



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 84

Date of Decision: 2020-08-05

[UNREVISED ENGLISH CERTIFIED TRANSLATION]

IN THE MATTER OF AN OPPOSITION

Lawyers Without Borders, Inc.

Opponent

and

Avocats sans frontières Québec

Applicant

**1,398,785 for LAWYERS WITHOUT
BORDERS**

Application

I. INTRODUCTION

[1] Lawyers Without Borders, Inc. (LWOB) is an American non-profit corporation. It opposes registration of the trademark LAWYERS WITHOUT BORDERS (the Mark) covered by application No. 1,398,785 in the name of *Avocats sans frontières Québec* (ASFQ), a Canadian non-profit corporation that is a member of the *Avocats sans frontières* international movement, based on the use of the Mark in Canada in association with the following goods and services:

[TRANSLATION]

Goods

(1) Publications, namely newsletters related to the empowerment of legal advocates, the fight against impunity and the promotion and defense of human rights, of access to justice, of democratic governance principles and of the rule of law.

Services

(1) Operation of a business for the empowerment of legal advocates, the fight against impunity and the promotion and defense of human rights, of access to justice, of democratic governance principles and of the rule of law; organization of humanitarian missions aiming at the empowerment of legal advocates, the fight against impunity and the promotion and defense of human rights, of access to justice, of democratic governance principles and of the rule of law; fundraising services for the organisation of missions and activities concerning the empowerment of legal advocates, the fight against impunity and the promotion and defense of human rights, of access to justice, of democratic governance principles and of the rule of law.

(2) Organization of conferences and information sessions on the empowerment of legal advocates, the fight against impunity and the defense and promotion of human rights, of access to justice, of democratic governance principles and of the rule of law.

Claims

- Used in Canada since at least as early as November 2006 in association with the goods.
- Used in Canada since at least as early as November 2002 in association with the services (1).
- Used in Canada since at least as early as June 2003 in association with the services (2).

[2] LWOB opposes the application, essentially arguing the likelihood of confusion between the Mark and an identical trademark of LWOB, which it alleges it had previously used, and continues to use, in Canada in association with essentially the same type of goods and services. As I have previously defined the trademark LAWYERS WITHOUT BORDERS as the Mark, that definition shall also apply to the trademark LWOB in my decision.

[3] As will become apparent in my analysis, I find that the application ought to be refused.

II. THE RECORD

[4] The application for the Mark was filed by ASFQ on June 10, 2008 and advertised for opposition purposes in the *Trademarks Journal* on June 26, 2013.

[5] The statement of opposition by LWOB was initially filed on November 26, 2013, and was then amended by it on January 6, 2014, in response to objections raised by the Registrar in an official letter dated December 6, 2013, concerning the insufficient grounds of opposition

pleaded by LWOB, concerning the non-distinctiveness of the Mark under section 2 of the *Trademarks Act*, R.S.C. 1985, c. T-13 (the Act); the non-entitlement under section 16(1)(a) of the Act, and the non-compliance of the application under section 30(a) of the Act.

[6] ASFQ filed a counterstatement on March 27, 2014, denying each of the grounds of opposition pleaded by LWOB and citing a Federal Court decision of January 14, 2013, in a case involving the same parties that resulted in the invalidation and expungement of registration No. TMA631,359 in the name of LWOB, in respect of the Mark in association with legal services, namely *Avocats sans frontières Québec v Lawyers Without Borders, Inc.*, 2013 FC 27 (the Invalidating Judgment) (appeal to the Federal Court of Appeal (file A-566-12) discontinued on March 7, 2013). I will return to that decision later.

[7] In support of its opposition, LWOB filed:

- An affidavit from Christina Storm, sworn in the United States on October 24, 2014 (the Storm affidavit). Ms. Storm is the Executive Director and Founder of LWOB. The purpose of her affidavit is to show LWOB's use of the Mark in Canada, and includes the history, nature, and scope of LWOB's activities in Canada. Ms. Storm was cross-examined on her affidavit, and the transcript of her cross-examination and the answers to the undertakings made during it are on the record. I note that, in her cross-examination, Ms. Storm made slight corrections to certain parts of her affidavit [see transcript, pp 4, 5, 7 and 83 regarding paragraphs 1, 27 and 37, and the removal of the subtitle "*Avocats sans Frontière [sic] Québec*" from her affidavit].
- An affidavit from Matthew Taylor, also sworn on October 24, 2014 (the Taylor affidavit). Mr. Taylor is a lawyer with the Department of Justice, Criminal Law Policy Section. The purpose of his affidavit is to recount his past experience as a coordinator, particularly of the Pro Bono Students Canada (PBSC) program, when he was a law student at the University of Ottawa in 2001 and 2002, and his interactions in that role with LWOB.
- An affidavit from Marion Williams of St-Augustine, Trinidad, in the Caribbean, sworn on November 4, 2014 (the Williams affidavit). Ms. Williams is the Director of Williams Law, with a post office box in Toronto. The purpose of her affidavit is to

recount her past experience as a representative of LWOB in Canada. Ms. Williams was cross-examined on her affidavit and the transcript of her cross-examination is on the record. I note that, in her cross-examination, Ms. Williams made slight corrections to certain parts of her affidavit [see transcript, pp 4 and 5 regarding paragraphs 1, 5 and 8 of her affidavit].

