

Federal Court



Cour fédérale

Date: 20130114

Docket: T-116-10

Citation: 2013 FC 27

BETWEEN:

AVOCATS SANS FRONTIÈRES QUÉBEC

Applicant

and

LAWYERS WITHOUT BORDERS, INC.

Respondent

REASONS FOR JUDGMENT

LEMIEUX J.

I. Introduction

[1] On the 29th day of November, 2012 this Court granted the application made on January 16, 2010 by the Applicant, Avocats Sans Frontières Québec (the Applicant or ASFQ) pursuant to section 57 of the Trade-marks Act, RSC, 1985, c T-13 (the Act) to expunge the Trade-Mark “Lawyers Without Borders” (LWOB) registered by the Registrar of Trade-Marks (the Registrar) on January 27, 2005 on application for registration dated October 15, 2003 filed by Lawyers Without Borders Inc. (the Respondent or LWOB Inc), a U.S. Corporation located in Hartford, Connecticut, based on use in Canada since at least as early as July 2001 in association with Legal Services. LWOB Inc was established by Christina Storm. LWOB Inc obtained, on November 4, 2003, its

U.S. registration for the LWOB trade-mark based on first use in the U.S. in association with legal services in that country since January 31, 2000.

[2] The following are the reasons why the expungement application was granted to ASFQ, a non-profit corporation incorporated on October 23, 2002, a member of the Avocats Sans Frontières international movement founded in Belgium in 1992 after the Rwandan massacre.

[3] Section 57 of the *Act* is the foundation for ASFQ's expungement application reads:

57. (1) The Federal Court has exclusive original jurisdiction, on the application of the Registrar or of any person interested, to order that any entry in the register be struck out or amended on the ground that at the date of the application the entry as it appears on the register does not accurately express or define the existing rights of the person appearing to be the registered owner of the mark.

(2) No person is entitled to institute under this section any proceeding calling into question any decision given by the Registrar of which that person had express notice and from which he had a right to appeal.

57. (1) La Cour fédérale a une compétence initiale exclusive, sur demande du registraire ou de toute personne intéressée, pour ordonner qu'une inscription dans le registre soit biffée ou modifiée, parce que, à la date de cette demande, l'inscription figurant au registre n'exprime ou ne définit pas exactement les droits existants de la personne paraissant être le propriétaire inscrit de la marque.

(2) Personne n'a le droit d'intenter, en vertu du présent article, des procédures mettant en question une décision rendue par le registraire, de laquelle cette personne avait reçu un avis formel et dont elle avait le droit d'interjeter appel.

[4] ASFQ grounds its expungement application on the allegation the registration of the LWOB trade-mark in Canada is invalid based on section 18 of the *Act* which reads:

18. (1) The registration of a trade-mark is invalid if

(a) the trade-mark was not registrable at the date of registration, [that date is January 27, 2005]

(b) the trade-mark is not distinctive at the time proceedings bringing the validity of the registration into question are commenced [that date is January 16, 2010], or

(c) the trade-mark has been abandoned,

and subject to section 17, it is invalid if the applicant for registration was not the person entitled to secure the registration.

(2) No registration of a trade-mark that had been so used in Canada by the registrant or his predecessor in title as to have become distinctive at the date of registration shall be held invalid merely on the ground that evidence of the distinctiveness was not submitted to the competent authority or tribunal before the grant of the registration.

[Emphasis added]

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

a) la marque de commerce n'était pas enregistrable à la date de l'enregistrement [cette date est le 27 janvier 2005];

b) la marque de commerce n'est pas distinctive à l'époque où sont entamées les procédures contestant la validité de l'enregistrement [cette date est le 16 janvier 2010];

c) la marque de commerce a été abandonnée.

Sous réserve de l'article 17, l'enregistrement est invalide si l'auteur de la demande n'était pas la personne ayant droit de l'obtenir.

(2) Nul enregistrement d'une marque de commerce qui était employée au Canada par l'inscrivant ou son prédécesseur en titre, au point d'être devenue distinctive à la date d'enregistrement, ne peut être considéré comme invalide pour la seule raison que la preuve de ce caractère distinctif n'a pas été soumise à l'autorité ou au tribunal compétent avant l'octroi de cet enregistrement.

[Je souligne]

Specifically, ASFQ submits:

- (a) On the date of its registration, January 27, 2005, LWOB Inc had not used the trade-mark LWOB in the manner set out in its application for registration. This allegation by the Applicant raises the question whether LWOB Inc used, in Canada, the mark “LWOB” in association with Legal Services;
- (b) As at January 26, 2010, the date this expungement application was launched in this Court, the LWOB trade-mark was not distinctive of its owner LWOB Inc but was rather distinctive of ASFQ in terms of its activities;
- (c) The Trade-mark LWOB has been abandoned by the LWOB Inc; and
- (d) At the time LWOB Inc made its application for registration on October 25, 2003 ASFQ, rather than LWOB was the person entitled to secure its registration in Canada. This allegation by ASFQ raises the issue who and when as between ASFQ and LWOB Inc first used in Canada the LWOB trade-mark.

[5] It is the Court’s judgment that ASFQ has proven that the registration of the LWOB trade-mark in Canada was invalid on two grounds: (1) at the time the expungement application was launched on January 26, 2010 the LWOB registered trade-mark did not actually distinguish the services in association with which that trade-mark is used by LWOB Inc or is adapted so as to distinguish them but rather the trade-mark “Lawyers Without Borders” was distinctive of the activities of ASFQ since 2002.

