

Date: 20060901

Docket: A-289-06

Citation: 2006 FCA 291

Present: SHARLOW J.A.

BETWEEN:

**BOJANGLES' INTERNATIONAL, LLC
and BOJANGLES' RESTAURANTS, INC.**

Appellants

and

BOJANGLES CAFÉ LTD.

Respondent

Dealt with in writing without appearance of parties.

Order delivered at Ottawa, Ontario, on September 1, 2006.

REASONS FOR ORDER BY:

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REASONS FOR ORDER

SHARLOW J.A.

[1] In 1998, the respondent (Bojangles Café) filed an application to register the trade-mark BOJANGLES CAFÉ based on its use and proposed use in Canada for wares and services relating to the operation of a restaurant. The appellants (collectively, Bojangles U.S.) operate a chain of restaurants in the United States under the trade name “Bojangles”. They opposed the application. Their opposition was rejected by the Trade Marks Opposition Board on June 9, 2004 (40 C.P.R. (4th) 553). Bojangles U.S. appealed to the Federal Court under subsection 56(1) of the *Trade-Marks Act*, R.S.C. 1985, c. T-13. That appeal was dismissed on May 31, 2006 (2006 FC 657). Bojangles U.S. has appealed that judgment to this Court.

[2] The parties have been unable to agree on the contents of the appeal book. Bojangles U.S. has filed a notice of motion under Rule 343(3) of the *Federal Courts Rules*, SOR/98-106, to have the contents determined by the Court. The issue in the motion is whether certain documents that were before the Federal Court judge should be excluded from the appeal book because, in the words of Rule 343(2), they are not “required to dispose of the issues on appeal”.

[3] Bojangles U.S. says, and I agree, that the words of Rule 343(2) quoted above indicate that an evidentiary document, such as an affidavit, is not necessarily required to be included in the appeal book simply because it was before the Judge. An evidentiary document should be included in the appeal book only if there is a reasonable basis for concluding that it is required to dispose of an issue on appeal.

[4] Parties rarely disagree on whether an evidentiary document is required to dispose of an issue on appeal. When there is such a disagreement, the result is a motion such as the present one, which places the motions judge in the difficult position of trying to appreciate the potential relevance of a document, with only a cursory knowledge of the case and the arguments on appeal (see *Canada (Information Commissioner) v. Canada (Minister of the Environment)*, 2001 FCA 221, per Létourneau J.A., at paragraph 4). The practicalities are such that in a close case, a motions judge generally will choose to include, rather than exclude.

[5] In most cases, the appeal book includes all of the evidentiary documents. That is appropriate if the issues on appeal are such that any of the documents might be required to dispose of an issue on appeal. I suspect, however, that in some cases the parties agree to include all evidentiary documents in the appeal book only because, at that early stage, they prefer not to risk excluding

something to which they might later wish to refer. That is a practical approach as long as it does not result in voluminous appeal books in which the connection between the documents and the issues on appeal is relatively remote. However, in a case with a lengthy evidentiary record, it is not good appellate practice to insist invariably on including all evidentiary documents in the appeal book. Rather, counsel should make a reasonable effort to determine, for each evidentiary document, whether the test in Rule 343(2) is met.

[6] The test in Rule 343(2) is a flexible one. For example, it may be appropriate to exclude from the appeal book a document that was presented in the court below to prove a particular fact that will not be in dispute on appeal; on the other hand, that document ought to be included if it is reasonable to suppose the appellate court may require it to gain a full appreciation of the facts. Similarly, it may be appropriate to exclude a document adduced by a party who does not intend to rely on it to support any of its arguments on appeal; on the other hand, it ought to be included if the opposing party has a reasonable basis for believing that it may wish to rely on that document to support one of its arguments on appeal. Generally, an evidentiary document should be excluded if its only foreseeable use is to enable one party to emphasize a general weakness in the evidentiary foundation presented by the other party in the court below.

[7] With these considerations in mind, I will examine the dispute about the evidentiary documents in this case, considering first the nature of the case, then the grounds of appeal, then the documents themselves.