[8] In support of its application, ASFQ filed:

- An affidavit from Pascal Paradis, sworn on March 3, 2016 (the Paradis affidavit). Mr. Paradis is Director General of ASFQ. The purpose of his affidavit is to show ASFQ's use of the Mark in Canada, and includes the history, nature and scope of ASFQ's activities. Mr. Paradis was cross-examined on his affidavit, and the transcript of his cross-examination and the answers to the undertakings made during it are on the record. I note that, in his cross-examination, Mr. Paradis made a correction to paragraph 38 of his affidavit [see transcript, pp 1–2].
- An affidavit from Simon V. Potter, a lawyer and former president of the Canadian Bar Association (CBA) in 2002/03, sworn on March 1, 2016 (the Potter affidavit). The purpose of his affidavit is to support ASFQ's claims regarding the association of the Mark with ASFQ, and the lack of any knowledge of any use of a similar trademark by LWOB in Canada.
- An affidavit from Fred Headon, a lawyer and former president of the CBA in 2013/14, sworn on March 3, 2016 (the Headon affidavit). The purpose of his affidavit is to support ASFQ's claims regarding the association of the Mark with ASFQ, and the lack of any knowledge of any use of a similar trademark by LWOB in Canada.
- A certified copy of registration No. TMA954,925 for the mark AVOCATS SANS FRONTIÈRES, in the name of ASFQ.

[9] Each of the parties filed written arguments and was represented at a hearing. At that hearing, LWOB voluntarily removed one of its grounds of opposition, namely the one based on the non-compliance of the application under section 30(a) of the Act, leaving as the sole grounds

of opposition the one based on non-entitlement under section 16(1)(a) of the Act and the one based on non-distinctiveness under section 2 of the Act, both of which focus on the issue of the likelihood of confusion between the Mark and the same trademark of LWOB, which it alleges that it has previously used, and continues to use, in Canada in association with goods and services similar to those listed in this application.

[10] Numerous amendments to the Act came into force on June 17, 2019. The date for identifying which version of the Act applies to opposition proceedings is the date on which the application being opposed was advertised. As this application was advertised prior to June 17, 2019, pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read on June 16, 2019, with the exception of confusion, for which subsections 6(2) to (4) of the Act as they currently read will be applied.

III. ANALYSIS

III.1 Preliminary remarks – Previous litigation between the parties

[11] As noted above, the parties to these proceedings were involved in a prior litigation that ultimately led to the invalidation and expungement of registration No. TMA631,359, in the name of LWOB, in respect of the Mark in association with services described as “legal services”.

[12] The context of that previous litigation should be briefly explained.

[13] The Invalidating Judgment is the result of proceedings that were initiated by ASFQ on January 16, 2010, pursuant to section 57 of the Act, to obtain the invalidation and expungement of a similar registration that had been cited against it by the Registrar in the course of a review of certain trademark applications filed by ASFQ, including this application [para 9, Paradis affidavit]. ASFQ based its application for invalidation and expungement on the claim that registration No. TMA631,359, based on both LWOB’s use of the Mark in Canada since at least as early as July 2001, and the use and registration of a similar mark in the United States by LWOB, was invalid under section 18 of the Act for four reasons, which are set out as follows by the Court at paragraph 4 of its decision:

- a) On the date of its registration, January 27, 2005, LWOB Inc had not used the trade-mark [LAWYERS WITHOUT BORDERS] in the manner set out in its application for registration. This allegation by the Applicant [ASFQ] raises the question whether LWOB Inc used, in Canada, the mark [LAWYERS WITHOUT BORDERS] in association with legal services;
- b) As of January 26, 2010, the date this expungement application was launched in this Court, the [LAWYERS WITHOUT BORDERS] 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 [LAWYERS WITHOUT BORDERS] has been abandoned by the LWOB Inc; and
- d) At the time LWOB Inc made its application for registration on October 25 [sic], 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 [LAWYERS WITHOUT BORDERS] trade-mark.

[Emphasis in the original. It should also be noted that the date on which the LWOB application was filed is October 15, 2003 (as correctly stated in paragraph 1 of the decision), not October 25, 2003.]

[14] In that case, the Court held at paragraphs 5 to 7 that:

[...] ASFQ has proven that the registration of the [LAWYERS WITHOUT BORDERS] 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.