[6] This Court is also of the view that on the date LWOB Inc made its application for registration, on October 25, 2003, ASFQ rather than LWOB was the person entitled to secure its registration in Canada.

[7] As a result it is not necessary for this Court to decide the two other grounds of invalidity raised by ASFQ.

II. Some key definitions and other statutory provisions

[8] The *Act* contains an interpretation in section (section 2) which sets out key definitions of what is (1) a trade-mark, (2) use, (3) distinctiveness, and (4) confusing. These definitions are set out as follows:

“trade-mark” means	« marque de commerce » Selon le cas :
(a) a mark that is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others,	a) marque employée par une personne pour distinguer, ou de façon à distinguer, les marchandises fabriquées, vendues, données à bail ou louées ou les services loués ou exécutés, par elle, des marchandises fabriquées, vendues, données à bail ou louées ou des services loués ou exécutés, par d’autres;
(b) a certification mark,	b) marque de certification;
(c) a distinguishing guise, or	c) signe distinctif;
(d) a proposed trade-mark;	d) marque de commerce projetée.
...	...

<p>“use”, <u>in relation to a trade-mark, means any use that by section 4 is deemed to be a use</u> in association with wares or services;</p>	<p>« emploi » ou « usage » <u>À l’égard d’une marque de commerce, tout emploi qui, selon l’article 4, est réputé un emploi en liaison avec des marchandises ou services.</u></p>
...	...
<p>“distinctive”, in relation to a trade-mark, means a trade-mark that actually distinguishes the wares or services in association with which it is used by its owner from the wares or services of others or is adapted so to distinguish them;</p>	<p>« distinctive » Relativement à une marque de commerce, celle qui distingue véritablement les marchandises ou services en liaison avec lesquels elle est employée par son propriétaire, des marchandises ou services d’autres propriétaires, ou qui est adaptée à les distinguer ainsi.</p>
...	...
<p>“confusing”, when applied as an adjective to a trade-mark or trade-name, means a trade-mark or trade-name the use of which would cause confusion in the manner and circumstances described in section 6;</p>	<p>« créant de la confusion » Relativement à une marque de commerce ou un nom commercial, s’entend au sens de l’article 6.</p>
[Emphasis added]	[Je souligne]

[9] Various statutory provisions of the *Act* are set out below to appreciate the factual underpinnings of this case.

- (a) Subsection 4(1) tells us when a trade-mark is deemed to be “used” in association with “wares” while subsection (2) indicates when it is deemed to be used with “services”, an undefined term. Simply put, deemed use occurs if that trade-mark “is used or displayed in the performance or advertising of those services”.

- (b) Section 5 of the *Act* sets out the conditions in order for a trade-mark to be deemed to be made known in Canada. That occurs only if the trade-mark is used by that person in a specified country of the Union of Paris made in 1883 as amended, and the services are advertised in association with it.
- (c) Section 6 of the *Act* deals with when a mark is confusing and the factors to be taken into account in making such a determination. The key concept is in subsection 6(2) which provides that “the use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the services or wares associated with those trade-marks are [...] performed by the same person.”
- (d) Section 12 of the *Act* states that subject to section 13 a trade-mark is registrable if it is not confusing with a registered trade-mark.
- (e) Section 16 of the *Act* deals with who is entitled to register a trade-mark; that person includes one that has used in Canada or made known in Canada in association with wares or services unless at the date on which such person so used it or made it known it was confusing with a trade-mark that had been previously used or made known in Canada by another person.

[10] In this expungement proceeding ASFQ, a non-profit corporation, established under the laws of Québec on October 23, 2002, asserts the use in Canada of three trade-marks: “Avocats Sans Frontières”, Lawyers Without Borders” and “ASF” in association with the same wares and services. The wares are publications (bulletins). The services are several in nature; (1) to organize and operate international cooperative projects and missions abroad to strengthen access to justice and

human rights in developing countries through the provision of legal services by volunteer Canadian lawyers, (2) to conduct extensive fundraising activities in Canada to support its activities, (3) organize conferences and information sessions in respect of ASFQ's activities, and (4) to maintain links with Canadian law schools and students who assist, under the supervision of ASFQ, to achieve its objectives.

[11] In the spring of 2008 ASFQ applied to the Canadian Intellectual Property Office (CIPO) for the registration of these three trade-marks on the basis of the following use in Canada of the trade-marks:

- (a) Avocats Sans Frontières; (1) in association with its activities at least since November 2002 (conferences since at least June 2003), (2) and wares since June 2005.
- (b) Lawyers Without Borders; (1) for its activities since at least November 2002 (conferences since at least June 2003), and (2) wares since November 2006.
- (c) ASF; (1) for its activities since November 2002 (conferences since at least June 2003), and (2) wares since at least November 2006.

[12] ASFQ was successful in obtaining the registration of "ASF" in association with the above described wares and services. Registration took place on May 12, 2010.

[13] ASFQ was not successful in obtaining the registration of "Avocats Sans Frontières" or "Lawyers Without Borders" in association with the organization and operation of international cooperative projects, conferences or publications. On February 9, 2009, an Examiner at CIPO

advised ASFQ pursuant to paragraph 12(1)(d) of the *Act* these two trade-marks were not registerable because of a likelihood of confusion with LWOB Inc's registered trade-mark of "Lawyers Without Borders" on January 27, 2005.

