

Federal Court



Cour fédérale

Date: 20240527

Docket: T-1700-23

Citation: 2024 FC 764

[ENGLISH TRANSLATION]

Ottawa, Ontario, May 27, 2024

PRESENT: Madam Justice St-Louis

BETWEEN:

**MÉCANIQUE DE PERFORMANCE
PANTHERA MOTORSPORTS INC.**

Applicant

and

JAGUAR LAND ROVER LIMITED

Respondent

JUDGMENT AND REASONS

I. Overview

[1] In November 2017, Mécanique de performance Panthera Motorsports Inc. [Panthera], the applicant, filed trademark application No. 1,870,658 for the PANTHERA logo below [the Panthera Mark]:



[2] On November 27, 2019, Jaguar Land Rover Limited [Jaguar], the respondent, filed a statement of opposition against Panthera's application for registration. Jaguar bases its opposition on several grounds, including that set out in paragraph 12(1)(d) of the *Trademarks Act*, RSC 1985, c T-13 [Act]. In connection with this ground, Jaguar submits that the Panthera Mark is unregistrable because it is confusing with trademarks registered by Jaguar, particularly the so-called "Leaper" trademarks bearing registration numbers TMA368,410 and TMA347,855 [Jaguar's LEAPER Marks]:



[3] On May 28, 2021, with the authorization of the Registrar, Panthera amended its registration application to propose a new description of the following products:

(1) Motorcycle and off-road all terrain motor vehicle engines parts and fittings thereof, excluding sport utility vehicle, light truck and automobile engines and parts and fittings thereof.

[TRANSLATION OF FRENCH TRANSLATION] (2) Protective face-shields for protective motorcycle and off-road all terrain motor vehicle helmets 160 4, motorcycle and off-road all terrain motor vehicle protective equipment, namely, helmets, protective supports for shoulders and elbows, excluding protective face-shields for protective helmets and protective equipment for sport utility vehicles, light trucks and automobiles.

(3) Motorcycle and off-road all terrain motor vehicle engines; engines for land vehicles, excluding sport utility vehicle, light truck and automobile engines and parts and fittings thereof; Motorcycles; off-road all terrain motor vehicles, excluding sport utility vehicles, light trucks and automobiles.

(4) Stickers.

(5) Casual clothing, baseball caps.

(6) Sports clothing, motorcycle clothing, namely, pants, shirts, sweatshirts, jackets, vests, chaps, gloves and riding boots.

Used in Canada since at least as early as December 2015 with goods (1), (3) and (4).

Used in Canada since at least as early as December 2016 with goods (5).

[4] Before the Board, Jaguar filed the affidavit of Gianfranco G. Mitrione, corporate counsel for Jaguar Land Rover North America, LLC, sworn on October 22, 2020, and that of Mary P. Noonan, a trademark searcher employed by Jaguar's representatives, sworn on August 26, 2020. Panthera filed the affidavit of Sébastien Montplaisir, President of Panthera, sworn on April 26, 2021, and that of Charlène Luc, a paralegal at the firm Canyon IP Inc., sworn on April 23, 2021. There were no cross-examinations on any of the affidavits.

[5] On May 29, 2023, the Trademarks Opposition Board [Board] allowed Jaguar's opposition pursuant to paragraph 12(1)(d) of the Act and refused Panthera's application pursuant to subsection 38(12) of the Act [Decision]. The Board rejected certain grounds of opposition, namely, those relevant to section 30 of the Act, and noted that the determinative issue is that

raised by paragraph 12(1)(d) of the Act, namely, whether the Panthera Mark is confusing with one or more of Jaguar's trademarks. The Board also noted that the grounds for opposition would be assessed in accordance with the Act as it read prior to June 17, 2019, and that its analysis would focus on trademark Nos. TMA368,410 and TMA347,855, i.e., the Jaguar LEAPER Marks reproduced in paragraph 2 above.

[6] The Board concluded that Jaguar had met its burden of producing sufficient admissible evidence from which it might reasonably be concluded that the facts alleged in support of the ground of opposition under paragraph 12(1)(d) of the Act existed. The Board then concluded that Panthera had failed, on a balance of probabilities, to establish that a ground of opposition should not prevent the registration of its Panthera Mark (*John Labatt Ltd v Molson Companies Ltd*, 1990 CanLII 11059 (FC), 30 CPR (3d) 293 (FCTD); *Christian Dior, SA v Dion Neckwear Ltd (CA)*, 2002 FCA 29) (Decision at para 13).

[7] The Board accepted the ground set out in paragraph 12(1)(d) of the Act and concluded that Jaguar had met its initial burden, so that the burden shifted to Panthera to establish, on a balance of probabilities, that there was no confusion between its mark and Jaguar's (Decision at paras 76–77).