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

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

[15] However, this invalidation and expungement proceeding was initiated by ASFQ at relatively the same time as another summary expungement proceeding initiated by the Registrar under section 45 of the Act, at the request of ASFQ’s former trademark agents and specifically related to the same registration, leading to the decision in *McCarthy Tétrault v Lawyers Without Borders Inc*, 2010 TMOB 169 (Opinion Decision 45), subsequently appealed by ASFQ to the Federal Court (File T-2103-10).

[16] In particular, in Opinion Decision 45, the Registrar had refused to expunge registration No. TMA631,359 for non-use, being of the view that LWOB had demonstrated use of the Mark in Canada during the relevant period covered in that proceeding, i.e. between June 30, 2005 and June 30, 2008 (date of the Registrar's notice), in association with the services described in the registration as "legal services".

[17] Not surprisingly, reference was made to Opinion Decision 45 in the Invalidating Judgment. As that case ultimately led to the invalidation and expungement of contested registration No. TMA631,359, the appeal of Opinion Decision 45 was discontinued on June 3, 2013.

[18] Although I understand the reasons that ASFQ is citing the Invalidating Judgment in this case, it should be highlighted that this type of decision is not necessarily determinative in this case. Suffice it to say that each case rests on its own merits. That being said, I will refer to the Invalidating Judgment when I find it is appropriate to do so.

III.2 The burden incumbent on the parties

[19] It is initially up to LWOB to establish that its opposition is well-founded. LWOB must ensure that each of its grounds of opposition is properly pleaded and meet the initial evidentiary burden by establishing the facts on which it bases each one. Once that initial evidentiary burden has been met, it is up to ASFQ to establish, on a balance of probabilities, that no grounds of opposition prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al.* (2002), 20 CPR (4th) 155 (FCA)].

III.3 Ground of opposition based on non-entitlement of the Mark under section 16(1)(a) of the Act

[20] It would be appropriate here to cite the ground of opposition as pleaded by LWOB in its entirety:

The Applicant is not the person entitled to registration of the [Mark] in Canada pursuant to section 16(1)(a) of the Act, as the [Mark] is confusing with the Opponent's mark

LAWYERS WITHOUT BORDERS (“Opponent’s Mark”), which had been previously used in Canada by the Opponent. The Opponent’s Mark has previous use in Canada in association with various wares and services, including: legal services, recruitment materials, promotional materials, fundraising materials, private and public newsletters, educational materials, greeting cards, calendars, books and websites. Through this prior use, the Opponent’s Mark has acquired a substantial degree of distinctiveness in Canada.
[Emphasis added]

[21] Contrary to what LWOB states at paragraph 6 of its written arguments, this ground of opposition does not allege that the Mark was previously used and made known in Canada by LWOB, but only previously used. That said, the goods and services in association with which LWOB alleges to have previously used the Mark in Canada are not limited to just the goods and services expressly listed in its ground of opposition, given the word “including” before the list. As ASFQ has not requested an interlocutory ruling to have this ground of opposition clarified or limited to just the goods and services expressly listed, this ground of opposition must be assessed based on the evidence on record [*Novopharm Ltd v AstraZeneca AB* (2002), 2002 FCA 387, 21 CPR (4th) 289]. Keeping in mind the Invalidating Judgment, I agree with LWOB that this is an important distinction, in that this ground of opposition is therefore not limited to an allegation of prior use of the Mark by LWOB in association with legal services only.

[22] To meet its initial evidentiary burden on this ground, LWOB must demonstrate that, at the dates of first use of the Mark alleged by ASFQ in this application, the Mark had previously been used in Canada by LWOB, and that it had not been abandoned by LWOB at the date of advertisement of the ASFQ application on June 26, 2013 [section 16(5) of the Act].

III.3.1 Applicable legal concepts

[23] The relevant definitions of “use” in association with goods and services are set out in section 4 of the Act:

A trademark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

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

[24] As noted by the Federal Court in *Hilton Worldwide Holding LLP v Miller Thomson*, 2018 FC 895 (on appeal to the Federal Court of Appeal (file A-325-18)) at paragraph 35: “Although s. 4(2) of the Act deems advertising of services to be use, it is clear that the mere advertisement of services in Canada, where no aspect of the services themselves are performed or delivered in Canada, does not constitute use within the meaning of the Act [...]” In this regard, reviewing recent jurisprudence on this issue, particularly at paragraphs 41 to 56, the Court states that: “Enabling Canadians to benefit directly from the service in Canada can constitute ‘use’ in Canada.”