[14] ASFQ did not pursue the matter because its lawyers were engaged at that time in another proceeding before CIPO. That proceeding was an application under section 45 of the *Act* to remove from the Register LWOB Inc's registration of "Lawyers Without Borders" on the grounds of non-use and, in particular, the use of its LWOB registered trade-mark was not in association with legal services.

[15] In that section 45 proceeding, both ASFQ and LWOB Inc filed documentary evidence as to use by LWOB Inc and by ASFQ, between June 30, 2005 (the date of registration of the trade-mark by LWOB Inc) and June 30, 2008 (the date of the Notice of non-use proceedings before CIPO).

[16] On October 18, 2010, Member P. Heidi Sprung dismissed the Applicant's section 45 proceeding being satisfied that LWOB Inc had used its LWOB registered trade-mark in association with "legal services" in Canada: See [2010] TMOB No 169. The specific legal services which LWOB Inc had itemized and which ASFQ challenged as not being legal services were:

- Coordinating the provision of legal services which are either[sic] needed by Canadian organizations, including non-governmental organizations such as Los Pescadores de La Playita and NGO working in 2006 supported through law students at McGill University;
- Consulting with organizations and/or lawyers in Canada in the development and implementation of global rule of law programming using Canadian lawyers;

- Overseeing and managing Canadian lawyers working on global rule of law programming;
- Researching legal issues; and
- Consulting about the provision of pro bono legal services with Canadian law students and lawyers, legal organizations, Canadian granting agencies and members of the Canadian Judiciary

[17] Member Sprung was satisfied that all items listed were not the provision of legal services except the first item, namely coordination of legal services.

III. The Applicant's Case

[18] ASFQ filed four affidavits in support of its expungement action.

(a) The Affidavit of Pascal Paradis

[19] The main affidavit is from Pascal Paradis, a lawyer and a founding member of ASFQ in 2002 and its Director General since 2004. This affidavit is dated June 10, 2010, has 62 paragraphs deposited in French and has 75 exhibits which run over 713 pages.

[20] The purpose of his affidavit is to support its allegations in this case and, in particular, that at least since 2002 ASFQ used its three trade-marks; "Avocats Sans Frontières", "Lawyers Without Borders" and "ASF" in association with its wares and services; being the organization and operation of international cooperative projects, the fundraising activities in support of such projects and missions as well as the organization of conferences in respect of its activities.

[21] In addition to those objectives, Mr. Paradis indicates that ASFQ (the corporate organization) is recognized as an important participant in the field of international cooperation in judicial matters

being financed by Canada's Department of Foreign Affairs and International Trade (DFAIT) as well as the Canadian International Development Agency (CIDA). He says ASFQ is also funded by provincial and municipal governments totalling more than \$600,000 as of the date of his affidavit.

[22] He asserts that since May 2002 ASFQ operates a non-for-profit organization whose mission is to support the defence of human rights of vulnerable persons or groups in fragile countries by reinforcing access to justice and legal representation and in that context since that time ASFQ participated in at least 70 humanitarian missions in Canada plus 12 other countries the main missions being in Columbia (since 2003 to date); Haiti (since 2006 to date) and Guatemala (since 2009 to date).

[23] ASFQ also carries out extensive funding activities in Canada in association with its three trade-marks which to date has yielded in excess of \$685,000 from the public.

[24] ASFQ has, as of the date of his affidavit, a full time staff of eight persons, a seven member board of directors under the leadership of former Supreme Court of Canada Justice Claire L'Heureux-Dubé. It is assisted by many supporters located across Canada. Its current yearly budget is more than \$2.6 million.

[25] He adds that in order to recruit lawyers and jurists who participate in ASFQ's missions ASFQ, since June 2002, has held events and organized recruitment campaigns or sessions in Canada all in association with all or some of its three trade-marks. He appends to his affidavit an e-

mail solicitation for *pro bono* lawyers which he states was distributed on the internet on the web-sites of the Québec Bar both local and provincial.

[26] He also states that since June 2002 ASFQ's trade-marks have appeared many times in French and English throughout Canada in promoting its services. It has had a web-site since 2004, has published on the internet since June 2005 a bulletin in association with those marks and since November 2006 has published a blog aimed at the Canadian legal community to continuously update it on the activities ASFQ is engaged in.

[27] He also states in his affidavit ASFQ has extensive cross-country membership of 200 members in good standing (500 over time). Individual members provide legal services through volunteers who interface with their foreign counterparts.

[28] He indicates ASFQ is supported by the Canadian Bar Association, numerous Canadian law firms, major corporations and many law schools.

[29] Mr. Paradis's affidavit shows and evidences that ASFQ and its three trade-marks, since June 15, 2002, have been referenced at least 150 times in major Canada-wide newspapers aimed at the public in general and specifically to the legal community as well as radio and TV outlets such as the CBC and Radio Canada (See also Exhibit 14 to his affidavit). A review of those media outlets shows they include the most prominent outlets, in both English and French.

[30] He states in his affidavit and evidences in exhibits that ASFQ, in liaison with its trade-marks, promotes its activities pointing to 30 press releases since February 10, 2003.

[31] He states the ASFQ activities and humanitarian missions required organizing since May 2002 over 100 meetings in association with its trade-marks and has organized over 100 conferences and public information sessions in association with its marks.

