

Federal Court



Cour fédérale

**Date: 20121031**

**Docket: T-1985-11**

**Citation: 2012 FC 1272**

**Toronto, Ontario, October 31, 2012**

**PRESENT: The Honourable Mr. Justice Campbell**

**BETWEEN:**

**CABLE CONTROL SYSTEMS INC.**

**Applicant**

**and**

**ELECTRICAL SAFETY AUTHORITY**

**Respondent**

**REASONS FOR ORDER AND ORDER**

[1] This present Application for judicial review concerns the quality of the evidence of use of a mark required to be submitted to the Registrar of Trade-marks (the Registrar) in order for the Registrar to give public notice of an official mark pursuant to section 9(1)(n)(iii) of the *Trade-marks Act* (the *Act*). In the present case, the Respondent, Electrical Safety Authority (ESA) applied for registration of the mark DIG SAFE as an official mark (the Official Mark) on the basis of a single piece of documentary evidence of adoption and use. The Registrar granted the application and, accordingly, published the Official Mark in in Volume 58, No. 2977 of the Trade-Marks Journal on November 16, 2011.

[2] Prior to the publication of the Official Mark, the Applicant, Cable Control Systems Inc. (Cable Control) had applied for and received the registration of the trade-mark DIG SAFE & Design; the registration was issued on March 1, 2011 under Registration No. TMA791, 850. Cable Control objects to the publication of the Official Mark because, by its publication, Cable Control's trade-mark is no longer entitled to the same degree of exclusivity conferred on registered marks by s. 19 of the *Act*. Cable Control argues that the Registrar erred in deciding to give public notice of the Official Mark because ESA did not meet the onus to establish that it had adopted and used the Official Mark in relation to its the wares or services prior to the date of the public notice.

**I. Context Leading to the Application**

[3] Cable Control provides call centre services to contractors and utilities in order to promote safe practices in excavation and construction. ESA is an administrative authority that oversees electrical safety in the Province of Ontario. It has responsibility for regulating the safe use of electricity and equipment in Ontario, enforcing the Ontario Electricity Safety Code, and appointing inspectors.

[4] In fulfilling its mandate, ESA works with a number of interested parties from the public and private sector. In or about 2003, to promote safe digging practices around underground utility infrastructure, the Ontario Regional Common Ground Alliance (the ORCGA) was formed and supported by ESA, the Technical Standards Safety Authority (TSSA), the Provincial Government, and other stakeholders, including Cable Control.

[5] In addition to providing evidence of its status as a public authority, which is not contested in these proceedings, ESA was also required to provide evidence of its adoption and use in Canada of the Official Mark. ESA provided the Registrar with the spring 2010 edition of its “Plugged In” newsletter (Spring 2010 Newsletter), downloaded from ESA’s website, which shows the Official Mark in an article promoting “DIG SAFE” month and features the accompanying logo. On the basis of this evidence, the Registrar decided to give public notice of ESA’s Official Mark.

[6] The effect on Cable Control from the Registrar’s decision to issue public notice arises out of the protection granted to official marks by s. 9(1)(n)(iii) of the *Act*, which prevents anyone from adopting as a trade-mark any mark likely to be mistaken for a mark adopted and used by a public authority in Canada as an official mark for wares or services. Parties having prior use of an official mark covered by s. 9(1)(n)(iii) may continue to use their mark, but only in association with the wares and services used at the time that the official mark is given public notice. Thus, Cable Control’s ability to expand its trade-mark is curtailed by ESA’s adoption of the Official Mark (*FileNET Corp. v Canada (Registrar of Trade-Marks)*, [2001] 1 FC 266 (FC)).

## **II. Standard of Review**

[7] The jurisprudence states that new evidence is admissible on judicial review of the Registrar’s decision to give public notice of an official mark (*Canadian Jewish Congress v Chosen People Ministries, Inc.*, [2003] 1 FC 29 at para 21 (FCTD); *See You In-Canadian Athletes Fund Corp. v Canadian Olympic Committee* (2007), 57 CPR (4th) 287 paras 14-16 (FC); *Canadian Rehabilitation Council for the Disabled v Rehabilitation Foundation for the Disabled* (2004), 35 CPR (4th) 260 at para 7-16 (FC).)