[25] Moreover, as noted by the Registrar in *Olive Me Inc, et al v. 1887150 Ontario Inc*, 2020 TMOB 26, at paragraphs 13 to 15, section 16 of the Act does not require that an opponent prove a certain level of use or reputation. If the opponent demonstrates that its use meets the requirements of section 4 of the Act, that such use occurred during the relevant period, and that its trademark was not abandoned at the date of advertisement of the applicant’s application, the opponent will have met its burden of demonstrating prior use for the purposes of an opposition under section 16(1)(a) of the Act, even if that proof is limited to a single sale or single event, to the extent that same is in the normal course of trade [*7666705 Canada Inc v 9301-7671 Québec Inc*, 2015 TMOB 150].

[26] That being said, the assessment of use must be based on its particular facts. In this regard, section 16 of the Act does not require an opponent to necessarily demonstrate continued use of the alleged trademark in support of a ground of opposition under section 16(1)(a) of the Act. Indeed, as noted by the Federal Court of Appeal in *Iwasaki Electric Co Ltd v Hortilux Schreder B.V.*, 2012 FCA 321, at paragraph 21:

Subsection 16(5) of the Act is not based on a person ceasing to use (as defined in the Act) a trade-mark but rather on a person abandoning a particular trade-mark. As noted above, abandonment of a trade-mark is not determined based solely on a person ceasing to use that trade-mark. The person must also have intended to abandon the trade-mark. I would agree that in determining whether a person has an intention to abandon a trade-mark, an inference of such intention could, in the absence of any other evidence, be drawn as a result of a failure to use the trade-mark for a long period of time.

[27] This leads me to review the evidence filed by LWOB in this case, as well as that of ASFQ, to determine the extent to which LWOB actually met its initial evidentiary burden.

III.3.2 Review of the evidence filed by LWOB

[28] As noted above, this evidence consists of three affidavits, two of which were cross-examined.

[29] The main affidavit is the Storm affidavit, with 74 paragraphs and exhibits “A” to “Z” and “AA” to “SS”. In addition, this lengthy affidavit must be read in light of the transcript of Ms. Storm’s cross-examination on this affidavit, which has some 275 pages and also includes rather lengthy exhibits and responses to undertakings. It should be noted at this stage of my decision that there were three exhibits filed during that cross-examination, consisting of the following documents:

- Exhibit “CS-A”: A copy of Ms. Storm’s affidavit, sworn on August 13, 2010, which was submitted as the only evidence on behalf of LWOB in the record for the Invalidating Judgement. That affidavit had 49 paragraphs and included exhibits “A” to “Y”. I note here that the Storm affidavit in this case is based in part on that earlier affidavit. However, this affidavit is substantially longer and includes more than double the number of attachments.
- Exhibit “CS-B”: A copy of Ms. Storm’s affidavit, sworn on December 30, 2008, which was submitted as the only evidence on behalf of LWOB in the record for Opinion Decision 45. That relatively short affidavit had nine paragraphs and included exhibits “A” to “C”.
- Exhibit “CS-C”: A copy of the affidavit from Catherine McKenna, Founder and Executive Director of the not-for-profit corporation *Canadian Lawyers Abroad* (CLA), sworn in December 2010, which was submitted as evidence on behalf of ASFQ (which evidence also included three other affidavits) in the record for the Invalidating Judgment. That affidavit had eight paragraphs.

[30] The purpose of the Taylor and Williams affidavits is to corroborate or expand upon assertions by Ms. Storm or some of the evidence filed by her regarding the use of the Mark by

LWOB. As well, rather than reviewing and discussing each of these affidavits in order, I will attempt here to summarize the portions of the Storm affidavit that I find are most relevant to my analysis, and how the Taylor and Williams affidavits complement or corroborate the Storm affidavit.

[31] That being said, I find that this summary nonetheless requires a high level of detail to allow me to distinguish between some of the facts and findings specific to the Invalidating Judgment and the circumstances of this case, and given ASFQ's position that LWOB did not meet its initial evidentiary burden with respect to this ground of opposition.

[32] Ms. Storm founded LWOB in Hartford, Connecticut on January 30, 2000, which was subsequently incorporated in that US state on March 1, 2000. Ms. Storm has been the Executive Director and President of LWOB since that time and has been on the LWOB payroll since 2006. At the date of Ms. Storm's cross-examination, LWOB had a total of nine employees at its US offices in Connecticut and Washington D.C., 10–15 full-time volunteers/interns and one part-time volunteer, and used the services of an external consultant [Storm affidavit, para 1; Storm transcript, pp. 6–20].

[33] In addition to its offices in the United States, LWOB has offices in the United Kingdom and Kenya [Storm transcript, pp. 10–14]. However, LWOB has no physical offices or establishment in Canada, and there has never been a Canadian chapter of the LWOB, despite some unsuccessful exploratory discussions in this regard [Storm transcript, pp 14–135; Williams transcript, pp. 27–29].