[8] The only ground of opposition asserted by Bojangles U.S. in the Federal Court was distinctiveness, so that the main issue in the Federal Court was whether there was any basis for

reversing the decision of the Board that, at the relevant date (which was agreed to be July 4, 2000), the trade-mark that Bojangles Café wished to register was “distinctive”, as defined in section 2 of the *Trade-Mark Act*. The Judge considered the matter of standard of review, and determined that the appropriate standard of review of the decision of the Trade-Mark Opposition Board is reasonableness. He then considered whether the Board met that standard in its determination and application of the legal test in paragraph 38(2)(d) of the *Trade-Mark Act*.

[9] After analyzing the jurisprudence, the Judge concluded that the Board had erred in its statement of the legal test, with the result that the Judge was required to consider the issue anew. He engaged in a detailed review of all of the affidavit evidence that was before the Board, as well as the additional affidavits filed in the Federal Court. I infer that the Judge considered all of the evidence, including the affidavits to which he did not refer in his reasons, and those to which he gave little or no weight. In the result, the Judge agreed with Board that the trade-mark sought to be registered by Bojangles Café was distinctive at the relevant time, and dismissed the appeal.

[10] The notice of appeal alleges that the Judge erred in law by requiring Bojangles U.S. to establish that its trade name “Bojangles” was known in Canada to a “substantial” or “significant” extent, when the test should have been whether it was known in Canada “at least to some extent”. The notice of appeal also alleges that the Judge erred in law by not deferring to the findings of fact of the Board to the effect that the “Bojangles” trade name was known “to some extent” in Canada.

The Survey Evidence

[11] Bojangles U.S. wishes to exclude from the appeal book the affidavit of Gillian Humphreys (a survey expert) that they filed in the Federal Court, an affidavit of Ruth Corbin (a survey expert)

filed in the Federal Court by Bojangles Café for the sole purpose of criticizing the evidence of Gillian Humphreys, and the transcripts of the cross-examinations of both survey experts.

[12] The Judge gave the affidavit of Gillian Humphreys “little weight” because it did not contain information in relation to the relevant time period, the questions were flawed, they were drafted by counsel rather than by the expert, there was no control condition. He said that even if that affidavit were treated as capable of establishing the degree of awareness in Canada of the “Bojangles” trade name of Bojangles U.S., it would establish, at best, that a positive response was given by 6 to 26 out of 1019 respondents, and that less than 1% of respondents said that their recollection goes back to the relevant time period.

[13] Counsel for Bojangles U.S. has said that he is “prepared to waive reliance on the affidavit of Gillian Humphreys”. I understand that to be an undertaking that the appeal will be conducted on the basis that Bojangles adduced no credible survey evidence relating to the degree to which the “Bojangles” trade name of Bojangles U.S. was known in Canada at the relevant time.

[14] Counsel for Bojangles Café has provided no basis upon which I could conclude that he may wish to refer specifically to any of the survey evidence. From that I infer that there is nothing in any of that evidence that is likely to advance the position of Bojangles Café. Bojangles Café objects to the exclusion of the survey evidence from the appeal book on the basis that the appellate court is entitled to be aware that Bojangles U.S. presented a large body of evidence, much of which was found to be weak and deeply flawed.

[15] There is some force in the argument of Bojangles Café, but it seems to me that if the appeal is conducted on the basis that Bojangles U.S. presented no credible survey evidence, Bojangles Café will be able to make submissions about the overall weakness of the case for Bojangles U.S., without necessarily having to point to the actual evidence that turned out to be unpersuasive. I would exclude from the appeal book the affidavit of Gillian Humphreys, the responding affidavit of Ruth Corbin, and the transcripts of the related cross-examinations.

The updated Newman affidavit

[16] Bojangles U.S. presented in the Federal Court an affidavit of Eric Newman, for the sole purpose of “updating” financial information about Bojangles U.S. in an earlier affidavit by Mr. Newman that had been presented to the Board. The Judge found that affidavit to be irrelevant because it did not relate to a relevant period of time. I see no justification for including that affidavit in the appeal book. It should be excluded.