[32] From paragraph 23 to 55 of his affidavit Pascal Paradis spells out in considerable detail, supported by exhibits, the use of ASFQ of its three trade-marks (Avocats Sans Frontières, Lawyers Without Borders and ASF) in association with its several activities (publication of bulletins since June 2005), the operation of an internet site since January 2004 to May 2010 (monthly average usage 6,855 visits, 27 pages seen 8,172 times and 2,527 downloads) as well as the operation of a blog since November 2006 to which must be added usage linked to the organization of its missions abroad and its extensive fund raising activities and conferences.

[33] He also deposed as to the defendant LWOB Inc. He asserts that on the date he signed his affidavit on June 10, 2010 he had no knowledge of any activity by LWOB Inc in Canada. He also states that on March 25, 2009 he met Jerry Kovacs at a cocktail who said he had been mandated by Christina Storm, the founder of LWOB Inc, to establish an LWOB Inc branch in Canada which means that as of that date LWOB Inc had no branch in Canada.

(b) The Affidavit of Catherine McKenna

[34] In her affidavit Catherine McKenna, who has been the Executive Director of Canadian Lawyer Abroad (CLA) since January 2005, deposes that in or around September 2004 she and Yasmin Shaker entered into preliminary discussions with Christina Storm, the founder of LWOB Inc in 2000, to explore the possibility of establishing a LWOB Inc chapter in Canada. Nothing came of that initiative. Catherine McKenna was not cross-examined.

(c) The Affidavit of Gail Davidson

[35] In her affidavit Gail Davidson, the Executive Director of Lawyer Rights Watch Canada (LRWC) since its incorporation in 2002, says she knows the legal community who promote human rights and the rule of law internationally by protecting advocacy rights. She indicates she routinely works with human rights NGOs around the world in the furtherance of its mandate, including ASFQ. She does not mention LWOB Inc. Gail Davidson was not cross-examined. She deposes the following in paragraphs 5 to 9 of her affidavit:

I have read the affidavit of Christina Storm sworn August 13th 2010, as well as pages 27 and 28 of the condensed version of the transcript of Ms. Storm's cross-examination on November 9, 2010 and make this affidavit in response thereto.

In the late summer or early fall of 2003, I was contacted in my capacity of Executive Director of LRWC by one Christina Storm, who identified herself as being in the process of starting a "lawyers without borders" organization in the Unites States. Ms Storm and I both expressed interest in working together in the future.

Ms Storm informed me that her first priority was to develop solid funding for the planned organization before embarking on any major work but that her group could perhaps provide some help with research.

In response, in or about October 2003, I sent Ms Storm a proposal enquiring about possible research assistance that her group might

provide with respect to a LRWC project regarding the right to be represented by counsel of choice. To the best of my recollection, Ms Storm did not provide the assistance we were seeking.

LRWC has not worked with Ms Storm's organization. In particular;

- a) To the best of my recollection, LRWC was never connected with pro bono volunteers or with student groups by Ms Storm; and
- b) Neither Ms Storm nor her organization has ever provided legal services to LRWC, or provided or offered to provide, any management, oversight or quality control services to LRWC.

[Emphasis added]

(d) The Affidavit of Denise Pope

[36] Denise Pope is a paralegal with the law firm before me representing ASFQ. She was not cross-examined. She exhibits the result of her searches. She consulted on June 16, 2010 the LWOB Inc internet site and Canada Revenue Agency's records of charitable organization operating in Canada. She was able to find an affidavit filed by Christina Storm in the section 45 proceedings which, as noted, ASFQ had launched. That affidavit is dated December 30, 2008. In it Christina Storm states, at paragraph 3, that her LWOB trade-mark in Canada is:

... registered in relation to "legal services" and LWOB has been providing legal services in Canada continuously since at least October 15, 2003. For greater certainty, I can confirm that LWOB was providing legal services in Canada in association with the trade-mark LAWYERS WITHOUT BORDERS in the period from June 2005 through June 2008 and continues to do so to date. The form of those legal services which LWOB has offered and provided in Canada in association with the trade-mark LAWYERS WITHOUT BORDERS (and continues to offer in Canada) include:

- a. Coordinating the provision of legal services which are either needed by Canadian organizations, including non-governmental

organizations such as **Los Pescadores de La Playita** an NGO working in 2006 supported through law students at McGill University;

- b. consulting with organizations and/or lawyers in Canada in the development and implementation of global rule of law programming using Canadian lawyers;
- c. overseeing and managing Canadian lawyers working on global rule of law programming;
- c. (sic) researching legal issues; and
- d. consulting about the provision of pro bono legal services with Canadian law students and lawyers, legal organizations, Canadian granting agencies and members of the Canadian Judiciary.

[Emphasis added]

[37] Ms. Storm further states, in her December 2008 affidavit, that since at least 2003 LWOB Inc has had a permanent representative in Toronto, Marion Williams. She describes Marion Williams' activities in these terms:

Ms. Williams has managed Canadian volunteers, diplomatic relationships and other Canadian involvement in LWOB's work from offices she maintains in Toronto there. Examples of the work Ms. Williams has managed in Canada in the provision of legal services by LWOB in association with the trade-mark LAWYERS WITHOUT BORDERS in the period from June 2005 to June 2008 include grant drafting and preparation, networking program funding opportunities, attending a diplomatic briefing/lunch meeting in Canada, and maintaining documentation and supporting individuals travelling through Canada from countries in which they may not be allowed to carry such documents.