[34] Unlike ASFQ, LWOB is not linked to the *Avocats sans frontières* international movement. LWOB based the creation of its group on the names of groups such as *Doctors Without Borders* and *Action Without Borders* [Storm transcript, pp. 24–25].

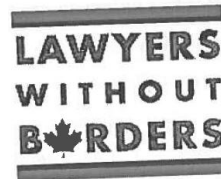
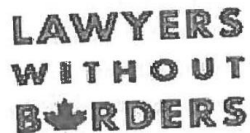
[35] According to Ms. Storm:

3. Since 2001, LWOB has offered lawyers, judges, and students in Canada an opportunity to learn about legal pro bono work, both in Canada, and abroad. LWOB provides education in Canada on how lawyers can transfer their skills to other jurisdictions. LWOB also does this work in the US and the UK.

4. LWOB has made continuing efforts to connect with the Canadian legal community. As a result of these efforts, LWOB has established a reputation in Canada for:

- a) Organizing, facilitating, and providing legal education;
- b) Promoting and raising awareness for rule of law issues (including domestic and international law) in developing nations;
- c) Planning, managing, and mobilizing volunteers for participating in rule of law programs in developing nations;
- d) Coordinating and connecting lawyers from developed nations for mentorship programs for mentoring lawyers in developing nations;
- e) Initiating and coordinating legal research projects at Canadian Universities;
- f) Running a job board for employers and job seekers looking for opportunities in rule of law projects.

[36] According to Ms. Storm, since 2001, LWOB has used the Mark in Canada, in its nominal form, and also in various stylized forms, including secondary graphic elements [Storm affidavit, paras 5–9], as depicted below:



[37] I note at this stage of my decision that I find that the use of the Mark in any of these graphic forms also substitutes for the use of the nominal mark LAWYERS WITHOUT BORDERS, in accordance with the principles set out in *Registrar of Trade-marks v Compagnie Internationale pour l'informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA); and *Nightingale Interloc v Prodesign* (1984), 2 CPR (3d) 535 (TMOB). I further note that the fact that the Mark also corresponds to the trade name of LWOB does not prevent concurrent use of the Mark.

[38] According to Ms. Storm, registration No. TMA631,359, expunged by the Invalidation Judgment, covered only a relatively narrow subset of services offered by LWOB under the Mark. More specifically, Ms. Storm states at paragraph 11 of her affidavit that:

Since 2001, we have continuously and actively promoted LWOB, and its goals and visions, to the Canadian legal community, and we have done so using the [Mark]. Our objective was to:

- (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.

[39] According to Ms. Storm, and as noted by LWOB at the hearing held in this case, the first official research project initiated by LWOB in Canada was in 2001. That project was conducted in collaboration with the University of Ottawa and focused on the rule of law in Kosovo, leading to the development of the CLEAR model (Creating Legal Accessibility and Resources with Students), allegedly serving as the model for subsequent collaborations between LWOB and various Canadian student organizations, with Ms. Storm adding: “I believe that model developed by LWOB is a core activity of the Canadian NGO [CLA] formed by a former LWOB volunteer” [Storm affidavit, para 27 (corrected)].

[40] More specifically, Ms. Storm explained that LWOB conducted legal research on various topics related to the rule of law in cooperation with students and a law professor at that university. Ms. Storm stated that the Mark was on most, if not all, correspondence between LWOB and the University of Ottawa and its volunteers. In support of her affidavit, as Exhibit “C”, she filed an undated and unsigned report prepared by Matthew Taylor (the same individual who swore the Taylor affidavit in this case), as she remembered in about 2004, describing the work done at the university [Storm transcript, pp. 217–219]. As Exhibit “D”,

Ms. Storm also filed a copy of a letter dated July 11, 2001, that she claimed she had sent to Mr. Taylor for the purpose of distributing LWOB promotional material (in this case pens) to students at the University of Ottawa working on LWOB projects (“Enclosed please find the promotional pens from our organization. Please distribute them to the folks working on LWOB projects.”).

[41] As noted by ASFQ, the copy of the letter in Exhibit “D” bears no signature or header. However, it is clear from Ms. Storm’s cross-examination that this is because, at the time, Ms. Storm had not kept a signed copy of the letter printed on LWOB letterhead. Ms. Storm simply printed a copy of the text of the letter in question from the documents in LWOB’s computer records to show its content as part of this case [Storm Transcript, pp. 219–220]. Moreover, I note that the receipt and distribution of such promotional material is expressly corroborated by Mr. Taylor at paragraph 6 of his affidavit, which also confirms that “these promotional materials were branded with the name of the organization (‘Lawyers Without Borders’).”

