ses services ou son entreprise de manière à causer ou à vraisemblablement causer de la confusion au Canada, lorsqu'il a commencé à y appeler ainsi l'attention, entre ses produits, ses services ou son entreprise et ceux d'un autre;

[...]

d) employer, en liaison avec des produits ou services, une désignation qui est fautive sous un rapport essentiel et de nature à tromper le public en ce qui regarde :

(i) soit leurs caractéristiques, leur qualité, quantité ou composition,

(ii) soit leur origine géographique,

(iii) soit leur mode de fabrication, de production ou d'exécution.

(a) *Passing Off (s. 7(b))*

[106] To demonstrate a contravention of section 7(b), a plaintiff must establish (i) the existence of goodwill, (ii) deception of the public due to wilful, negligent or careless misrepresentation, and (iii) actual or potential damages: *Kirkbi AG v Ritvik Holdings Inc.*, 2005 SCC 65 at paras 66–68. As a threshold matter, a plaintiff must also prove possession of a valid and enforceable trademark, whether registered or unregistered, at the time the defendant first began directing public attention to its own goods and services: *Sandhu*, above, at para 39.

[107] I find that the Plaintiff has met the threshold requirement of proving possession of a valid and enforceable trademark at the relevant time. In brief, the Plaintiff has provided copies of the registrations of each of the Registered Marks. For the reasons discussed at paragraphs 181–189 below, the Defendants have failed to raise a genuine issue for trial in relation to their allegation that the Registered Marks are invalid.

[108] Given the evidence summarized at paragraph 71 above, I also find that the Plaintiff has demonstrated the existence of goodwill in the Registered Marks.

[109] However, I find that the Plaintiff has not demonstrated that there is no genuine issue for trial in respect of the elements of deception and actual damages. While I am satisfied that the conduct described at paragraph 89 above collectively amounted to a wilful or careless misrepresentation, the evidence adduced on this Motion does not demonstrate that there is no genuine issue for trial regarding the deceit element of the test. That element is assessed by

reference to the same factors in subsection 6(5) of the *Trademarks Act* that are considered in assessing confusion: *Sandhu*, above, at para 53. For the reasons discussed at paragraphs 85–87 above, there is a genuine issue for trial with respect to whether one or more purchasers within the relevant universe of buyers of the disputed goods and services was or is likely to be confused or deceived by the Defendants’ conduct and their use of the TECHNO PILES marks/trade names. For essentially the same reasons, there is a genuine issue for trial regarding whether the Plaintiff has or will likely suffer actual or potential damages. Such damages cannot be presumed: *Cheung v Target Event Production Ltd.*, 2010 FCA 255 at para 24. In the absence of a demonstration of actual or likely confusion or deceit, they also cannot be inferred. On the record before me on this Motion, I am not confident that I can make the requisite factual findings and apply the relevant legal principles so as to make fair and just determinations on the merits of the Plaintiff’s claims: *Hryniak*, above, at paras 49–50.

[110] I will add in passing that the Plaintiff has not provided any persuasive evidence to establish that anyone was *actually* deceived or confused by the Defendants’ conduct and their use of the TECHNO PILES marks/trade names.

(b) *False Representations (s. 7(d))*

[111] Section 7(d) contemplates “deceit in offering goods or services to the public, deceit in the sense of material false representations likely to mislead in respect of” the matters listed in clauses 7(d)(i) – (iii), respectively: see paragraph 105 above, *MacDonald et al v Vapor Canada Ltd.*, [1977] 2 SCR 134 at 148.

[112] As with the Plaintiff's submissions in respect of section 7(b), its submissions made in relation to section 7(d) were very cursory. They consisted of a bare assertion that the Defendants have made use of marks and names that are likely to mislead the public into thinking that their goods are affiliated with or authorized by the Plaintiff. In my view, this bare submission, even as supplemented with the submissions made in respect of deemed infringement under section 20, fall short of establishing that there is no genuine issue for trial. While the conduct discussed at paragraph 89 above appears to have included statements and the posting of other material that were false in a material respect, the issue of whether the public is or was likely to be misled as a consequence is a genuine issue for trial.

(5) Copyright Infringement

(a) *Applicable legal principles*

[113] The *Copyright Act* protects the expression of ideas in *original* works, but not the ideas themselves: *CCH Canadian Ltd. v Law Society of Upper Canada*, 2004 SCC 13 at para 8 [*CCH*].

[114] Copyright subsists in every original literary, dramatic, musical and artistic work if any one of certain enumerated conditions, which are not in dispute on the present Motion, is met: *Copyright Act*, s 5(1).

[115] For a work to be *original* within the meaning of that legislation, it must be more than a mere copy of another work. However, the work need not be “creative, in the sense of being novel or unique.” Instead, “[w]hat is required to attract copyright protection in the expression of an

idea is an exercise of skill and judgment”: *CCH*, above, at para 16. Skill can be demonstrated by “the use of one’s knowledge, developed aptitude or practice ability in producing the work”, whereas judgment is demonstrated through “the use of one’s capacity for discernment or ability to form an opinion or evaluation by comparing different possible options in producing the work”: *CCH*, above, at para 16.

[116] The requisite degree of skill and judgment is something more than something so trivial that it could be characterized as a purely mechanical exercise: *CCH*, above, at para 16.

[117] “Copyright”, in relation to a work, includes the sole right to produce or reproduce the work or any substantial part thereof in any material form whatsoever: *Copyright Act*, s 3. Consequently, copyright infringement occurs whenever anyone reproduces the copyrighted work, or a substantial part thereof, without the consent of the owner: *Copyright Act*, s 27(1). The same is true whenever anyone makes a “colourable imitation”: *Copyright Act*, s 2.

[118] What constitutes a “substantial” part of a work is a flexible notion and is a matter of fact and degree – “[a]s a general proposition, a substantial part of a work is a part of the work that represents a substantial portion of the author’s skill and judgment expressed therein”: *Cinar Corporation v Robinson*, 2013 SCC 73 at para 26 [*Cinar*].

[119] In considering whether there has been a reproduction of a substantial part of a work protected by copyright, regard must be had to the copyrighted work as a whole, rather than to isolated parts thereof: *Cinar*, above, at paras 35–36. For greater certainty, the focus is not upon

whether that which is alleged to have been copied amounts to a substantial part of the defendant's work: *Cinar*, above, at para 39. Moreover, the alteration of copied features or their integration into a work that is notably different from the copyrighted work does not necessarily preclude a determination in favour of the plaintiff: *Cinar*, above, at para 39.

[120] A “colourable imitation” of a work is a form of the original work that has been altered or modified in such a way as to deceive: *Rains v Molea*, 2013 ONSC 5016 at para 45, quoting May M. Cheng and Michael Shortt, “Colourable Imitation: The Neglected Foundation of Copyright Law” (2012) 17 *Intellectual Property* at 1131.

[121] In the absence of evidence of actual copying, an allegation of copyright infringement may be inferred from evidence of substantial similarity and access to the copyrighted work: *Philip Morris Products S.A. v Marlborough Canada Limited*, 2010 FC 1099 at para 320 [**Philip Morris**], *aff'd* 2012 FCA 201 at para 119; *Pyrrha Design Inc. v Plum and Posey Inc.*, 2019 FC 129 at para 121. However, this inference may be rebutted by establishing that the allegedly infringing work was created independently of the copyrighted work, even though recourse may have been had to common source material: *Philip Morris*, above, at para 320.

[122] Pursuant to paragraph 34.1(1)(b), in any civil proceedings taken under the *Act*, the author is presumed to be the owner of copyright.

(b) *The parties' submissions*

(i) The Plaintiff

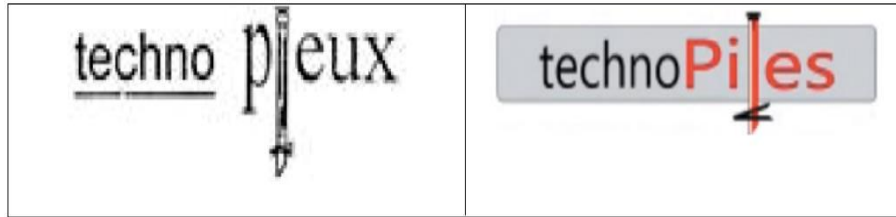
[123] As previously noted, the Copyrighted Works asserted by the Plaintiff consist of the Techno-Pieux logo (TMA562798) and Techno Metal Post logo (TMA638884): see para 10 above.