[8] The effect of new evidence on the standard of review is addressed by Justice O'Reilly in *Canadian Rehabilitation Council for the Disabled* at paragraph 15:

If I conclude that the fresh evidence supplied is probative - in the sense that it would have materially affected the Registrar's decision - I must come to my own conclusion about whether the public authority had indeed adopted and used the official mark. In other words, I must decide whether the Registrar's decision to issue a public notice was correct: Piscitelli, above. On the other hand, if the new evidence would not have had any material effect on the Registrar's decision, I would have to consider whether the decision was reasonable based on the evidence before the Registrar: *Magnotta Winery Corp. v. Vintners Quality Alliance*, 2001 FCT 1421, [2001] F.C.J. No. 1941 (Fed. T.D.) .

[9] Cable Control argues that the new evidence requires a fresh re-examination and that I must come to my own conclusions on this matter. ESA argues that the additional evidence does not materially affect the Registrar's findings, but rather, since it affirms the reasonableness of the Registrar's decision, the appropriate standard of review is reasonableness.

[10] For the reasons that follow, I agree with ESA's argument.

### **III. Adoption and Use**

[11] The *Act* describes the meaning to be given of "adoption" and "use" in the contest of the trade-marks and not official marks. However, this Court has held that the definitions of these terms in relation to trade-marks can assist in the interpretation of s. 9(1)(n)(iii) of the *Act* (*FileNET Corp. v Canada (Registrar of Trade-Marks)*, [2001] 1 FC 266 (FC)).

[12] Section 3 of the *Act* sets out the meaning of "adoption" in relation to trade-marks:

3. A trade-mark is deemed to have been adopted by a person when that person or his predecessor in title commenced to use it in Canada or to make it known in Canada or, if that person or his predecessor had not previously so used it or made it known, when that person or his predecessor filed an application for its registration in Canada.

3. Une marque de commerce est réputée avoir été adoptée par une personne, lorsque cette personne ou son prédécesseur en titre a commencé à l'employer au Canada ou à l'y faire connaître, ou, si la personne ou le prédécesseur en question ne l'avait pas antérieurement ainsi employée ou fait connaître, lorsque l'un d'eux a produit une demande d'enregistrement de cette marque au Canada.

In *FileNET Corp. v Registrar of Trade-Marks*, [2002] FCA 418 (FCA) at paragraph 11, the Federal Court of Appeal addressed what constitutes “adoption” in relation to Section 9:

First, there is the question of what constitutes "adoption" of an official mark. Counsel for Filenet argued that the official mark in question had never been adopted because there is no formal document in the nature of a resolution of a board of directors or government body that constitutes evidence of its formal adoption. However, he was unable to point to any law or regulation that mandates any particular procedure for the adoption of an official mark by a Minister or agency of the Crown. In my view, the question of adoption of an official mark is a question of fact. In this case, and I would expect in most cases, that fact is sufficiently proved by the request to the Registrar to give public notice under section 9 unless there is some cogent reason to believe that the request was not authorized. There is no such reason here.

[13] The meaning of “use” in the *Act* means any use deemed to be a use in association with wares or services by Section 4 of the *Act*:

4. (1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the

4. (1) Une marque de commerce est réputée employée en liaison avec des marchandises si, lors du transfert de la propriété ou de la

normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

possession de ces marchandises, dans la pratique normale du commerce, elle est apposée sur les marchandises mêmes ou sur les colis dans lesquels ces marchandises sont distribuées, ou si elle est, de toute autre manière, liée aux marchandises à tel point qu'avis de liaison est alors donné à la personne à qui la propriété ou possession est transférée.

(2) Une marque de commerce est réputée employée en liaison avec des services si elle est employée ou montrée dans l'exécution ou l'annonce de ces services.

(3) Une marque de commerce mise au Canada sur des marchandises ou sur les colis qui les contiennent est réputée, quand ces marchandises sont exportées du Canada, être employée dans ce pays en liaison avec ces marchandises.

[14] In *See You In-Canadian Athletes Fund Corp. v Canadian Olympic Committee*, 2006 FC 406 (FC), Justice Phelan confirmed that section 3 and 4 of the *Act* can assist in determining adoption or use in relation to an official mark. However, he also provided some guidance as to what is required to establish adoption or use of an official mark, at paragraph 48 of the decision:

While an official mark is not used for commercial purpose or in the course of trade, ss. 3 and 4 assist in the interpretation of those words. A common feature of both "use" and "adoption" is that there is an element of public display, of which there was none established in this case.