[42] Returning to the report filed as Exhibit “C” in support of the Storm affidavit, I note that Mr. Taylor explains the relationship that had developed at the time between LWOB and PBSC at the University of Ottawa as follows:

This is a brief summary of the relationship that Pro Bono Students Canada at the University of Ottawa has formed with [LWOB] and how we have linked together to provide pro bono services on an international stage. This report is meant to outline the steps that were taken to establish this linkage and the important features necessary for such partnership to succeed. It should be noted at the outset that this was made all the more easier because of the fact that the two organizations, [LWOB] and [PBSC], each had as primary goals the provision of pro bono legal services. As such, both organizations were uniquely focused, both had the experience and the framework to work on such projects:

1. My first entry point with LWOB was their website. I simply sent an email letting them know about our organization and whether there would be opportunities for student involvement in rule of law projects.
2. After establishing formal ties with [LWOB] and determining there was in fact work to be done. The first thing done was an assessment of the resources available here in Ottawa in support of the project [...]
3. In terms of recruiting students, it was determined that six would be required for the project [...]

4. Not only is academic and administrative support and linkage required, project support from those frontline professionals working on the project is also to be encouraged. Having a lawyer familiar with the project and immediate needs is crucial. LWOB provided this link with one of its lawyers familiar and in regular contact with the client NGO [...] Through the use of email and the pro bono office as a central link to the University, this 1st linkage proved successful.

[...]

Since the first CLEARs project implemented in 2001, LWOB has experienced some of the pitfalls and benefits of such a program. A Manager whose task is to develop this project and a team to create a working model for it was assigned in early 2004. A Project intake form was created by LWOB with the insights suggested by Pro Bono Canada and a vehicle for that intake form to be processed at the LWOB website is in development and should be in a launch position before the end of February 2004.

[Emphasis added]

[43] I note that this report was apparently prepared by Mr. Taylor when he was no longer coordinator of the PBSC program (as explained below in my review of his affidavit). In this respect, one could question Mr. Taylor's personal knowledge of the facts related in the last paragraph of the report cited above, regarding the creation of an intake form by LWOB. That being said, I note that Ms. Storm's assertions regarding LWOB's relationship with PBSC and the University of Ottawa as part of the first project conducted in 2001 are also corroborated by the Taylor affidavit.

[44] More specifically, Mr. Taylor stated in his affidavit that, when he was a law student at the University of Ottawa, he was hired by the University to coordinate two programs, including PBSC. He held the position of coordinator from May 2001 to about May 2002, after which he took on new responsibilities in the Faculty of Law [Taylor affidavit, para 2].

[45] Mr. Taylor stated that, as coordinator, he assigned student volunteers from the University of Ottawa who were enrolled in the PBSC program to volunteer programs initiated by various organizations, including LWOB [Taylor affidavit, para 3].

[46] More specifically, Mr. Taylor states the following at paragraph 4 of his affidavit:

The [PBSC] program began working with LWOB in the summer of 2001. During the course of my tenure as Coordinator of the University's Program, students from the University worked on two of LWOB's projects. The first project involved students preparing a legal research memorandum examining possible legal remedies available to

respond to actions taken by special forces operating in Kosovo. The second project involved law students assisting in annotating Kosovo's Criminal Code. Faculty professors were also identified to assist the students working on these projects.

[47] Mr. Taylor also briefly described two events that occurred in the fall of 2001, in which the partnership developed between the University of Ottawa and LWOB was reportedly discussed. The first was at a roundtable meeting attended by Ms. Storm as LWOB's representative, held as part of the annual meeting of the International Lawyers Association in New York, in the United States, and attended by Mr. Taylor (and for which LWOB reimbursed some of the costs incurred by Mr. Taylor [see Storm affidavit, Exhibit "A", including a copy of a cheque made out to him on October 22, 2001, in the amount of \$200 and a copy of a cover letter from Ms. Storm to Mr. Taylor]). The second was an open house at the University of Ottawa to promote the PBSC program and the various projects offered to students, including those with LWOB. Mr. Taylor added that promotional material provided by various organizations, including LWOB, was handed out that day [Taylor affidavit, para 7]. However, no other information was provided regarding the material handed out on behalf of LWOB.

[48] Finally, Mr. Taylor stated that, as coordinator, he prepared several reports regarding the PBSC program at the University of Ottawa. To that end, he included with his affidavit, as exhibits "A", "B", and "C", copies of three reports on, among other things, projects with LWOB, dated June 22, 2001, August 23, 2001, and April 2, 2002, respectively. For example, the report in Exhibit "B" states that:

PBSC has secured a large number of new organisations and interesting projects for our students in Ottawa. Notably, organisations like [LWOB] [...] will provide quality placements for our participants [...]

Below is a list of organisations that have accepted student volunteers over the past summer: [...] LWOB [...]

MAJOR PROJECTS:

[...]