[124] The Plaintiff maintains that the Copyrighted Works are artistic works that meet the low bar for originality under the *Copyright Act*. In this regard, the Plaintiff adds that its logos resulted from the exercise of the skills of two employees, Mr. Laurent Binet and Ms. Nadia Tardif, who exercised judgment in producing the logos from among the many different possible options that were available to them.

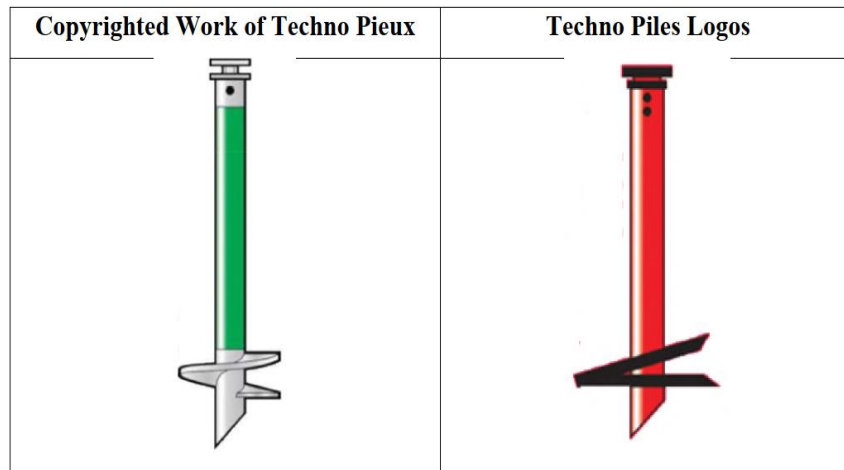
[125] In the absence of any evidence that the Defendants copied their logos from the Copyrighted Works, the Plaintiff requests the Court to infer copying from the Defendants' access to the Copyrighted Works and the similarity between the disputed logos.

[126] Regarding access, the Plaintiff notes that Ms. Bertram was a communications advisor and social media manager at Techno-Pieux for a period of time beginning in late 2016. In that capacity, she was responsible for corporate marketing and communications, public relations and social media management. She also used the Registered Marks and Copyrighted Works in the course of preparing marketing materials. These facts are not contested by the Defendants.

[127] Turning to the issue of substantial similarity, the Plaintiff maintains that this is readily apparent from the following side-by-side comparisons of two of the disputed logos:⁴



[128] The Plaintiff takes the same position regarding the helical piles depicted in the disputed logos, which it has reproduced as follows:



[129] Specifically, the Plaintiff maintains that the foregoing helical pile designs have the same shapes, the same orientation of the screw piles (vertical with the point coming down on the left side), the same white shading going down the left side of the pile, and the same proportions (length/diameter). The Plaintiff adds that the hole(s) at the top of the piles are also lined up in the same orientation.

⁴The Defendants sometimes use other logos, including one with various cities included beside their helical pile. On cross-examination, Ms. Bertram acknowledged that the Defendants make use of the version without the city names, depicted above.

[130] Given the foregoing, the Plaintiff submits that the similar elements of the disputed logos and helical pile images collectively represent a substantial part of the skill and judgment that its aforementioned employees expressed in the Copyrighted Works. Consequently, it requests that the Court conclude that the reproduction of the Defendants' Techno Piles logos constitutes an infringement of its copyright.

(ii) The Defendants

[131] The Defendants maintain that the Plaintiff cannot claim copyright in respect of a generic helical pile image that is used in an industry where numerous companies have similar images in their logos. In any event, they state that there is no evidence that any of them copied the Copyrighted Works and no evidence of substantial or unique skill and judgment expressed in the Techno-Pieux logo. In the latter regard, they assert that the Plaintiff's helical pile image is extremely common throughout many industries, and specifically in the screw pile and broader construction markets. They add that this image is simply a mechanical copy of the actual screw piles used by the Plaintiff. In this context, they submit that the Court cannot infer that there has been any copyright infringement.

[132] In support of their position, the Defendants note that the Plaintiff's principal affiant, Mr. Chabot, acknowledged on cross-examination that the helical pile represented in the Plaintiff's logos "look[s] pretty much just like" the galvanized piles sold by the Plaintiff. Mr. Chabot also acknowledged that the principal difference between the pile represented in the Plaintiff's logo and the pile represented in the logo of one of its competitors, Postech, is the green colouring used by the Plaintiff.

[133] In addition to the foregoing, the Defendants submit that there are substantial differences between the disputed logos. These include the differences in their colours,⁵ the differences in the screw portion of the depicted piles, and the differences in the number of holes at the top of the screw pile. They add that other participants in the industry, such as Postech and Pro Post, have logos that have more similarities to the Plaintiff's helical pile image than do the TECHNO PILES logos. While some of the Defendants may have had access to the Plaintiff's logo, they also had access to these other logos.

[134] Moreover, in her affidavit, Ms. Bertram added that the Defendants' logos use different font from the Plaintiff's logo, and do not use the underlining that appears under the word "techno" in the Plaintiff's logos. On cross-examination, she further explained that Mr. Bergevin created the representation of the helical pile that is represented in the Defendants' logos long before the breakdown in the relationship between the parties began to materialize. She then inserted his hand drawn creation into what became the TECHNO Piles logos, on her computer.

(c) *Assessment*

[135] In my view, the three Copyrighted Works asserted by the Plaintiff represent original artistic works. There is no genuine issue for trial regarding this issue.

[136] Two of the works in question consist of more than just an image of a helical pile that the Defendants allege is a mere copy of the actual helical piles sold by the Plaintiff. Other important components of the two logos include the underlined word "techno", the remaining word(s)

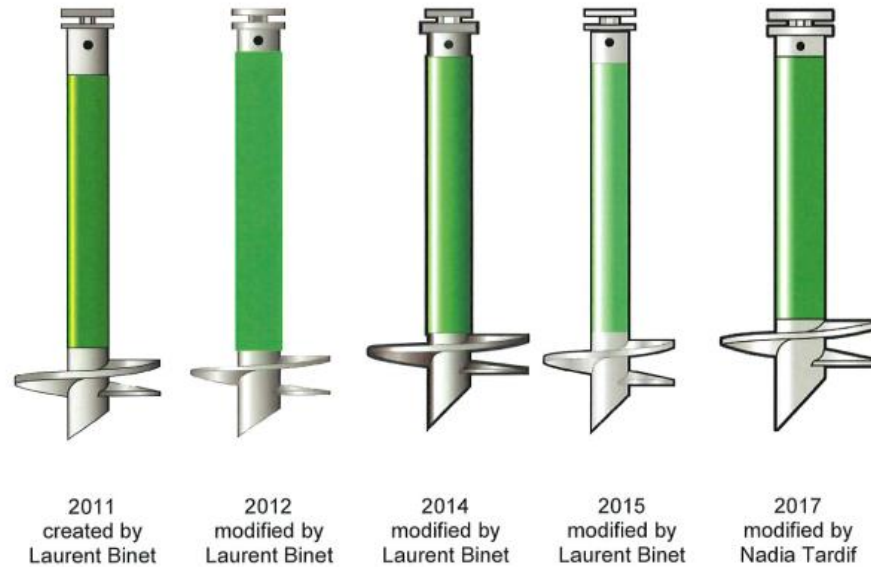
⁵The helical piles in the Plaintiff's logos are green, whereas they are red in the Defendants' logos.

“Pieux” and “Metal Post,” and the placement of the helical pile within the logo – either where the “i” would be in one of the logos, or in between the words “Metal” and “Post” in the other logo.

[137] I consider that each of the two logos resulted from the exercise of skill and judgment on the part of the Plaintiff’s employees, Ms. Tardif and Mr. Binet, each of whom drew upon their skills as marketing assistants and graphic designers. In the absence of any evidence to demonstrate, or even suggest, that the logos as a whole are mere copies of any other work in particular, it is readily apparent that they involved some intellectual effort. Such effort was evidently not so trivial that it could be characterized as a purely mechanical exercise: *CCH*, above, at para 16.

[138] Among other things, the placement of the helical pile in the place of the “i” in the word “Pieux” reflects an element of creativity and novelty. This is accentuated by the placement of a single hole at the top of the helical pile, where the dot above the “i” would otherwise appear. Likewise, the placement of the helical pile between the words “METAL” and “POST” in the other logo reflects a conscious decision to choose that location in preference to other available alternatives. A similar decision evidently was made with respect to the underlining of the word “techno”, and the presentation of that word entirely in lower case letters.