[Emphasis added]

[38] Denise Pope also filed another document she retrieved from the LWOB Inc website. That document is a LWOB Inc NGO intake form addressed to organizations in need of *pro bono* legal services. The note at the bottom reads:

NOTE: At no time will a lawyer-client relationship be created between your organization and LWOB or any law firm reviewing your application until a formal retainer agreement between your organization and the law firm is executed by both parties. LWOB does not represent NGO's or individuals.

[Emphasis added]

IV. The Respondent's Case

[39] LWOB Inc filed the affidavit of Christina Storm in support of its opposition to ASFQ's expungement proceeding. It was sworn on August 13, 2010. She was cross-examined. She is the Executive Director and President of LWOB Inc since its foundation by her in early 2000. Since 2006 she has been paid as an employee. Globally, LWOB Inc has five paid employees and one retained outside consultant as of the date of her affidavit.

[40] Specifically, relating to Canada, she states that LWOB Inc has been operating in Canada as early as 2001 and "that during this time we have continuously and actively promoted LWOB Inc and its goals and visions to the Canadian legal community". In this August 2010 affidavit she described LWOB Inc's objectives in this way:

- (a) Provide access to the Canadian legal community, including lawyers, students, universities, and professors, resources for plugging in to the international *pro bono* community;
- (b) Provide Canadian resident volunteers with opportunities to participate in rule of law programs, mentoring programs, community outreach, and legal education in developing nations;
- (c) Connect Canadian NGOs with volunteers for legal-centric projects in Canada and abroad;
- (d) Provide opportunities in Canada to Canadian (sic) law students to participate in legal research projects;

- (e) Promote LWOB and its projects in the Canadian legal community, including to law students, law professors, lawyers, law firms, and judges.

[41] I summarize below the main elements of her affidavit.

[42] At paragraphs 6 and 7 she speaks of a Canadian lawyer, Marion Williams as having “been operating under the direction of LWOB since its inception and was LWOB’s representative in Canada from about 2001 to the present.” She adds “Ms. Williams was involved in shaping the *pro bono* model that LWOB uses today. For example, Ms. Williams helpd (sic) LWOB demonstrate that, and how, lawyers from all over the world can draw upon their diverse skill sets and contribute to rule of law programming for a developing nation. Ms. Williams was also involved in identifying the generic skill sets of lawyers around the world, particularly within Canada and how those skills should be applied to the legal needs of developing countries.” She appends as exhibit “A” a copy of a report prepared by Marion Williams.

[43] At paragraph 7 of her affidavit Christina Storm states that as part of her work at LWOB Marion Williams spearheaded LWOB’s Africa Child Project by drafting proposals seeking funding from the Canadian Government and managed and led a team of volunteers interested in launching LWOB into rule of law projects in Africa, concluding she:

[...] was a key point person for LWOB in its volunteer and government relations in Canada. Canadian inquiries were most often either referred to Ms. Williams or involved Ms. Williams. Ms. Williams has consistently been a strong promoter and representative of LWOB since we began formal operations in Canada in 2001.

[44] In paragraph 8 of her affidavit she states that LWOB representatives promote LWOB and its legal services whenever “we are invited to attend at conferences, seminars, career fairs, universities and law firms”, adding that “these promotions include newsletters and the web-site which all prominently feature its trade-mark ‘Lawyers Without Borders’”. She then mentions she attended, in 2001 an educational program in Nova Scotia relating to peacekeeping and asserts she promoted LWOB using LWOB promotional material which incorporates the LWOB trade-mark with the legal services LWOB Inc offers in Canada and abroad and “connected with many people, lawyers and non-lawyers alike some of whom became partners in our work”. She mentions meeting Peter Bach, an instructor at Pearson Peace Keeping Centre, who contributed in LWOB Inc’s newsletter in April 2002 which she appends as exhibit “B” to her affidavit.

[45] At paragraph 9 of her affidavit she deposes as follows:

In and around 2003, LWOB’s representatives in Canada (Ms. Williams and Hamid Mojtabehi (attended at least one career conference at McGill University to promote the work that LWOB was doing in Canada and abroad. The goal was to raise awareness of LWOB and to make connections with law students and law professors and highlight for them the *pro bono* opportunities they might enjoy through work with LWOB. Marked as an Exhibit “W” is a photograph taken during the conference. At this conference, attendees were directed to the LWOB website which has always borne the trade-mark LAWYERS WITHOUT BORDERS.

[Emphasis added]

[46] She then states that Mr. Hamid Mojtabehi travelled to Iran twice representing LWOB in its effort to observe one or more trials and recently volunteered to visit Iran a third time on behalf of LWOB to observe any trial that might be conducted involving three American citizens arrested on charges of espionage. She also deposes that in the summer of 2010 she spoke to a Canadian judge

about an effort to create a training program, in French, relating to common law and civil law trial differences for a launch in francophone West Africa.

[47] At paragraph 12 of her affidavit she deposes as to “the efforts, in different time periods”, by a third party to establish a LWOB operational base in Canada. She states that in both cases discussions fell through because “the third parties wanted to use the LWOB trade-mark but did not want to advertise any connection with LWOB world headquarters nor want to have any USA domiciled members of LWOB sitting on their board.” She added, “one of the groups which splintered off from the LWOB volunteer thereafter founded an NGO known as ‘Canadian Lawyers Abroad’ ”.