Partnering with [LWOB]. This has proven to be extremely beneficial for our office and is leading to a number of spinoffs for our office. LWOB is currently exploring the idea of creating a complimentary network of law students to assist in their ongoing work. PBSC will likely assist in that as we are already organized in a way to easily support LWOB initiatives. Publicity around this project has resulted in our information being found in news articles, web pages, and magazine features.

[Emphasis added]

And, in the one filed as Exhibit “C”:

MAJOR PROJECTS/DEVELOPMENTS

[LWOB]: Through our partnership with this organisation, our school has formed links with the Criminal Defense Resource Centre in Pristina, Kosovo. Over the past year, we have participated in two projects with the Centre [...] I would expect the incoming coordinator to ensure that communication is maintained on this project and that they ensure that our partnership with [LWOB] and the Criminal Defence Resource Centre are maintained.

[49] At the hearing in this case, ASFQ argued that the first research project involving PBSC at the University of Ottawa did not in itself show the performance of services by LWOB in Canada in association with the Mark, but instead that such services were performed by third parties in Canada, in this case PBSC (LWOB in fact being the beneficiary of services from PBSC). On the contrary, LWOB argued that such a project showed performance of services in Canada by LWOB in association with the Mark because LWOB had provided the “linkage” between PBSC and the Criminal Defense Resource Centre non-governmental organization (NGO) in Kosovo. Before discussing this issue more fully, I wish to continue my review of the evidence on record by attempting to identify specific events or facts (including some expressly noted by LWOB at the hearing), rather than reiterate the assertions, often vague and general, contained in the Storm and Williams affidavits.

[50] I thus note Exhibit “E” filed in support of Ms. Storm’s affidavit, in support of her claims regarding the relationship created by LWOB with various student organizations in Canada to demonstrate the use of the Mark by LWOB prior to the date of first use by ASFQ in association with the services (1) listed in this application. That exhibit, which LWOB specifically cited at the hearing in this case, is a copy of a letter dated July 16, 2002, from Ms. Storm to Pam Shime, PBSC National Director at the University of Toronto Faculty of Law, sending her the new LWOB recruitment brochures:

Enclosed please find our newly created recruitment brochures. We have a few projects in the pipeline, which may yield something for your group in the fall. I have been contacted by Patrice Thomas from the University of Toronto looking for projects for her group. My copies of my correspondence with Patrice are enclosed.

[51] Ms. Storm attached to her affidavit as Exhibit “F” a representative sample of the brochures in question [she confirmed on page 222 of her cross-examination: “It’s the only brochure we had until we did our first annual report many years later”].

[52] As noted by ASFQ at the hearing, the copy of the letter in Exhibit “E” has no signature, no header, and no attachment. However, it is clear here again from Ms. Storm’s cross-examination that this is apparently because, at the time, Ms. Storm had not kept a signed copy of the letter printed on LWOB letterhead. Ms. Storm simply printed a copy of the text of the letter in question from the documents in LWOB’s computer records to show its content as part of this case [Storm Transcript, p 221].

[53] In reviewing the sample brochure in Exhibit “F”, I note that it clearly displays the Mark and describes LWOB as follows:

LWOB links legal professionals with pro bono projects from Connecticut to Kosovo, the Midwest to the Middle East. To date, we have created an association with hundreds of lawyers from around the world, including the USA, Canada, Australia [...]

[...]

LWOB facilitates a global linkage between NGOs, non-profits and governmental organizations with pro bono partners in areas of human rights, business law, litigation and advocacy [...]

[...]

How it works: we do the linking. LWOB makes your skills available to NGOs and non-profits on a global basis, using not only USA-based lawyers but also those around the world [...]

[...]

Our website is your one-stop resource for internships and eleemosynary opportunities. We monitor and maintain lists of useful links showcasing intern, volunteer and lawyer positions. One visit to our homepage will familiarize you with the opportunities available for humanitarian work in your field and the global issues facing those dealing with conflict resolution and human rights.

[...]

Play an integral part of peace in the making, from your office or from abroad, short-term or long-term. You can use your legal skills for a worthwhile endeavor.

[...]

Want to get involved? Visit www.lawyerswithoutborders.org today!

[Emphasis added]

[54] However, I see nothing in the evidence about any project or concrete achievements with the University of Toronto after Ms. Storm's letter discussed above under Exhibit "E" was sent.