Affidavits of members or employees of Smart & Biggar

[17] In the Federal Court, Bojangles U.S. presented nineteen affidavits of “fact witness”. Six of those witnesses were lawyers or employees of Smart & Biggar, the law firm that was then representing Bojangles U.S. (J. Auerbach, L. Blais, F. Boltezar, T. Briggs, B. Padget, E. Simcoe). Of those six witnesses, Bojangles Café cross-examined only J. Auerbach. A motion was made by Bojangles Café to have those affidavits struck. That motion was denied but Bojangles U.S. was required to retain new counsel (2005 FC 272). Bojangles U.S. retained new counsel; that same counsel is now acting for them in this appeal.

[18] Bojangles U.S. wishes these six affidavits, as well as the transcript of the cross-examination of J. Auerbach, to be excluded from the appeal book. Bojangles U.S. also wishes to exclude the reasons cited above (2005 FC 272) and the related order, on the basis that they are not relevant to any issue on appeal. Counsel for Bojangles U.S. has said that he is prepared to waive reliance on these six affidavits. Again, I understand that to be an undertaking that the appeal will be conducted on the basis that Bojangles adduced no evidence from those witnesses.

[19] Counsel for Bojangles Café does not point to anything in any of these affidavits, the transcript of the cross-examination, the reasons or the order that would be relevant to the appeal, except in the general sense that the initial impropriety of adducing these affidavits puts Bojangles U.S. in a generally bad light and, again, comprises part of a very large body of evidence presented by Bojangles U.S. that was ultimately found to be weak. It seems to me that because the appeal will be conducted on the basis that there was no relevant evidence from any of these six witnesses, and their affidavits contain nothing that will advance the case of Bojangles Café, it cannot be said that their affidavits are required to dispose of any issue on appeal. The same can be said of the transcript of the cross-examination of J. Auerbach, the reasons cited as 2005 FC 272, and the related order. I would exclude them all from the appeal book.

Affidavits of members or employees of Osler, Hoskins and Harcourt and KPMG LLP

[20] Bojangles U.S. also presented in the Federal Court thirteen affidavits were from employees or lawyers with the law firm Osler, Hoskins and Harcourt, or the accounting firm KPMG LLP. Of those witnesses, Bojangles Café cross-examined J. Dolman from Oslers, and M. Avarello from KPMG.

[21] Bojangles U.S. says that of those thirteen affidavits, the affidavits of R. Beaumont, K. Cabana, J. Dolman, C. Murray, D. Seymour, A. Whyte contain only evidence of knowledge relating to a period of time that is not relevant to the issues on appeal. For that reason, Bojangles U.S. wishes to have the affidavits of R. Beaumont, K. Cabana, J. Dolman, C. Murray, D. Seymour, A. Whyte, and the transcript of the cross-examination of J. Dolman, excluded from the appeal book.

[22] Counsel for Bojangles U.S. has said that he is prepared to waive reliance on these six affidavits, meaning that the appeal will be conducted on the basis that Bojangles adduced no evidence from those witnesses.

[23] Bojangles Café objects to the exclusion of these affidavits, substantially for the same reason as it objects to the other exclusions. However, there is an additional point in relation to the affidavit and cross-examination of J. Dolman. That point is that the cross-examination apparently revealed the existence of certain e-mails, which are among the documents that Bojangles U.S. wishes to have included in the appeal book.

[24] I find it impossible to determine, at this point, whether and how that connection to the e-mails relates to any of the issues on appeal. Given that uncertainty, I would include the affidavit of J. Dolman and the transcript of her cross-examination in the appeal book. However, I would exclude the affidavits of R. Beaumont, K. Cabana, C. Murray, D. Seymour and A. Whyte.

[25] Bojangles Café also submits that Bojangles U.S. presented the affidavit of a person named “Boyes”, whose knowledge also relates to an irrelevant period of time, and yet Bojangles U.S. has not sought to exclude that affidavit. This is said to indicate an inconsistent approach by Bojangles

U.S. I cannot determine whether the approach of Bojangles U.S. is inconsistent, or whether Bojangles Café is correct in its characterization of the facts stated in the Boyes affidavit. In any event, I see nothing in the comments about the Boyes affidavit that advances the debate about whether the other affidavits referred to above should be included in the appeal book.