[139] With respect to the helical pile itself, Ms. Tardif provided the following illustration of the evolution of the pile, which reflects the exercise of additional skill and judgment, as well as a consideration of different possible options in producing the work: *CCH*, above at para 16:



[140] As is readily apparent from the foregoing, Mr. Binet and Ms. Tardif had to exercise skill and judgment with respect to the top part of the helical pile, its thickness and colour, the number of holes (the Defendants' logos have two holes at the top, while another competitor's logo has three holes at the top), and the angle and direction of the bottom part of the pile.

[141] Turning to the Plaintiff's allegation of infringement, the Defendants do not dispute that Ms. Bertram had access to the Copyrighted Works. This was readily acknowledged by Ms. Bertram. However, in the context of this particular industry, mere access to the Plaintiff's Copyrighted Works does not necessarily support a strong inference of copying. This is because other industry participants use helical piles in their logos. At least two of them were used and registered in Canada before the Defendants commenced using their TECHNO PILES logos. Unfortunately, similar evidence regarding the logos of the other industry participants was not provided.

[142] Moreover, Ms. Bertram testified, on cross-examination, that she obtained the representation of the helical pile that appears in the Defendants' logos from something that Mr. Bergevin made in a ceramics class. She also stated that she and Mr. Bergevin consciously chose the colour red for their logos in an effort to "be as far away from green as possible" and to avoid confusing the marketplace. She added that they wanted to distinguish their mark by inserting the mathematical "less than" sign (<) towards the bottom of their helical pile, to convey the idea of engineering technology.

[143] Considering the foregoing, I conclude that the Defendants have raised a genuine issue for trial as to whether they can rebut the presumption of copying that arises from their uncontested access to the Copyrighted Works. In my view, their case on this issue cannot be said to be "clearly without foundation, or ... so doubtful that it does not deserve consideration by the trier of fact at a future trial": *Canmar*, above, at para 24. On the record before me on this Motion, I am not confident that I can make the requisite factual findings and apply the relevant legal principles so as to make fair and just determinations on the merits of the Plaintiff's claims: *Hryniak*, above, at paras 49–50. Consequently, the Plaintiff has not established that there is no serious issue for trial in relation to the issue of copying.

[144] In view of this finding, it is unnecessary to address the Plaintiff's allegation that the Defendants copied a "substantial" part of the Copyrighted Works.

(6) Personal Liability of the Individual Defendants

[145] In their defence to the Plaintiff's Motion for summary judgment, as well as in their Cross-Motion (discussed below), the Defendants maintain that the claims against the personal Defendants are without basis and do not meet the test for piercing the corporate veil. In both Motions, the Defendants rely on essentially the same arguments in support of their position. For convenience, I will deal with those arguments immediately below.

[146] The Defendants assert that cases in which the corporate veil has been pierced have typically involved the incorporation of a company as a façade, to conceal an illegal, fraudulent or improper purpose. That is not what is being alleged by the Plaintiff. Accordingly, I will not further address that particular line of jurisprudence.

[147] The Defendants also rely on a second line of jurisprudence. Specifically, they note that in *Normart Management Ltd. v West Hill Redevelopment Co.*(1998), 155 DLR (4th) 627 at para 18, the Court of Appeal for Ontario stated as follows:

“It is well established that the directing minds of corporations cannot be held civilly liable for the actions of the corporations they control and direct unless there is some conduct on the part of those directing minds that is either tortious in itself or exhibits a separate identity of interest from that of the corporations such as to make the act or conduct complained of those of the directing minds”.

[148] The Defendants recognize that in *Tommy Hilfiger Licensing Inc. v Produits de Qualité I.M.D. Inc.*, 2005 FC 10 at paragraph 142, this Court held that the test for piercing the corporate veil requires evidence of “circumstances from which it is reasonable to conclude that the purpose of the director or officer of a company is to deliberately, willfully and knowingly pursue a course

of conduct that will incite infringement or an indifference to the risk of infringement” [emphasis added].

[149] The latter formulation of the test was adapted from the following passage in the patent infringement case of *Mentmore Manufacturing Co. v National Merchandise Manufacturing Co.* (1978), 89 DLR (3d) 195 at 204–205 (FCA) [*Mentmore*]:

[T]here must be circumstances from which it is reasonable to conclude that the purpose of the director or officer was not the direction of the manufacturing and selling activity of the company in the ordinary course of his relationship to it but the deliberate, wilful and knowing pursuit of a course of conduct that was likely to constitute infringement *or reflected an indifference to the risk of it*. The precise formulation of the appropriate test is obviously a difficult one. Room must be left for a broad appreciation of the circumstances of each case to determine whether as a matter of policy they call for personal liability. [Emphasis added.]

[150] The first sentence in the passage quoted above was adopted by the Supreme Court of Canada in *Cinar*, above, at paragraph 60. Accordingly, that is the applicable test.

[151] The Defendants submit that they continue to contend that they are entitled to use the disputed marks pursuant to the Disputed Distribution Agreements. In any event, they maintain that their use of the TECHNO PILES trade name/mark does not infringe the Registered Marks. Consequently, they assert that the present situation is not one in which it could be found that they “deliberately, wilfully or knowingly pursued a course of conduct to incite infringement.”

[152] In response, the Plaintiff notes that Mr. Bergevin and Ms. Bertram are the directing minds of the Corporate Defendants. This is not contested.

[153] The Plaintiff also asserts that, given their time working as authorized distributors for the Plaintiff, Mr. Bergevin and Ms. Bertram acted with the full knowledge of the Plaintiff's rights, and with reckless disregard for those rights. It adds that Mr. Bergevin and Ms. Bertram actively cultivated confusion and demand for products associated with names/marks that are confusingly similar to the Registered Marks. The Plaintiff maintains that this is outside the scope of the legitimate duties of an officer or director of a company. It further contends that Mr. Bergevin and Ms. Bertram misled consumers in their personal capacity, including by posting infringing content to their personal social media pages.

[154] In cross-examination on her affidavit, Ms. Bertram maintained that she simply "shared" material that had been posted by the Corporate Defendants. However, some of the material that was allegedly "shared" on her personal Facebook page was accompanied by new text written by Ms. Bertram. The same is true for material that was posted or reposted on Mr. Bergevin's personal Facebook page. There were also postings or repostings of disputed material on their respective Twitter accounts and in Ms. Bertram's profile on LinkedIn. In any event, at this point in time, I am not persuaded that the "reposting" of misleading corporate posts is conduct that can escape personal liability.

[155] In my view, there is a genuine issue to be tried with respect to whether the purpose underlying the impugned actions of Mr. Bergevin and Ms. Bertram amounted to a deliberate, wilful and knowing pursuit of a course of conduct that was likely to constitute infringement *or reflected an indifference to the risk of it.*

[156] Accordingly, I reject the Defendants' request for an Order dismissing the Plaintiff's action against Mr. Bergevin and Ms. Bertram, in their personal capacities.

(7) Conclusion

[157] The Plaintiff's Motion for summary judgment is dismissed.

[158] For the reasons that I have provided, I am not satisfied that there is no serious issue for trial with respect to the Plaintiff's claims of (i) trademark infringement, pursuant to sections 19 and 20 of the *Trademarks Act*, (ii) depreciation of goodwill, pursuant to section 22, (iii) passing off, contrary to section 7(b), (iv) conduct contrary to section 7(d), or (v) copyright infringement, pursuant to sections 3 and 27 of the *Copyright Act*. The Plaintiff has not persuaded me that the case advanced by the Defendants in respect of any of these claims is "clearly without foundation, or is so doubtful that it does not deserve consideration by the trier of fact at a future trial":

Canmar, above, at para 24.

[159] The same is true with respect to the Defendants' claim that the case against Mr. Bergevin and Ms. Bertram is without basis and does not meet the test for piercing the corporate veil.

[160] I consider that all of the foregoing issues can and should be determined by way of a summary trial: Rule 215(3).

V. The Defendants' Cross-Motion

A. *Summary of Relief Sought*

[161] The relief sought by the Defendants in its Cross-Motion is summarized at paragraph 4 above.