[48] At paragraph 13 of her affidavit she states that LWOB Inc connects with Canadian NGOs in need of legal services in Canada with student groups and/or lawyers in Canada adding:

LWOB manages, oversees and controls the quality of the legal services provided by the individuals and any of its representatives in varying degrees depending on the entity involved. For example, in and around 2003, we connected Lawyers Rights Watch of Canada with *pro bono* volunteers, and with a student group at the University of Ottawa. Around the same time, we expended (unsuccessfully however) significant effort to procure *pro bono* counsel for a Canadian NGO, Refugee Education Sponsorship Program: Enhancing Communities Together (RESPECT) that had submitted an online request at our website where the trade-mark LAWYERS WITHOUT BORDERS was used, seeking *pro bono* assistance.

[49] In the next paragraph to her affidavit she indicates that in 2006, LWOB Inc supplied MBA’s Without Borders, an Ottawa-based NGO, with *pro bono* lawyers providing legal services under the quality control of LWOB Inc who advised that NGO in:

- (a) reviewing and updating existing contract templates;
- (b) developing new contracts and policies;
- (c) providing corporate governance and due diligence advice to the board of directors;
- (d) providing tax advice and general organizational advice;
- (e) registering tax exempt regional offices around the world.

[50] She appends as exhibit “V” to her affidavit MBA’s Without Borders “Request for *pro bono* Legal Assistance.”

[51] At paragraph 15 of her affidavit she deposes that in 2002 and through the present date LWOB Inc hosted an “opportunities board” on the internet for job seekers looking for intern, student or lawyer opportunities in Canada or elsewhere to participate in internationally oriented rule of law projects and that this “opportunities board” prominently displayed the LWOB trade-mark. She, however, only identified McGill University who “for several years” paid the necessary subscription for access to the opportunities board. She adds that in 2004 LWOB launched a public job board which was available to the public at large.

[52] At paragraph 16 of her affidavit Christina Storm refers to LWOB Inc having employed as staff and having hosted interns and full time volunteer lawyers from Canada and/or from Canadian Universities which she described in the following way:

- (a) In 2008, we hired a student from McGill, Firas Ayoub, as a summer intern. Mr. Ayoub learned of LWOB through the internet and the LWOB website which promotes our legal services in association with our trade-mark, LAWYERS WITHOUT BORDERS;

- (b) LWOB's UK operations were overseen for the year 2009-2010 by a Canadian citizen and law graduate;
- (c) A major Latin America (LAC) based project was managed from 2008-2009 by a graduate of McGill University;
- (d) Individuals based in Canada assisted with support of LWOB legal services involved in that LAC project.

[53] In paragraphs 17 to 23 Christina Storm describes LWOB Inc's work with Canadian universities stating that "Canadian University students have historically formed an integral part of LWOB Inc's volunteer network." She identifies that in 2001 LWOB Inc "initiated its first official research project in Canada in conjunction with the University of Ottawa" adding that "in our interactions with the University and its volunteers the LWOB trade-mark was displayed on most if not all correspondence." She indicates LWOB Inc coordinated with the University of Ottawa law students and a law professor to conduct legal research on various rule of law topics and appends as exhibit "C" to her affidavit a report describing the project work that was done at the University of Ottawa. She again emphasizes LWOB Inc distributed promotional material to the student volunteers working on the project. She concluded:

This initial project became the model for future collaborations with various student bodies from Canadian Universities – from this model, we established CLEARs: Creating Legal Accessibility and Resources with Students. CLEARs was created to allow us to work with Universities to conduct legal research projects. I believe that model developed by LWOB is a core activity of the Canadian NGO Canadian Lawyers Abroad formed by former LWOB volunteers.

[Emphasis added]

[54] In the next paragraph she deposes that the model involves NGOs from around the world with legal needs. She adds:

We turned to the pro bono student to service and resource the legal research which often supported actions filed or contemplated in world courts. Our model always required at least one law professor in Canada overseeing the Canadian students. Thereafter, we used the model created and launched so successfully in Canada as an example in other law schools, notably in the United Kingdom and America. Since the first project in 2001, there have been research projects conducted by Canadian law students, including those at the University of Toronto and McGill University.

[55] She next described as part of LWOB Inc marketing efforts with Canadian Universities, Canadian lawyers and Canadian law firms; “our recruitment brochure to introduce law students and lawyers to the concept of *pro bono* and LWOB Inc’s projects which materials prominently displayed the LWOB trade-mark.” She appends as exhibit “E” to her affidavit a letter sent in 2002 to the University of Toronto attaching the recruitment brochure and other promotional material.

[56] At paragraph 21 of her affidavit she indicates that from about 2004 to about 2009 two representatives of LWOB Inc, students at the University of Toronto, worked with various teams of the University of Toronto on a variety of legal research projects, emphasizing that one of the representatives assisted with the planning of the North and South tour of a prominent Iranian lawyer.

[57] Paragraphs 22 and 23 of her affidavit read:

From time to time, LWOB is invited to speak with Canadian law students to introduce the concept of legal *pro bono* work in international law and rule of law matters – our presentations prominently display the LAWYERS WITHOUT BORDERS trade-marks. Marked as Exhibit “G” is a presentation that was delivered to students at Osgoode Hall Law School in 2004.

In 2006, a group of law students from McGill University submitted a request through our online *pro bono* lawyer assistance request

mechanism seeking assistance in a case in Panama, where a group of fishermen were being relocated in order facilitate a development project. LWOB was able to procure lawyers to assist and provide legal services for the project only to discovery that the students had opted not to continue with their support of the group in Panama.