It is now accepted that to satisfy the statutory requirement of adoption and use, the public authority must demonstrate that the official mark was made available for public display.

[15] The evidence of adoption and use of the Official Mark before the Registrar was a copy of ESA's Spring 2010 Newsletter. The Official Mark is used in an article announcing that April 2010 is the first annual Dig Safe Month in Ontario. A diamond shaped logo with the words DIG SAFE, with the "I" in the word DIG represented as a man with a shovel in hand, is found next to the article. The newsletter is downloadable from ESA's public website.

[16] Cable Control challenges the Registrar's decision on the grounds that prior to the giving of public notice, ESA did not use the Official Mark in association with its own wares and services. Rather, Cable Control argues, ESA promoted the activities of other parties, like ORCGA, who in turn was the actual user of the mark in question in the Spring 2010 Newsletter. Cable Control views the article in the Spring 2010 Newsletter as mere advertisement by ESA of the activities of ORCGA and other related parties. It submits that this would have been clear to the Registrar if he had inquired into the parties named in the article before him.

[17] Cable Control argues that the information that is before me in these proceedings would have made it clear to the Registrar that the Official Mark was used by ORCGA and not ESA. In particular, it points to ORCGA's application for a trade-mark registration of DIG SAFE & DESIGN, filed by ORCGA in June of 2010. Cable Control also relies on information obtained from its cross-examination of Ms. Jennifer Robertson, a representative of ESA, including the fact that ORCGA never sought permission from ESA to use the Official Mark in association with its

initiatives. Ms. Robertson also testified that the article in the Spring 2010 Newsletter had two objectives: “There were two messages in this article. One was Dig Safe month as message number one. Message number two was the benefits of joining Ontario One Call” (Transcript of Cross-Examination of Jennifer Robertson, Applicant’s Record, p 87). Cable Control argues that the evidence before the Registrar was ESA’s encouragement or endorsement of the projects led by other organizations and that this cannot constitute use of the Official Mark by ESA and, therefore, should not entitle ESA to the broad rights that come with the status of owning an official mark.

[18] In my opinion, the greater context of the use of the Official Mark brought forward by Cable Control does not make the Registrar’s decision unreasonable. I am satisfied that the additional evidence would not have had a material effect on the Registrar’s decision to give public notice of the Official Mark. As pointed out by Counsel for ESA, the Registrar was not required to inquire into other parties’ registrations or uses of the same mark because any such use would have been irrelevant to the decision to give public notice of the Official Mark. All that ESA was required to do was satisfy the Registrar that it was a public authority and that it had adopted and used the mark in question (*FileNET Corp.*, [2002] FCA 418 at para 7 (FCA)).

[19] ESA’s application before the Registrar makes it clear that its mandate is to regulate the safe use of electricity and equipment in Ontario. The testimony of Ms. Robertson also explains that ESA was one of the founding members of ORCGA and that it continues to support this organization in furtherance of ESA’s mandate of public safety education. While the evidence submitted pursuant to Cable Control’s challenge clarifies the relationship between ESA and ORCGA and other parties, it also makes it clear that the Official Mark was used by ESA, ORCGA, TSSA and others

participating in the public education and safety campaign. This after all was the purpose for which the mark was used in the Spring 2010 Newsletter. I find that the use of the mark by ESA and ORCGA for the same purpose does not disentitle ESA from acquiring the mark as an official mark.

[20] As a result, I find that it was reasonable for the Registrar to accept the Spring 2010 Newsletter as evidence of ESA's adoption and use of the official mark.

**ORDER**

**THIS COURT ORDERS that**

The Application for judicial review is dismissed.

As it is the successful party on the present Application, I award costs to the Respondent.

“Douglas R. Campbell”

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Judge

Federal Court



Cour fédérale

**FEDERAL COURT**

**SOLICITORS OF RECORD**

**DOCKET:** T-1985-11

**STYLE OF CAUSE:** CABLE CONTROL SYSTEMS INC. v ELECTRICAL  
SAFETY AUTHORITY

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**DATE OF HEARING:** OCTOBER 25, 2012

**REASONS FOR ORDER  
AND ORDER BY:** CAMPBELL J.

**DATED:** OCTOBER 31, 2012

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