B. *Analysis*

(1) The Test for Summary Judgment

[162] The test applicable to the Defendants' Cross-Motion for summary judgment is the same as that which is set forth at paragraphs 37-40 above, in relation to the Plaintiff's Motion.

(2) Trademark Invalidity (Lack of Distinctiveness)

(a) *Applicable Legal Principles*

[163] Pursuant to section 18(1)(b) of the *Trademarks Act*, the registration of a trademark is invalid if the trademark is not distinctive at the time proceedings bringing the validity of the registration into question are commenced.

[164] The word "distinctive" describes a trademark that either actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others, or is adapted so to distinguish them: *Trademarks Act*, s 2.

[165] A trademark actually distinguishes by acquiring distinctiveness through use, resulting in distinctiveness in fact. Such acquired distinctiveness can be inferred from evidence of the extent of the mark's use, the significance of promotion and advertising activities pertaining to the mark,

and the level of sales revenues of goods or services associated with the mark: see jurisprudence cited above, at paragraph 70; and *Boston Pizza International Inc. v Boston Chicken Inc.*, 2003 FCA 120 at para 5 [*Boston Pizza*].

[166] A trademark that is “adapted so as to distinguish” the goods in respect of which it is associated is a mark that is inherently distinctive. A coined or invented word falls into this category: *Astrazeneca AB v Novopharm Ltd.*, 2003 FCA 57 at para 16 [*Astrazeneca*].

[167] In this context, distinctiveness connotes some quality in the trademark which makes the goods or services in respect of which it is associated distinct from those of other producers of those goods or services: *Astrazeneca*, above, at para 14.

[168] In assessing the distinctiveness of a trademark, the mark must be assessed as a whole, rather than dissected into its component parts: *AIL International Inc v Canadian Energy Services LP*, 2019 FC 795 at para 70.

[169] Where a trademark is demonstrated to have acquired distinctiveness over time, and to have maintained that distinctiveness at the time of an expungement proceeding, it will survive the challenge to its validity, even if it is found to lack inherent distinctiveness: *Boston Pizza*, above, at para 14.

[170] Section 19 of the *Trademarks Act* states:

Rights conferred by registration

19 Subject to sections 21, 32 and 67, the registration of a trademark in respect of any goods or services, unless shown to be invalid, gives to the owner of the trademark the exclusive right to the use throughout Canada of the trademark in respect of those goods or services.

Droits conférés par l'enregistrement

19 Sous réserve des articles 21, 32 et 67, l'enregistrement d'une marque de commerce à l'égard de produits ou services, sauf si son invalidité est démontrée, donne au propriétaire le droit exclusif à l'emploi de celle-ci, dans tout le Canada, en ce qui concerne ces produits ou services.

[171] This language has been characterized as creating a presumption of validity, in the sense that “an application for expungement will succeed only if an examination of all of the evidence presented to the Federal Court establishes that the trade-mark was not registrable at the relevant time”: *Cheaptickets and Travel Inc. v Emall.ca Inc.*, 2008 FCA 50 at para 12 [*Cheaptickets*].

[172] It follows that the party alleging invalidity bears the onus to prove, on a balance of probabilities, that the contested trademark mark is invalid: *Bedessee Imports Ltd. v GlaxoSmithKline Consumer Healthcare (UK) IP Limited*, 2020 FCA 94 at para 18.

[173] Where a party alleges invalidity on the ground of lack of distinctiveness that party must establish that the trademark is “so devoid of distinctiveness” that it fails to distinguish the registrant’s goods or services from those of others: *A&W Food Services of Canada Inc. v McDonald’s Restaurants of Canada Ltd.*, 2005 FC 406 at para 99 [*A&W*].

(b) *The Parties’ Positions*

(i) The Defendants (Plaintiffs by Counterclaim)

[174] The Defendants maintain that, by using the words “Techno”, “Pieux”, “Metal” and “Post”, the Plaintiff has impermissibly reached inside the common trade vocabulary. The Defendants assert that the Plaintiff should not be allowed to effectively monopolize those allegedly descriptive and generic words in association with the sale and installation of helical piles, which are literally metal posts.

[175] In support of their position, the Defendants emphasize that the words “pile” and “metal posts” are alternate dictionary translations for the French word “pieux”. As with their response to the Plaintiff’s Motion for summary judgment, they maintain that the combined words “Techno Pieux” and “Techno Metal Post” simply convey that the Plaintiff provides and installs helical (screw) piles using technology: see paragraph 67 above. They therefore submit that there is nothing distinctive about either of those combined terms.

[176] The Defendants add that if the Registered Word Marks were ever distinctive, they have lost that distinctiveness by allowing many firms in the construction industry to use the words “Techno”, “Piles” and “Post”, or variations thereof. Such variations include the words “Tech” and “Technologies”. The Defendants rely on essentially these same facts to assert that the Registered Word Marks have not acquired any distinctiveness over time.

[177] The Defendants make similar submissions with respect to the Plaintiff’s registered logos (TMA562798 and TMA638884). In brief, they note that several competitors have very similar representations of helical piles in their logos. At least one rival, Pro Post, has its helical pile inserted in the same spot (between the two words) as is depicted in the Techno Metal Post logo.

They further note that, on cross-examination, Ms. Tardif could not identify the differences between a real helical pile and the one represented in the Plaintiff's logo. She also conceded that the main difference between the helical pile image that she created for the Plaintiff and the corresponding image in Postech's logo is the colour. She also acknowledged that the image in the Plaintiff's logo "is like a real one."

(ii) The Plaintiff (Defendant to the Counterclaim)

[178] The Plaintiff begins by asserting that the Defendants' position in this Cross-Motion is inconsistent with their position in the Plaintiff's Motion for summary judgment. In this regard, the Plaintiff notes that the Defendants are maintaining that the Court can find, on the basis of the existing record, that the Registered Marks lack distinctiveness. The Plaintiff states that this is inconsistent with the Defendants' prior position that a trial on the facts is required for the Court to assess the distinctiveness of those marks.

[179] The Plaintiff also relies on the presumption of validity of the Registered Marks and states that the evidence filed by the Defendants falls well short of what is required to displace that presumption: *Cheaptickets*, above. Among other things, the Plaintiff underscores the absence of: evidence regarding the actual use of third-party marks, evidence from consumers, evidence that any other party makes use of the word "Techno" in association with the relevant goods or services, and evidence that the Registered Marks are no longer distinguishable from the allegedly similar marks of third parties.

[180] In contrast, the Plaintiff asserts that it has filed cogent evidence that the Registered Marks have inherent and acquired distinctiveness.

(c) *Assessment*

[181] Broadly speaking, I agree with the Plaintiff. The Defendants have not met their burden of displacing the presumption of validity of the Registered Marks, let alone on the high standard required in a Motion for summary judgment: see para 39 above.

[182] In my view, the Plaintiff has “come up with specific facts showing that there is a genuine issue for trial”: *Canmar*, above, at para 27. Indeed, it has gone further and demonstrated that the Registered Marks have a certain degree of inherent distinctiveness and have acquired distinctiveness over time: see paras 68–73 above.

[183] It is unnecessary to reiterate the evidence discussed in the paragraphs referenced immediately above. For the present purposes, it will suffice to state that I agree with the Plaintiff that each of the Registered Marks, taken as a whole, is distinctive because of (i) the presence of the striking first word “TECHNO”, (ii) the unique combination of the words “TECHNO PIEUX” and “TECHNO METAL POST” and (iii), in the case of the design logos, the combination of those unique words with the helical post design. This strikingness is not likely to be materially reduced by virtue of the fact that some of the parties’ competitors use the words “Tech”, “tech”, “Technology” or “Technologies” in their trademarks or trade names. The same is true with respect to the fact that some market participants use a similar helical post in their design marks.

[184] Moreover, the evidence of the Plaintiff's substantial sales, combined with the extensive advertising and promotional activities that it and its distributors have made over many years, reasonably supports the conclusion that the Registered Marks have acquired meaningful distinctiveness over time: see paragraphs 70–71 above.

[185] The Defendants have not demonstrated that this acquired distinctiveness had dissipated to the point of failing to distinguish the Plaintiff's goods and services from those of other producers, at the time this Cross-Motion was filed: *A&W*, above, at para 99. This provides a sufficient basis to find that the presumption of validity has not been displaced: *Trademarks Act*, section 18(1)(b); *Boston Pizza*, above, at para 14.