[8] The Board reviewed the likelihood of confusion test and examined the circumstances of the case, including the factors listed in subsection 6(5) of the Act.

[9] With respect to the distinctiveness of certain trademarks and the extent to which they have become known, the Board found that the Jaguar LEAPER Marks had become widely known in Canada in association with Jaguar automobiles and that these circumstances clearly favoured Jaguar (Decision at paras 41–43).

[10] With respect to the length of time the trademarks had been in use, the Board concluded that this factor also favoured Jaguar (Decision at para 45).

[11] With respect to the nature of the goods, services or businesses and the nature of the trade, the Board concluded that the differences between the parties' goods and the establishments through which the goods were sold were not as pronounced as Panthera contended (Decision at para 53).

[12] With respect to the degree of resemblance between the trademarks, the Board found that there was a fair degree of resemblance between the Panthera Mark and Jaguar's LEAPER Marks (Decision at para 61).

[13] The Board examined the circumstances of the case and noted, with respect to the state of the trademarks register, that Ms. Luc's affidavit was of no assistance to Panthera and that the state of the register evidence was incomplete given the lack of information. The Board gave no weight to the registered trademarks identified in the register considering the low number of these third-party trademarks and the absence of evidence of their common use in the marketplace (Decision at para 65). With respect to the family of marks, the Board noted that Jaguar had established the use of a family of marks featuring feline imagery, not only in association with its Jaguar vehicles, but also with a range of derivative products in Canada and concluded that this factor favoured Jaguar (Decision at paras 71–72). The Board also noted that little weight was to be attributed to Panthera's allegations that no instances of confusion had occurred (Decision at para 74). Finally, the Board concluded that Panthera's argument regarding the examiner's failure to cite Jaguar's trademarks was of no assistance to it (Decision at para 75).

[14] On August 14, 2023, Panthera appealed the Board's Decision to the Federal Court pursuant to section 56 of the Act.

[15] Before the Court, Panthera filed a new affidavit from Mr. Montplaisir, President of Panthera, sworn on September 12, 2023. Mr. Montplaisir testified about the research he conducted to verify the commercial use of feline imagery in the industry of products falling under Class 12 of the Nice Classification (Vehicles). He filed nine exhibits in connection with the feline imagery used by ARTIC CAT since at least as early as 2016 and by Dodge (Hellcat) since at least as early as 2015.

[16] Panthera submits that this affidavit constitutes new evidence and that it would have had an impact on the Board's decision and its exercise of its discretionary power had the Board been in possession of it. Panthera submits that this affidavit clarifies the commercial use of feline imagery in association with products falling under Class 12 of the Nice Classification (Vehicles) by parties other than Panthera and Jaguar and that it reduces any risk of confusion between the Panthera Mark and Jaguar's trademarks.

[17] Panthera therefore asks this Court to allow its appeal, set aside the Decision of the Board and order the Registrar to accept its application No. 1,870,658, with costs.

[18] Jaguar appeared before the Court but subsequently filed no evidence and no response to the appeal filed by Panthera. Nor did Jaguar appear at the hearing of this appeal.

[19] For the detailed reasons below, I would allow Panthera's appeal.

II. Analysis

[20] The Court must determine the applicable standard of review and whether the mark is registrable in light of paragraph 12(1)(d) of the Act.

A. *New evidence*

[21] As noted by Madam Justice Janet Fuhrer in *Caterpillar Inc v Puma SE*, 2021 FC 974, aff'd 2023 FCA 4 [*Caterpillar*]:

[32] An appellate standard of review applies where, as in the case before me, there is a statutory right of appeal: Canada (*Minister of Citizenship and Immigration*) v *Vavilov*, 2019 SCC 65 [*Vavilov*] at paras 36-37, citing *Housen v Nikolaisen*, 2002 SCC 33, [2002] 2 SCR 235 [*Housen*]. *Vavilov* does not displace the previous jurisprudence regarding new evidence filed with the Federal Court on appeal from a decision of the Registrar, but rather necessitates an adjustment: *The Clorox Company of Canada, Ltd v Chloretec SEC*, 2020 FCA 76 [*Clorox*] at paras 19-23. The starting point is a consideration of whether any new evidence would have affected the [Trademarks Opposition Board's] decision materially: *Clorox*, above, at para 19.

[22] If new evidence is presented to the Court and is considered material, a *de novo* appeal is triggered, which requires the application of the correctness standard (*Clorox* at para 21; *Caterpillar* at para 3).