[58] In the next several paragraphs, Christina Storm deposes as to LWOB's Canadian lawyer representatives and volunteers who are involved in a wide variety of LWOB activities in Canada and abroad. She states "we have over 200 volunteers who have been identified as residing in Canada representing a significant percentage of our overall volunteer network", adding:

We keep track of our volunteers through an online database tool that we created several years ago (replacing our listserv, which also included people and organizations residing in Canada) and maintain to this day. Since as early at 2001, we have periodically sent e-mails to people and/or organizations in our listserv and/or database, promoting legal services and providing news regarding LWOB projects and activities around the world under the trade-mark LAWYERS WITHOUT BORDERS and continue to do so to this day.

On numerous occasions, LWOB has worked, in conjunction with Canadian lawyers, to assess and observe the legal and justice systems in developing nations, including Namibia, West Bank, Iran and Liberia. For example, one of our volunteers Stephanie Case, under the direction and control of LWOB and who at various times during her law school and subsequently her legal career, has worked in a variety of developing nations on a variety of rule of law programs including international human rights issues.

During 2007-2008 Ms. Case worked with us during the C40 Trial Observation in Ethiopia, networking with the local legal community and conducting legal research and spearheaded our effort to obtain access to inmates who were accused of serious crimes.

In 2006-2000 Ms. Case was placed at an NGO in Rwanda then called Sisters with Rwanda for whom LWOB Inc acted as a fiscal sponsor and provided legal and other support services to this NGO.

In 2007 Ms. Case travelled to Liberia to conduct a post-program evaluation of one of our projects in that area. She and another

volunteer from Ireland were involved in observing trials and reaching out to the community through various promotional activities.

[59] Exhibit “H” to Christina’s affidavit is Ms. Case’s report detailing her observations from hearings held in the Supreme Court, Temple of Justice. She adds:

Most recently Ms. Case travelled to the West Bank to conduct due diligence and investigated partner prospects. Her efforts including identifying potential local organizations to practice with and meetings with local universities as well as with LWOB Inc’s own counsel in the region.

[60] At paragraph 26 of her affidavit she states: “In the last few years alone we have briefed and dispatched a number of Canadian lawyers into the rule of law assessments, trial observations and other projects around the world.” She states that “Canadian lawyers have been sent to Kenya, Uganda and Namibia on our behalf”. She gives the example of Michael Wickum, a Canadian criminal lawyer who volunteered to investigate the rural legal needs in Uganda in connection with a UN request of LWOB to suggest mechanisms for residents in Uganda’s rural areas. She appends Mr. Wickum’s assessment report in 2008. “We dispatched a Canadian lawyer and law graduate to manage our UK operations in London”.

[61] The next chapter in her affidavit is entitled “LWOB’s promotional activities” mentioning the following:

- (a) Since its inception in 2002 LWOB has distributed a digital newsletter in Canada via its website. This newsletter “in which we promote and offer LWOB’s legal services has always carried the LWOB trade-mark and since as early as April 2002 LWOB Inc has distributed a printed newsletter to Canadian lawyers, law firms, NGOs and at conferences, legal seminars and speaking engagements in Canada and

elsewhere.” She states “we distribute hundreds of these newsletters every year in order to raise awareness of LWOB” – numerous copies of the newsletter which is a hard copy of the newsletter posted on its website.

- (b) She also indicates that sometime between 2006-2008 she was a guest speaker on a radio talk-show in Canada focussed on Lawyers Without Borders.
- (c) She states the web-site was created in approximately 2001 but before that a different web-site was launched with the founding of LWOB Inc in February 2000.

[62] In the next paragraphs she provides statistics on Canadian visits to the LWOB current web-site stating that Canadians continue to be among the most frequent visitors to that web-site: (1) 300 visits from Canadians in July 2010 alone; 6,800 people in Canada last year. She concludes:

This suggests that people in Canada, including NGOs, are visiting the LWOB website looking at the legal services provided and promoted by LWOB in Canada, and signing up to receive our digitized edition of our newsletter. Marked as Exhibit “N” is a separate analytic printout showing a breakdown of visitors by page of LWOB’s website visited between 2009 and 2010. This website has always featured the trade-mark LAWYERS WITHOUT BORDERSE.

[63] In the last chapter of her affidavit Christina Storm speaks to the topic of “ASF’s World-Wide Strategy”. At paragraphs 36 to 46 she states the following:

From time to time, LWOB was made aware of articles in journals, newspapers and other printed publications which featured lawyers associated with *Advocats (sic) Sans Frontière Québec* (“ASF”). These articles typically made reference to “lawyers without borders” being founded in North America in 2002. When these were brought to our attention we wrote letters to the publications to ensure that they understood that LWOB had not association with ASF, despite their unlicensed use of our trade-mark. Factual corrections were also made, clarifying that Lawyers Without Borders in North America was founded in February 2000.

[64] She states that in June 2002 she sent a letter to the LA Times regarding an article referring to ASF as Lawyers Without Borders. “We advised them that ASF had no association with LWOB.”

[65] She deposes that on May 5, 2004 “we wrote to Canadian Lawyer Magazine advising them that ASF had no association with LWOB.”

[66] She indicates that “most recently, April 15, 2009, we wrote to the National Post advising that they had improperly used the LWOB trade-mark in association with a group that was not associated with LWOB.”

V. The Issues

(a) Those raised by the Applicant ASFQ

[67] The case raised by ASFQ is whether it has led sufficient probative evidence to meet its burden that the LWOB trade-mark registered on January 27, 2005 was invalid on one or more of the four grounds of invalidity it invoked under sections 18 and 57 of the *Act*.