(3) Trademark Invalidity (Clearly Descriptive)

[186] In their written and oral submissions, the Defendants alleged that the Registered Marks are each clearly descriptive, contrary to section 12(1)(b) of the *Trademarks Act*.

[187] In response, the Plaintiff submitted that this allegation was not mentioned in the Defendants' Notice of Motion, as required by Rule 359(c), or in their Statement of Defence and Counterclaim. As a result, the Plaintiff maintained that the Defendants had failed to provide proper notice to it, and denied it the ability to file evidence on that issue and test the Defendants' evidence by cross-examination. Accordingly, the Plaintiff requested the Court to dismiss this particular claim without further consideration.

[188] After confirming that there was no mention of this allegation in the Defendants' Notice of Motion or in their pleadings, the Defendants' counsel conceded during the hearing that the Court did not need to address this allegation.

[189] Having regard to the foregoing, the Defendants' allegation that the Plaintiff's two Word Marks are clearly descriptive, contrary to section 12(1)(b), is dismissed.

(4) Techno Piles Inc.

(a) *The Parties' Positions*

[190] The Defendants submit that there is no genuine issue for trial with respect to Techno Piles Inc.'s involvement in the within action. In support of this position, they note that this entity has never engaged in any operations or used any trademarks in association with any goods or services. For greater certainty, they add that it has not made any transactions, distributions, conveyances, purchases, sales or transfers. Nor does it have a registered GST or HST account, a registered payroll number, or a bank account.

[191] In response, the Plaintiff notes that Techno Piles Inc. is the owner of the technopiles.com domain name registration. As such, the Plaintiff asserts that it is presumptively responsible for the content posted to that website. For these reasons alone, the Plaintiff maintains that this entity is a proper defendant in the within action.

(b) *Assessment*

[192] I agree with the Plaintiff's position.

[193] During the hearing of these Motions, the Defendants represented that the relief sought by the Plaintiff in respect of Techno Piles Inc.'s name and the above-mentioned domain name could be implemented without including that entity in the proceeding. Counsel for the Plaintiff conveyed an uneasy openness to proceeding in this fashion.

[194] Upon further reflection, I understand that unease. I agree with the Plaintiff's written submission that maintaining Techno Piles Inc. as a Defendant in the within action is the appropriate manner in which to ensure that the relief described above can be obtained by the Plaintiff, if such relief is ultimately granted. Among other things, this will ensure that any Order that may be issued in that regard is addressed directly to Techno Piles Inc. The Defendants did not identify any material cost or other adverse impact that they would suffer if Techno Piles Inc. were to remain a named defendant in the within action.

(5) *Conclusion*

[195] For the reasons set forth in part V.B.(2)(c) above, the Defendants have not demonstrated that there is no genuine issue for trial regarding their claim that the Registered Marks are invalid pursuant to section 18(1)(b) of the *Trademarks Act*. In my view, the Plaintiff has adduced "specific facts showing that there is a genuine issue for trial": *Canmar*, above, at para 27.

[196] For the reasons provided in part V.B.(3) above, the Defendants' allegation that the Plaintiff's two word marks are clearly descriptive, contrary to section 12(1)(b) of the *Trademarks Act*, is dismissed.

[197] For the reasons provided in part V.B.(4) above, the Defendants have failed to demonstrate that there is no genuine issue for trial with respect to Techno Piles Inc.'s involvement in the within action.

[198] In their Cross-Motion, the Defendants also requested that the Plaintiff's underlying action be dismissed in its entirety. However, they did not advance any arguments in support of that position. Accordingly, they have failed to demonstrate that there is no genuine issue for trial regarding the claims made by the Plaintiff in the within action. On the contrary, for the reasons provided in part IV.C.(2), the Plaintiff has established that four of the five factors set forth in subsection 6(5) of the *Trademarks Act* weigh in its favour in the determination of whether the Defendants' tradenames/marks are confusingly similar to the Registered Marks. The Plaintiff has also adduced evidence regarding the Defendants' conduct that may well be found to weigh in its favour in this regard. For the reasons I have provided in parts IV.C.(2)-(5), I consider that there is a genuine issue for trial in respect of the various claims made by the Plaintiff under the *Trademarks Act* and the *Copyright Act*. There is also a genuine issue for trial in respect of the personal liability of the Defendants Mathieu Bergevin and Ronda Bertram.

VI. Costs

[199] Shortly following the hearing of these Motions, I issued a Direction encouraging the parties attempt to reach an agreement regarding a lump sum amount of costs to be paid to the prevailing party in each of the Motions. In the event that the parties were unable to reach such an agreement, they were directed to provide submissions, preferably in support of a lump sum cost award.

[200] In a letter dated March 21, 2022, counsel to the Plaintiff wrote to advise the Court that the parties jointly proposed that the prevailing party on each Motion be awarded costs in the lump sum amount of \$10,000, inclusive of fees and disbursements. This agreement was not meant to address the circumstance in which a party had mixed success on a Motion.

[201] Having regard to the factors set forth in Rule 400, I consider the foregoing proposal to be fair and just in the circumstances.

[202] However, given that the Defendants largely prevailed with respect to the Plaintiff's Motion, whereas the converse was true with respect to the Defendants' Cross-Motion, the amounts to which they are entitled, respectively, largely offset one another. However, they do not completely offset one another. This is because the Plaintiff prevailed regarding an issue that was raised in its Motion, namely, the existence of a genuine issue for trial in respect of the personal liability of Mr. Bergevin and Ms. Bertram. The Plaintiff also prevailed regarding the

preliminary issue discussed in part VI.B. of these reasons. Accordingly, I consider it appropriate to award the Plaintiff costs in the lump sum amount of \$2,000.

ORDER in T-969-21

THIS COURT ORDERS that:

1. The Plaintiff's Motion for summary judgment is dismissed.
2. The Defendant's Cross-Motion for summary judgment is dismissed.
3. For greater certainty, the Defendants' request for an order dismissing the Plaintiff's within action against the Defendants Techno Piles Inc., Ronda Bertram and Mathieu Bergevin is dismissed.
4. The Defendants shall pay to the Plaintiff lump sum costs of \$2,000, inclusive of fees and disbursements.
5. Pursuant to Rule 215(3)(a), the underlying action in this proceeding shall be determined by way of a summary trial. The undersigned will remain seized of this proceeding.

"Paul S. Crampton"

Chief Justice

APPENDIX 1: RELEVANT STATUTORY PROVISIONS

Trademarks Act, RSC 1985, c T-13

Interpretation

Definitions

2 distinctive, in relation to a trademark, describes a trademark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or that is adapted so to distinguish them; (*distinctive*)

[...]

When mark or name confusing

6 (1) For the purposes of this Act, a trademark or trade name is confusing with another trademark or trade name if the use of the first mentioned trademark or trade name would cause confusion with the last mentioned trademark or trade name in the manner and circumstances described in this section.

[...]

What to be considered

6 (5) In determining whether trademarks or trade names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including

- (a) the inherent distinctiveness of the trademarks or trade names and the extent to which they have become known;
- (b) the length of time the trademarks or trade names have been in use;

Définitions et interprétation

Définitions

2 distinctive Se dit de la marque de commerce qui distingue véritablement les produits ou services en liaison avec lesquels elle est employée par son propriétaire de ceux d'autres personnes, ou qui est adaptée à les distinguer ainsi. (*distinctive*)

[...]

Quand une marque ou un nom crée de la confusion

6 (1) Pour l'application de la présente loi, une marque de commerce ou un nom commercial crée de la confusion avec une autre marque de commerce ou un autre nom commercial si l'emploi de la marque de commerce ou du nom commercial en premier lieu mentionnés cause de la confusion avec la marque de commerce ou le nom commercial en dernier lieu mentionnés, de la manière et dans les circonstances décrites au présent article.

[...]

Éléments d'appréciation

6 (5) En décidant si des marques de commerce ou des noms commerciaux créent de la confusion, le tribunal ou le registraire, selon le cas, tient compte de toutes les circonstances de l'espèce, y compris :

- a) le caractère distinctif inhérent des marques de commerce ou noms commerciaux, et la mesure dans laquelle ils sont devenus connus;
- b) la période pendant laquelle les marques de commerce ou noms commerciaux ont été en usage;

(c) the nature of the goods, services or business;

(d) the nature of the trade; and

(e) the degree of resemblance between the trademarks or trade names, including in appearance or sound or in the ideas suggested by them.