[23] If no new evidence is presented to the Federal Court, or if the new evidence is considered immaterial, for questions of fact and questions of mixed fact and law (except for extricable

questions of law), the applicable standard is that of the “palpable and overriding error”, while for questions of law, the applicable standard is correctness (*Clorox* at paras 22–23). To be considered material, the new evidence must be sufficiently substantial and significant, and of probative value (*Clorox* at para 21; *Caterpillar* at para 33)

[24] The test is not whether the new evidence would have changed the Registrar’s mind, but rather whether it would have a material effect on the decision (*Caterpillar* at para 33 citing *Scott Paper Limited v Georgia-Pacific Consumer Products LP*, 2010 FC 478 at para 49).

[25] In addition, only those issues to which the new evidence speaks warrant a fresh analysis by the Court. Where additional evidence is adduced before the Federal Court that would have materially affected the Board’s findings of fact or exercise of discretion, the Court must come to its own conclusions about the issues to which the new evidence relates (*Seara Alimentos Ltda. v Amira Enterprises Inc*, 2019 FCA 63 at para 22 citing *Molson Breweries v John Labatt Ltd.*, 2000 CanLII 17105 (FCA), [2000] 3 FC 145 (CA) at paras 46–51).

B. *Panthera’s position before the Court*

[26] Panthera submits that Mr. Montplaisir’s new affidavit constitutes new evidence and is material. Panthera notes that the Board pointed out that Panthera had not presented any evidence before it of commercial use of feline imagery (Decision at para 65). Panthera argues that Mr. Montplaisir’s new affidavit would have materially affected the Decision and the exercise of discretion by the Board had it been in the Board’s possession, as it clarifies the commercial use of feline imagery in association with products falling under Class 12 of the Nice Classification (Vehicles) by parties other than Panthera and Jaguar.

[27] Panthera notes in particular that Mr. Montplaisir's new affidavit would have materially affected the Board's conclusions regarding the assessment of the inherent distinctiveness of the trademarks under consideration and the exercise of its discretionary power, as detailed at paragraphs 54 to 61 of its Memorandum of Fact and Law [Memorandum].

[28] Panthera adds that Mr. Montplaisir's new affidavit would also have materially affected the Board's findings relating to the evaluation of the other factors/circumstances and affected the exercise of its discretionary power because these various factors/circumstances cannot be evaluated in isolation.

[29] Panthera maintains that, following the admission of Mr. Montplaisir's new affidavit, the Court should proceed with a *de novo* appeal vis-à-vis the conclusions issued by the Board on each of the factors it took into account for the purposes of assessing the risk of confusion.

[30] Finally, Panthera submits that an examination of the factors set out in subsection 6(5) of the Act, in light of the new evidence, supports a finding of absence of likelihood of confusion between the Panthera Mark and Jaguar's trademarks.

C. *Decision*

[31] I agree with Panthera. I find that the evidence is sufficiently substantial and significant and has sufficient probative value to be material and that it would have materially affected the Board's Decision with respect to the risk of confusion and the ground of opposition accepted by the Board under paragraph 12(1)(d) of the Act, the sole ground ultimately accepted by the Board.

[32] However, as mentioned above, the Federal Court of Appeal confirmed that only those issues to which the new evidence speaks warrant a fresh analysis by the Court.

[33] In this case, Mr. Montplaisir's new affidavit addresses other vehicle brands featuring feline imagery and relates to the evaluation of the distinctiveness of Jaguar's trademarks and the state of the trademarks register. I will therefore consider *de novo* the Board's conclusions regarding this factor and then consider the other factors, if necessary, according to the applicable standard of review, and, finally, decide whether Panthera has established, on a balance of probabilities, that the registration of its mark is not likely to create confusion with the Jaguar LEAPER Marks.

[34] I should start by noting that the relevant date for assessing the circumstances in the context of the objection based on paragraph 12(1)(d) of the Act is the date of the Board's Decision, namely, May 29, 2023.

[35] The applicable test for confusion was set out by the Supreme Court of Canada at paragraph 20 of *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, [2006] 1

SCR 824:

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 *Cliquot* on the respondents' storefront or invoice, at a time when he or she has no more than an imperfect recollection of the VEUVE CLICQUOT 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.

[36] When applying the test for confusion, the Court must take into account all the surrounding circumstances, including those specifically enumerated in subsection 6(5) of the Act, the most important of which is the resemblance between the marks (*Clorox* at para 33).

[37] With respect to the distinctiveness evaluation (paragraph 6(5)(a) of the Act), the evidence shows that the use of feline imagery is widespread within the sector of products falling under Class 12 of the Nice Classification (Vehicles) in Canada. Mr. Montplaisir's new affidavit and associated exhibits confirm the use of feline imagery in association with the well-established Dodge and ARCTIC CAT trademarks, and their direct link with the Class 12 products. Ms. Luc's affidavit, presented to the Board, also demonstrates the existence of several trademark registrations featuring feline imagery used in direct association with Class 12 products.