[68] In particular, ASFQ submitted that the only affidavit produced by LWOB Inc in support of its position, the affidavit of Christina Storm, should be given little weight because she provided significant contradictory evidence on the issue of first use of the LWOB trade-mark in Canada, on the issue of when her Canadian representative, Marion Williams, was first employed in Canada and the lack of corroborative evidence which had been reviewed by the affiant Christina Storm but not produced.

(b) Those raised by the Respondent LWOB Inc

[69] The owner of the LWOB trade-mark raised the following issues:

- (a) ASFQ has failed to meet its burden to prove any of its grounds of invalidity relying on the principle that there exists a presumption of validity when a trade-mark is registered.
- (b) ASFQ has attempted to violate the rule in *Browne v Dunn* (1893), 6 R 67 (HL) by filing the Davidson and the McKenna affidavits only after Christina Storm had been cross-examined on her affidavit. LWOB Inc submits those two affidavits should be given no weight to the extent they are relied on to challenge or question Ms. Storm's credibility.
- (c) LWOB Inc next comments on the use by ASFQ of its Avocats Sans Frontières mark and the LWOB mark stating it is a French language based organization and only recently sought to take the name LWOB from LWOB Inc. It states, at paragraph 30 of its memorandum:

Mr. Paradis' evidence shows that if any mark was used by ASF Québec prior to registration it was AVOCATS SANS FRONTIÈRES QUÉBEC, ASFQ, ASF QUÉBEC, AVOCATS SANS FRONTIÈRES. Any use, even of the above marks was principally in Québec.

- (d) Adding at paragraph 69 that:

Where the term LWOB has been used by ASFQ in conjunction with other marks of ASFQ the presence of "Québec" in those marks changes the nature of the mark and results in a mark which would not be confusing with LWOB Inc's mark and that any use of the term LWOB by ASFQ is insufficient to negate the distinctiveness of the mark in respect of the services of LWOB Inc.

[70] It concludes on the point that ASFQ's use of the LWOB mark is narrow and inconsistent.

VI. Analysis and Conclusion

[71] I make the following finding based on the analysis set out below and my review of the extensive evidence provided by the parties.

[72] First, there has been no breach of the rule of *Browne v Dunn*. Pursuant to Rule 84(1) of the Federal Courts Rules (SOR/98-106) (the Rules) a party may not cross-examine on an opponent's affidavits until the party has served and filed its own affidavits. However, the sequence may be altered by leave of the Court. Moreover, Rule 312(a) of the Rules provides that a party may file additional affidavits with leave of the Court. This happened with the consent of LWOB Inc in this case with the Davidson and the McKenna affidavits by Order of Prothonotary Morneau.

[73] Second, a review of the answers Christina Storm gave on cross-examination shows her affidavit can only be given low weight on major issues such as the date of first use in Canada of the LWOB mark. She provided significant contradictory evidence in two affidavits on the date of first use and on Marion Williams' representation function for LWOB Inc in Canada. Parts of her affidavit were impugned by the Davidson and the McKenna affidavits. Often she could not provide details in respect of questions asked relying on documents which she had reviewed but not produced.

[74] Third, in cross-examination Pascal Paradis maintained the allegation stated in his affidavit and more importantly, corroborated his statements with extensive documentation which shows extensive use of the LWOB mark by ASFQ. This in contrast to the Christina Storm affidavit which contains only 19 documents.

[75] Fourth, in terms of lack of distinctiveness of the LWOB mark, LWOB Inc admits that the registered mark does not possess inherent distinctiveness so the question arises whether the registered mark, LWOB, acquired distinctiveness through continuous use such that the mark points to LWOB Inc as the source of its services. I need not decide this specific point because the law is clear that the use by ASFQ of the LWOB registered mark may negate its distinctiveness. The question to be settled is whether, at the date the expungement proceedings were launched, i.e. in 2010, the use by ASFQ of the LWOB mark was sufficiently well known to negate the distinctiveness which LWOB Inc may assert flowing from usage of that mark. The jurisprudence is clear that the determination of distinctiveness is a question of fact.

[76] In my view the evidence submitted by ASFQ is overwhelming and clearly establishes that its use of the LWOB mark across Canada points to its association to ASFQ and not to LWOB Inc whose evidence of use of the mark in Canada is extremely poor. In short, the reputation ASFQ acquired in the LWOB mark through usage was significant and substantive.

[77] Fifth, I am persuaded, based on the evidence before me, LWOB Inc was not the person entitled to register the LWOB mark for the reason that it was not the first person to use or make known the LWOB mark in Canada. Again, this evidence is clear from the affidavit of Pascal

Paradis that the trade-mark Avocats Sans Frontières was first used by ASFQ in 2002, whereas because of the contradictions in the evidence submitted by LWOB Inc on this point does not establish first use by it of the registered mark.

[78] Sixth, the issue of confusion from the point of view of the average bilingual person arose during argument. Avocats Sans Frontières is an exact translation of Lawyers Without Borders. In view of the previous findings made by this Court I need not decide the question.

[79] For all of these reasons, the applicant's application is granted. The registration of the LWOB mark is invalid and must be struck from the Registry. At the request of the parties not costs are awarded.

“François Lemieux”

Judge

Ottawa, Ontario
January 14, 2013

FEDERAL COURT
SOLICITORS OF RECORD

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DATED: January 14, 2013

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