[...]

Unfair Competition and Prohibited Signs Prohibitions

7 No person shall

(b) direct public attention to his goods, services or business in such a way as to cause or be likely to cause confusion in Canada, at the time he commenced so to direct attention to them, between his goods, services or business and the goods, services or business of another;

[...]

(d) make use, in association with goods or services, of any description that is false in a material respect and likely to mislead the public as to

(i) the character, quality, quantity or composition,

(ii) the geographical origin, or

(iii) the mode of the manufacture, production or performance

of the goods or services.

[...]

When trademark registrable

c) le genre de produits, services ou entreprises;

d) la nature du commerce;

e) le degré de ressemblance entre les marques de commerce ou les noms commerciaux, notamment dans la présentation ou le son, ou dans les idées qu'ils suggèrent.

[...]

Concurrence déloyale et signes interdits Interdictions

7 Nul ne peut :

b) appeler l'attention du public sur ses produits, ses services ou son entreprise de manière à causer ou à vraisemblablement causer de la confusion au Canada, lorsqu'il a commencé à y appeler ainsi l'attention, entre ses produits, ses services ou son entreprise et ceux d'un autre;

[...]

d) employer, en liaison avec des produits ou services, une désignation qui est fautive sous un rapport essentiel et de nature à tromper le public en ce qui regarde :

(i) soit leurs caractéristiques, leur qualité, quantité ou composition,

(ii) soit leur origine géographique,

(iii) soit leur mode de fabrication, de production ou d'exécution.

[...]

Marque de commerce enregistrable

12 (1) Subject to subsection (2), a trademark is registrable if it is not

(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the goods or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;

When registration invalid

18 (1) The registration of a trademark is invalid if

(b) the trademark is not distinctive at the time proceedings bringing the validity of the registration into question are commenced;

[...]

Rights conferred by registration

19 Subject to sections 21, 32 and 67, the registration of a trademark in respect of any goods or services, unless shown to be invalid, gives to the owner of the trademark the exclusive right to the use throughout Canada of the trademark in respect of those goods or services.

Infringement

20 (1) The right of the owner of a registered trademark to its exclusive use is deemed to be infringed by any person who is not entitled to its use under this Act and who

12 (1) Sous réserve du paragraphe (2), la marque de commerce est enregistrable sauf dans l'un ou l'autre des cas suivants :

b) qu'elle soit sous forme graphique, écrite ou sonore, elle donne une description claire ou donne une description fautive et trompeuse, en langue française ou anglaise, de la nature ou de la qualité des produits ou services en liaison avec lesquels elle est employée, ou en liaison avec lesquels on projette de l'employer, ou des conditions de leur production, ou des personnes qui les produisent, ou de leur lieu d'origine;

Quand l'enregistrement est invalide

18 (1) L'enregistrement d'une marque de commerce est invalide dans les cas suivants :

b) la marque de commerce n'est pas distinctive à l'époque où sont entamées les procédures contestant la validité de l'enregistrement;

[...]

Droits conférés par l'enregistrement

19 Sous réserve des articles 21, 32 et 67, l'enregistrement d'une marque de commerce à l'égard de produits ou services, sauf si son invalidité est démontrée, donne au propriétaire le droit exclusif à l'emploi de celle-ci, dans tout le Canada, en ce qui concerne ces produits ou services.

Violation

20 (1) Le droit du propriétaire d'une marque de commerce déposée à l'emploi exclusif de cette dernière est réputé être violé par une personne qui est non admise à l'employer selon la présente loi et qui :

a) soit vend, distribue ou annonce des produits ou services en liaison avec une

(a) sells, distributes or advertises any goods or services in association with a confusing trademark or trade name;

(b) manufactures, causes to be manufactured, possesses, imports, exports or attempts to export any goods in association with a confusing trademark or trade name, for the purpose of their sale or distribution;

(c) sells, offers for sale or distributes any label or packaging, in any form, bearing a trademark or trade name, if

(i) the person knows or ought to know that the label or packaging is intended to be associated with goods or services that are not those of the owner of the registered trademark, and

(ii) the sale, distribution or advertisement of the goods or services in association with the label or packaging would be a sale, distribution or advertisement in association with a confusing trademark or trade name; or

(d) manufactures, causes to be manufactured, possesses, imports, exports or attempts to export any label or packaging, in any form, bearing a trademark or trade name, for the purpose of its sale or distribution or for the purpose of the sale, distribution or advertisement of goods or services in association with it, if

marque de commerce ou un nom commercial créant de la confusion;

b) soit fabrique, fait fabriquer, a en sa possession, importe, exporte ou tente d'exporter des produits, en vue de leur vente ou de leur distribution et en liaison avec une marque de commerce ou un nom commercial créant de la confusion;

c) soit vend, offre en vente ou distribue des étiquettes ou des emballages, quelle qu'en soit la forme, portant une marque de commerce ou un nom commercial alors que :

(i) d'une part, elle sait ou devrait savoir que les étiquettes ou les emballages sont destinés à être associés à des produits ou services qui ne sont pas ceux du propriétaire de la marque de commerce déposée,

(ii) d'autre part, la vente, la distribution ou l'annonce des produits ou services en liaison avec les étiquettes ou les emballages constituerait une vente, une distribution ou une annonce en liaison avec une marque de commerce ou un nom commercial créant de la confusion;

d) soit fabrique, fait fabriquer, a en sa possession, importe, exporte ou tente d'exporter des étiquettes ou des emballages, quelle qu'en soit la forme, portant une marque de commerce ou un nom commercial, en vue de leur vente ou de leur distribution ou en vue de la vente, de la distribution ou de l'annonce de produits ou services en liaison avec ceux-ci, alors que :

(i) d'une part, elle sait ou devrait savoir que les étiquettes ou les emballages sont destinés à être associés à des produits ou services qui

(i) the person knows or ought to know that the label or packaging is intended to be associated with goods or services that are not those of the owner of the registered trademark, and

(ii) the sale, distribution or advertisement of the goods or services in association with the label or packaging would be a sale, distribution or advertisement in association with a confusing trademark or trade name.

Deemed infringement under paragraph (1)(b)

(1.01) An infringement under paragraph (1)(b) is presumed, unless the contrary is proven, if a person who is not entitled to use a registered trademark imports goods on a commercial scale that bear a trademark that is identical to, or cannot be distinguished in its essential aspects from, the trademark registered for such goods.

Exception – *bona fide* use

(1.1) The registration of a trademark does not prevent a person from making, in a manner that is not likely to have the effect of depreciating the value of the goodwill attaching to the trademark,

(a) any bona fide use of his or her personal name as a trade name; or

(b) any bona fide use, other than as a trademark, of the geographical name of his or her place of business or of any accurate

ne sont pas ceux du propriétaire de la marque de commerce déposée,

(ii) d'autre part, la vente, la distribution ou l'annonce des produits ou services en liaison avec les étiquettes ou les emballages constituerait une vente, une distribution ou une annonce en liaison avec une marque de commerce ou un nom commercial créant de la confusion.

Présomption de violation aux termes de l'alinéa (1)b)

(1.01) Est réputé, sauf preuve contraire, une violation aux termes de l'alinéa (1)b) le fait pour une personne qui est non admise à employer une marque de commerce déposée d'importer à l'échelle commerciale des produits qui portent une marque de commerce identique à la marque de commerce déposée à l'égard de tels produits ou impossible à distinguer de celle-ci dans ses aspects essentiels.

Exception — emploi de bonne foi

(1.1) L'enregistrement d'une marque de commerce n'a pas pour effet d'empêcher une personne d'employer les éléments ci-après de bonne foi et d'une manière non susceptible d'entraîner la diminution de la valeur de l'achalandage attaché à la marque de commerce :

a) son nom personnel comme nom commercial;

b) le nom géographique de son siège d'affaires ou toute description exacte du genre ou de la qualité de ses produits ou services,

description of the character or quality of his or her goods or services.

Exception – utilitarian feature

(1.2) The registration of a trademark does not prevent a person from using any utilitarian feature embodied in the trademark.

Exception

(2) The registration of a trademark does not prevent a person from making any use of any of the indications mentioned in subsection 11.18(3) in association with a wine, any of the indications mentioned in subsection 11.18(4) in association with a spirit or any of the indications mentioned in subsection 11.18(4.1) in association with an agricultural product or food.