The emails

[26] There are a number of emails that apparently relate to enquiries sent by the former counsel of Bojangles U.S. to various people to solicit information as to their knowledge of the trade name Bojangles. Bojangles U.S. agrees that most of those emails should be included in the appeal book, but argues that one particular email should be excluded because the only persons who responded to it were those whose affidavits are not being relied upon. As I cannot tell whether those persons include J. Dolman, I would include that email in the appeal book.

Federal Court Orders

[27] Bojangles U.S. says that there are four Federal Court orders that related to the conduct of the proceedings that should be excluded from the appeal book. I assume that one of those is the order referred to above, relating to the affidavits of members or employees of Smart & Biggar.

[28] The material filed by Bojangles U.S. does not state what other orders are referred to but it appears from the material filed by Bojangles Café that the other three orders are the orders dated December 10, 2004, March 30, 2005 and April 6, 2005.

[29] As I have no idea what those orders deal with, I have no basis for concluding that they should be excluded from the appeal book.

Evidence before the Board

[30] Bojangles U.S. argues that the only material that was before the Board that is relevant to the appeal is the material that addresses the question of distinctiveness. Bojangles U.S. says that the relevant evidence consists of the affidavits of J. Cavanaugh, V. Chestnut, T. Dekine, B. Lukie, D. Maisel, E. Newman (2001), M. Oshefsky, T. Rumsey, M. Snide and W. Whray.

[31] Bojangles U.S. wishes to exclude the affidavits of C. Cordova, B. Green, F. Hurd, J. Megison, M. Moran, G. Rawls, K. Rosenthal, M. Sandefer, D. Scopinich, and D. Carkeek, which were filed with Board and were part of the record of the Federal Court, on the basis that they deal with other issues or were not relied upon by the Board. Bojangles Café disagrees, and argues that these affidavits must be taken as going to the issue of distinctiveness, as they were cited by Bojangles U.S. in argument in the Federal Court, where distinctiveness was the only issue.

[32] None of these affidavits are before me. There is substantial disagreement as to their actual contents, and I have no basis for resolving that disagreement. For that reason, I would require all affidavits that were filed with the Board and were part of the record of the Federal Court to be included in the appeal book.

Letters to the Federal Court following the Court's direction of April 28, 2006

[33] Bojangles Café submits that two letters from counsel, submitted in response to the Court's direction of April 28, 2006, should be included in the appeal book.

[34] Bojangles U.S. has made no submissions on that point. I will require those letters to be included in the appeal book.

Memoranda of Fact and Law submitted in the Federal Court

[35] Bojangles Café submits that the memorandum of fact and law of Bojangles U.S. dated April 28, 2005, and its own memorandum of fact and law dated June 29, 2005 filed in the Federal Court, should be included in the appeal book, because they confirm that distinctiveness was the only issue before the Federal Court, and because it contains some statements about the relevant date for determining distinctiveness. I am unable to see how any of those statements would be of assistance to this Court in determining the appeal. There would appear to be no dispute on either of those points. These memoranda should be excluded.

Conclusion

[36] An order will be made to require the appeal book to include all of the documents set out in the draft order in Tab 3 of Volume 2 of the Motion Record of Bojangles Café (pages 299-303), except the documents specified in these reasons as documents that are to be excluded. Costs of this motion are costs in the cause.

“K. Sharlow”

J.A.

FEDERAL COURT OF APPEAL

NAMES OF COUNSEL AND SOLICITORS OF RECORD

DOCKET: A-289-06

STYLE OF CAUSE: BOJANGLES' INTERNATIONAL,
LLC and BOJANGLES'
RESTAURANTS, INC. v.
BOJANGLES' CAFÉ LTD.

MOTION DEALT WITH IN WRITING WITHOUT APPEARANCE OF PARTIES

REASONS FOR ORDER BY: SHARLOW J.A.

DATED: SEPTEMBER 1, 2006

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