[38] I note that the case law has established that the presence of a common element among several trademarks has significant bearing on the issue of confusion, as noted by the Federal Court at page 456 of *Kellogg Salada Canada Inc v Canada (Registrar of Trade Marks) (CA)*, 1992 CanLII 14792 (FCA), [1992] 3 FC 442, citing Harold G. Fox, *The Canadian Law of Trade Marks and Unfair Competition*, 3rd ed (Toronto: Carswell Co, 1972) at 351:

[I]t is a well-recognized principle that, where those two marks contain a common element that is also contained in a number of other marks in use in the same market, such a common occurrence in the market tends to cause purchasers to pay more attention to the other or non-common features of the respective marks and to distinguish between them by those other features.

[39] Also, when the trademark refers to many things, it is not considered inherently distinctive and will have less protection (*TLG Canada Corp v Product Source International LLC*,

2014 FC 924 at para 60). However, distinctiveness need not necessarily be inherent.

Distinctiveness can also be acquired through continual use in the marketplace: “[T]o establish that distinctiveness has been acquired, it must be shown that the mark has become known to consumers as originating from one particular source” (*Tommy Hilfiger Licensing Inc v Produits de Qualité IMD Inc*, 2005 FC 10 at para 53).

[40] In addition, as noted by Panthera, if several trademarks belonging to various owners share common elements, this generally favours the person applying for registration:

If those marks which have common characteristics are registered in the names of different owners then the presumption is that the common characteristic is a common feature in the trade and registration ought to be allowed. The fact that the marks are owned by different persons tends to negative any proprietorial significance of the common feature and so assists an applicant (*Canadian Olympic Association v Logo-Motifs Ltd.*, 1999 CanLII 9157 (FC) at para 8 citing *Canadian Olympic Association v Techniquip Ltd.*, 1999 CanLII 8993 (FCA) at para 15).

[41] Moreover, Mr. Montplaisir’s new affidavit provides evidence of actual use of these trademarks. These findings are enough to tip this factor in Panthera’s favour.

[42] With respect to the nature of the goods (paragraph 6(5)(c) of the Act), I agree with Panthera’s statements at paragraphs 76 to 88 of its Memorandum. I note that Panthera and Jaguar do not operate in the same area and that the markets in which the marks will appear are distinct. Accordingly, the simultaneous use of the trademarks at issue in the same region could not reasonably lead the relevant consumer to conclude that the goods associated with these trademarks are supplied or managed by the same entity. I find that the Board committed a

palpable and overriding error in concluding that the differences between the two parties as to their goods and the nature of their trade were not as pronounced as Panthera claimed.

[43] With respect to the degree of resemblance (paragraph 6(5)(e) of the Act), I also agree with Panthera's statements at paragraphs 89 to 99 of its Memorandum. I find that the Board erred in not giving sufficient weight to the other circumstances of the case that lead the potential buyers of Panthera's products and those of Jaguar's products, respectively, to pay special attention to the differences between the trademarks under consideration.

III. Conclusion

[44] In light of the new evidence, I find that Panthera has met its burden and demonstrated that the registration of its Mark is not, on a balance of probabilities, likely to be confusing with Jaguar's trademarks. I therefore dismiss the ground of opposition accepted by the Board.

JUDGMENT in T-1700-23

THIS COURT’S JUDGMENT is as follows:

1. The applicant’s appeal is allowed.
2. The Board’s Decision is set aside.
3. The respondent’s opposition is dismissed.
4. The Registrar must allow the applicant’s trademark application No. 1,870,658.
5. Costs are awarded to the applicant under section 407 of the *Federal Courts Rules*, SOR/98-106.

“Martine St-Louis”

Judge

Certified true translation
Francie Gow

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-1700-23

STYLE OF CAUSE: MÉCANIQUE DE PERFORMANCE PANTHERA
MOTORSPORTS INC. v JAGUAR LAND ROVER
LIMITED

PLACE OF HEARING: MONTRÉAL, QUEBEC

DATE OF HEARING: MARCH 27, 2024

JUDGMENT AND REASONS: ST-LOUIS J

DATED: MAY 27, 2024

APPEARANCES:

Philippe Brouillet
Charlène Rambeaud

FOR THE APPLICANT

No appearance

FOR THE RESPONDENT

SOLICITORS OF RECORD:

Brouillette Légal Inc.
Montréal, Quebec

FOR THE APPLICANT

Gowling WLG (Canada) LLP
Toronto, Ontario

FOR THE RESPONDENT