[...]

Depreciation of goodwill

22 (1) No person shall use a trademark registered by another person in a manner that is likely to have the effect of depreciating the value of the goodwill attaching thereto.

Action

(2) In any action in respect of a use of a trademark contrary to subsection (1), the court may decline to order the recovery of damages or profits and may permit the defendant to continue to sell goods bearing the trademark that were in the defendant's possession or under their control at the time notice was given to them that the owner of the registered trademark complained of the use of the trademark.

sauf si elle les emploie à titre de marque de commerce.

Exception — caractéristique utilitaire

(1.2) L'enregistrement d'une marque de commerce n'a pas pour effet d'empêcher une personne d'utiliser toute caractéristique utilitaire incorporée dans la marque.

Exception

(2) L'enregistrement d'une marque de commerce n'a pas pour effet d'empêcher une personne d'employer les indications mentionnées au paragraphe 11.18(3) en liaison avec un vin, les indications mentionnées au paragraphe 11.18(4) en liaison avec un spiritueux ou les indications mentionnées au paragraphe 11.18(4.1) en liaison avec un produit agricole ou aliment.

[...]

Dépréciation de l'achalandage

22 (1) Nul ne peut employer une marque de commerce déposée par une autre personne d'une manière susceptible d'entraîner la diminution de la valeur de l'achalandage attaché à cette marque de commerce.

Action à cet égard

(2) Dans toute action concernant un emploi contraire au paragraphe (1), le tribunal peut refuser d'ordonner le recouvrement de dommages-intérêts ou de profits, et permettre au défendeur de continuer à vendre tout produit portant cette marque de commerce qui était en sa possession ou sous son contrôle lorsque avis lui a été donné que le propriétaire de la marque de commerce déposée se plaignait de cet emploi.

Copyright in works

3 (1) For the purposes of this Act, copyright, in relation to a work, means the sole right to produce or reproduce the work or any substantial part thereof in any material form whatever, to perform the work or any substantial part thereof in public or, if the work is unpublished, to publish the work or any substantial part thereof, and includes the sole right

(a) to produce, reproduce, perform or publish any translation of the work,

(b) in the case of a dramatic work, to convert it into a novel or other non-dramatic work,

(c) in the case of a novel or other non-dramatic work, or of an artistic work, to convert it into a dramatic work, by way of performance in public or otherwise,

(d) in the case of a literary, dramatic or musical work, to make any sound recording, cinematograph film or other contrivance by means of which the work may be mechanically reproduced or performed,

(e) in the case of any literary, dramatic, musical or artistic work, to reproduce, adapt and publicly present the work as a cinematographic work,

(f) in the case of any literary, dramatic, musical or artistic work, to communicate the work to the public by telecommunication,

(g) to present at a public exhibition, for a purpose other than sale or hire, an artistic work created after June 7, 1988, other than a map, chart or plan,

(h) in the case of a computer program that can be reproduced in the ordinary course of

Droit d'auteur sur l'oeuvre

3 (1) Le droit d'auteur sur l'oeuvre comporte le droit exclusif de produire ou reproduire la totalité ou une partie importante de l'oeuvre, sous une forme matérielle quelconque, d'en exécuter ou d'en représenter la totalité ou une partie importante en public et, si l'oeuvre n'est pas publiée, d'en publier la totalité ou une partie importante; ce droit comporte, en outre, le droit exclusif :

a) de produire, reproduire, représenter ou publier une traduction de l'oeuvre;

b) s'il s'agit d'une oeuvre dramatique, de la transformer en un roman ou en une autre oeuvre non dramatique;

c) s'il s'agit d'un roman ou d'une autre oeuvre non dramatique, ou d'une oeuvre artistique, de transformer cette oeuvre en une oeuvre dramatique, par voie de représentation publique ou autrement;

d) s'il s'agit d'une oeuvre littéraire, dramatique ou musicale, d'en faire un enregistrement sonore, film cinématographique ou autre support, à l'aide desquels l'oeuvre peut être reproduite, représentée ou exécutée mécaniquement;

e) s'il s'agit d'une oeuvre littéraire, dramatique, musicale ou artistique, de reproduire, d'adapter et de présenter publiquement l'oeuvre en tant qu'oeuvre cinématographique;

f) de communiquer au public, par télécommunication, une oeuvre littéraire, dramatique, musicale ou artistique;

g) de présenter au public lors d'une exposition, à des fins autres que la vente ou la location, une oeuvre artistique — autre

its use, other than by a reproduction during its execution in conjunction with a machine, device or computer, to rent out the computer program,

(i) in the case of a musical work, to rent out a sound recording in which the work is embodied, and

(j) in the case of a work that is in the form of a tangible object, to sell or otherwise transfer ownership of the tangible object, as long as that ownership has never previously been transferred in or outside Canada with the authorization of the copyright owner,

and to authorize any such acts.

[...]

Conditions for subsistence of copyright

5 (1) Subject to this Act, copyright shall subsist in Canada, for the term hereinafter mentioned, in every original literary, dramatic, musical and artistic work if any one of the following conditions is met:

(a) in the case of any work, whether published or unpublished, including a cinematographic work, the author was, at the date of the making of the work, a citizen or subject of, or a person ordinarily resident in, a treaty country;

(b) in the case of a cinematographic work, whether published or unpublished, the maker, at the date of the making of the cinematographic work,

qu'une carte géographique ou marine, un plan ou un graphique — créée après le 7 juin 1988;

h) de louer un programme d'ordinateur qui peut être reproduit dans le cadre normal de son utilisation, sauf la reproduction effectuée pendant son exécution avec un ordinateur ou autre machine ou appareil;

i) s'il s'agit d'une oeuvre musicale, d'en louer tout enregistrement sonore;

j) s'il s'agit d'une oeuvre sous forme d'un objet tangible, d'effectuer le transfert de propriété, notamment par vente, de l'objet, dans la mesure où la propriété de celui-ci n'a jamais été transférée au Canada ou à l'étranger avec l'autorisation du titulaire du droit d'auteur.

Est inclus dans la présente définition le droit exclusif d'autoriser ces actes.

[...]

Conditions d'obtention du droit d'auteur

5 (1) Sous réserve des autres dispositions de la présente loi, le droit d'auteur existe au Canada, pendant la durée mentionnée ci-après, sur toute oeuvre littéraire, dramatique, musicale ou artistique originale si l'une des conditions suivantes est réalisée :

a) pour toute oeuvre publiée ou non, y compris une oeuvre cinématographique, l'auteur était, à la date de sa création, citoyen, sujet ou résident habituel d'un pays signataire;

b) dans le cas d'une oeuvre cinématographique — publiée ou non —, à la date de sa création, le producteur était citoyen, sujet ou résident habituel d'un pays

(i) if a corporation, had its headquarters in a treaty country, or

(ii) if a natural person, was a citizen or subject of, or a person ordinarily resident in, a treaty country; or

(c) in the case of a published work, including a cinematographic work,

(i) in relation to subparagraph 2.2(1)(a)(i), the first publication in such a quantity as to satisfy the reasonable demands of the public, having regard to the nature of the work, occurred in a treaty country, or

(ii) in relation to subparagraph 2.2(1)(a)(ii) or (iii), the first publication occurred in a treaty country.

[...]

Infringement of Copyright

Infringement Generally

27 (1) It is an infringement of copyright for any person to do, without the consent of the owner of the copyright, anything that by this Act only the owner of the copyright has the right to do.

[...]

Presumptions respecting copyright and ownership

34.1 (1) In any civil proceedings taken under this Act in which the defendant puts in issue either the existence of the copyright or the title of the plaintiff to it,

(b) the author, performer, maker or broadcaster, as the case may be, shall, unless the contrary is proved, be presumed to be the owner of the copyright.

signataire ou avait son siège social dans un tel pays;

c) s'il s'agit d'une oeuvre publiée, y compris une oeuvre cinématographique, selon le cas :

(i) la mise à la disposition du public d'exemplaires de l'oeuvre en quantité suffisante pour satisfaire la demande raisonnable du public, compte tenu de la nature de l'oeuvre, a eu lieu pour la première fois dans un pays signataire,

(ii) l'édification d'une oeuvre architecturale ou l'incorporation d'une oeuvre artistique à celle-ci, a eu lieu pour la première fois dans un pays signataire.

[...]

Violation du droit d'auteur

Règle générale

27 (1) Constitue une violation du droit d'auteur l'accomplissement, sans le consentement du titulaire de ce droit, d'un acte qu'en vertu de la présente loi seul ce titulaire a la faculté d'accomplir.

[...]

Présomption de propriété

34.1 (1) Dans toute procédure civile engagée en vertu de la présente loi où le défendeur conteste l'existence du droit d'auteur ou la qualité du demandeur:

b) l'auteur, l'artiste-interprète, le producteur ou le radiodiffuseur, selon le cas, est, jusqu'à preuve contraire, réputé être titulaire de ce droit d'auteur.

Order for reference

153 (1) The Court may, for the purpose of making an inquiry and report, refer any question of fact in a proceeding to a judge or other person designated by the Chief Justice of the court before which the proceeding is pending.

Directions on reference

(2) Notwithstanding rules 155 to 160, the Court may at any time give directions regarding the conduct of a reference.

[...]

If no genuine issue for trial

215 (1) If on a motion for summary judgment the Court is satisfied that there is no genuine issue for trial with respect to a claim or defence, the Court shall grant summary judgment accordingly.

Genuine issue of amount or question of law

(2) If the Court is satisfied that the only genuine issue is

(a) the amount to which the moving party is entitled, the Court may order a trial of that issue or grant summary judgment with a reference under rule 153 to determine the amount; or

(b) a question of law, the Court may determine the question and grant summary judgment accordingly.

Powers of Court

(3) If the Court is satisfied that there is a genuine issue of fact or law for trial with respect to a claim or a defence, the Court may

Ordonnance de renvoi

153 (1) La Cour peut renvoyer toute question de fait pour enquête et rapport devant un juge ou toute autre personne désignés par le juge en chef de la cour saisie de l'instance, pour agir à titre d'arbitre.

Directives

(2) Malgré les règles 155 à 160, la Cour peut à tout moment donner des directives concernant le déroulement d'un renvoi.

[...]

Absence de véritable question litigieuse

215 (1) Si, par suite d'une requête en jugement sommaire, la Cour est convaincue qu'il n'existe pas de véritable question litigieuse quant à une déclaration ou à une défense, elle rend un jugement sommaire en conséquence.

Somme d'argent ou point de droit

(2) Si la Cour est convaincue que la seule véritable question litigieuse est :

a) la somme à laquelle le requérant a droit, elle peut ordonner l'instruction de cette question ou rendre un jugement sommaire assorti d'un renvoi pour détermination de la somme conformément à la règle 153;

b) un point de droit, elle peut statuer sur celui-ci et rendre un jugement sommaire en conséquence.

Pouvoirs de la Cour

(3) Si la Cour est convaincue qu'il existe une véritable question de fait ou de droit litigieuse à l'égard d'une déclaration ou d'une défense, elle peut :

(a) nevertheless determine that issue by way of summary trial and make any order necessary for the conduct of the summary trial; or

(b) dismiss the motion in whole or in part and order that the action, or the issues in the action not disposed of by summary judgment, proceed to trial or that the action be conducted as a specially managed proceeding.

[...]

Notice of motion

359 Except with leave of the Court, a motion shall be initiated by a notice of motion, in Form 359, setting out

(c) the grounds intended to be argued, including a reference to any statutory provision or rule to be relied on;

[...]

Discretionary powers of Court

400 (1) The Court shall have full discretionary power over the amount and allocation of costs and the determination of by whom they are to be paid.

[...]

Factors in awarding costs

400 (3) In exercising its discretion under subsection (1), the Court may consider

(a) the result of the proceeding;

(b) the amounts claimed and the amounts recovered;

(c) the importance and complexity of the issues;

(d) the apportionment of liability;

a) néanmoins trancher cette question par voie de procès sommaire et rendre toute ordonnance nécessaire pour le déroulement de ce procès;

b) rejeter la requête en tout ou en partie et ordonner que l'action ou toute question litigieuse non tranchée par jugement sommaire soit instruite ou que l'action se poursuive à titre d'instance à gestion spéciale.

[...]

Avis de requête

359 Sauf avec l'autorisation de la Cour, toute requête est présentée au moyen d'un avis de requête établi selon la formule 359 et précise :

c) les motifs qui seront invoqués, avec mention de toute disposition législative ou règle applicable;

[...]

Pouvoir discrétionnaire de la Cour

400 (1) La Cour a le pouvoir discrétionnaire de déterminer le montant des dépens, de les répartir et de désigner les personnes qui doivent les payer.

[...]

Facteurs à prendre en compte

400 (3) Dans l'exercice de son pouvoir discrétionnaire en application du paragraphe (1), la Cour peut tenir compte de l'un ou l'autre des facteurs suivants:

a) le résultat de l'instance;

b) les sommes réclamées et les sommes recouvrées;

- (e) any written offer to settle;
- (f) any offer to contribute made under rule 421;
- (g) the amount of work;
- (h) whether the public interest in having the proceeding litigated justifies a particular award of costs;
- (i) any conduct of a party that tended to shorten or unnecessarily lengthen the duration of the proceeding;
- (j) the failure by a party to admit anything that should have been admitted or to serve a request to admit;
- (k) whether any step in the proceeding was
 - (i) improper, vexatious or unnecessary, or
 - (ii) taken through negligence, mistake or excessive caution;
- (l) whether more than one set of costs should be allowed, where two or more parties were represented by different solicitors or were represented by the same solicitor but separated their defence unnecessarily;
- (m) whether two or more parties, represented by the same solicitor, initiated separate proceedings unnecessarily;
- (n) whether a party who was successful in an action exaggerated a claim, including a counterclaim or third party claim, to avoid the operation of rules 292 to 299;
- (n.1) whether the expense required to have an expert witness give evidence was justified given
 - c) l'importance et la complexité des questions en litige;
 - d) le partage de la responsabilité;
 - e) toute offre écrite de règlement;
 - f) toute offre de contribution faite en vertu de la règle 421;
 - g) la charge de travail;
 - h) le fait que l'intérêt public dans la résolution judiciaire de l'instance justifie une adjudication particulière des dépens;
 - i) la conduite d'une partie qui a eu pour effet d'abrégé ou de prolonger inutilement la durée de l'instance;
 - j) le défaut de la part d'une partie de signifier une demande visée à la règle 255 ou de reconnaître ce qui aurait dû être admis;
 - k) la question de savoir si une mesure prise au cours de l'instance, selon le cas:
 - (i) était inappropriée, vexatoire ou inutile,
 - (ii) a été entreprise de manière négligente, par erreur ou avec trop de circonspection;
 - l) la question de savoir si plus d'un mémoire de dépens devrait être accordé lorsque deux ou plusieurs parties sont représentées par différents avocats ou lorsque, étant représentées par le même avocat, elles ont scindé inutilement leur défense;
 - m) la question de savoir si deux ou plusieurs parties représentées par le même avocat ont engagé inutilement des instances distinctes;
 - n) la question de savoir si la partie qui a eu gain de cause dans une action a exagéré le montant de sa réclamation, notamment celle

- (i) the nature of the litigation, its public significance and any need to clarify the law,
 - (ii) the number, complexity or technical nature of the issues in dispute, or
 - (iii) the amount in dispute in the proceeding; and
- (o) any other matter that it considers relevant.
- indiquée dans la demande reconventionnelle ou la mise en cause, pour éviter l'application des règles 292 à 299;
- n.1) la question de savoir si les dépenses engagées pour la déposition d'un témoin expert étaient justifiées compte tenu de l'un ou l'autre des facteurs suivants :
- (i) la nature du litige, son importance pour le public et la nécessité de clarifier le droit,
 - (ii) le nombre, la complexité ou la nature technique des questions en litige,
 - (iii) la somme en litige;
- o) toute autre question qu'elle juge pertinente.

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-969-21

STYLE OF CAUSE: TECHNO-PIEUX INC. v TECHNO PILES INC.,
TECHNO METAL POST MEDECINE HAT INC.,
MATHIEU BERGEVIN, AND RONDA BERTRAM

PLACE OF HEARING: HEARD BY VIDEOCONFERENCE

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ORDER AND REASONS: CRAMPTON C.J.

DATED: MARCH XX, 2022

APPEARANCES:

R. Nelson Godfrey
Sarah Li
Kyle H. T. Smith

FOR THE PLAINTIFF/
DEFENDANT BY COUNTERCLAIM

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