[55] In this regard, I note that Ms. Storm refers at paragraph 30 of her affidavit to students Raha and Rose Shahidsaless as having been [TRANSLATION] "representatives" of LWOB at that university from about 2004 to 2009 and having worked with "various teams of University of Toronto students on a variety of legal research projects." However, no other information or documentation was provided regarding those alleged projects [Storm transcript, pp. 45–49]. At most, Ms. Storm mentioned that one of the Shahidsaless sisters was apparently invited to introduce an Iranian lawyer named Shirin Ebadi, a human rights activist and former judge, at an event held in Canada in honour of Ms. Ebadi. Here again, no other information or documentation was provided regarding the event in question, except that it was apparently an informal presentation during a luncheon meeting, not necessarily associated with the University of Toronto [Storm transcript, pp. 43–46]. Moreover, it is clear from Ms. Storm's cross-examination that, following that luncheon, although they were informally or potentially invited to organize or sponsor a cross-Canada tour by Ms. Ebadi on human rights, LWOB was unable to do so, due to a lack of funding [Storm transcript, p 47].

[56] Also in relation to the University of Toronto, I note that Ms. Storm attached to her affidavit as Exhibit "SS" a partially redacted email exchange between August and November 2003 regarding a vague potential project involving PBSC at the University of Toronto Faculty of Law. However, based on what can be understood from that email exchange and from Ms. Storm's cross-examination, LWOB did not do any work on that file due to staffing issues, other than putting PBSC in contact with a man named Peter Henner. Indeed, Ms. Storm explained under cross-examination that:

[Answer to Q. 780] The nature of the relationship between [LWOB] and schools or law firms is that they have an ongoing request for interesting projects for their students that involve research skills, international rule of law issues [...]

[Answer to Q. 788] [...] So basically this little linkage was made, and whether Mr. Henner took it forward I'd have to—I'd continue examining the thread, but that

didn't seem to be critical to this particular proceeding except to show importantly that we took a project and we tried to introduce it to pro bono students of Toronto.

[57] At the hearing in this case, LWOB also noted Exhibits "KK" and "W" filed in support of the Storm affidavit to show the use of the Mark by LWOB prior to the date of first use alleged by ASFQ in association with the services (2) listed in this application.

[58] Exhibit "KK" consists of various email chains, all from November 2002, discussing a Career Without Borders event at McGill University in Montréal. An initial email dated November 15, 2002 was allegedly sent to Ms. Storm by a student at that university (whose identity has been redacted to preserve confidentiality), claiming to be a member of the McGill International Law Society and helping to organize this type of event. It reads as follows:

The purpose of this event is to familiarize law students with all the possible careers in international law, by meeting with legal practitioners involved in various fields.

Working on the assumption that there is such a thing as a Canadian "chapter" to your organization, or at the very least –

[59] The rest of the message is cut off, i.e. we cannot read the rest of the presumption mentioned. (I note that, under cross-examination regarding Exhibit "KK", Ms. Storm stated that the links created with McGill University date back to before her career day emails, i.e. Exhibit "KK" is related only to that event, not the beginning of the relationship with McGill University [Storm transcript, p 151]).

[60] Based on what we can understand from paragraph 16 of Ms. Storm's affidavit and the various emails in Exhibit "KK", Ms. Storm apparently forwarded that first email to Marion Williams (the same person who swore the Williams affidavit in this case) and Hamid Mojtahedi (a Canadian lawyer) asking if they were able to attend that event on behalf of LWOB. In one of the emails sent by Ms. Storm to a recipient identified as "Canadian International Counsel" (Mr. Mojtahedi), with Ms. Williams in cc, Ms. Storm wrote:

I can share with you a) a Power point presentation and b) some written materials that we've developed about pro bono, human rights work, etc. This should help. We'll also mail brochures to you...some pens to pass out if we can. I will respond to this young woman that we can send a representative (there is another Canadian lawyer willing to go – and she can speak to the work, for example, that she's doing for us from Canada-and you can speak about LWOB in general terms, as well as, from your help in developing

the role of lawyers as observers, your trip to Iran, all in the context of maintaining a rather traditional law practice in Canada.

[61] In her response on November 21, 2002 to the student at McGill University confirming LWOB's participation at the career day, Ms. Storm wrote:

We have two lawyer volunteers in Canada who are willing to attend your proposed meeting. Each has worked on a project with LWOB, one a research question from her office in Canada, the other a short trip to conduct an observation in Iran. I will equip them with materials for your students. Please keep me informed as you set the dates and agenda of your program.

[62] I note that, in this regard, Ms. Storm also filed as Exhibit "W" in support of her affidavit a copy of a photograph of Ms. Williams and Mr. Mojtahedi, taken at the event in question, which was apparently held "in and around 2003" [Storm affidavit, para 16]. Looking at the photo, I see that it shows no visible (or legible) mention of LWOB.

[63] It emerges from the evidence that this was apparently the only career day of its kind in which LWOB took part [Storm transcript, p. 146; and Williams transcript, p. 51]. Ms. Williams and Mr. Mojtahedi reportedly distributed approximately 30 to 50 LWOB brochures [Williams affidavit, para 6; Williams transcript, p. 59] at that event, which was reportedly attended by about 100 students, and they reportedly referred interested students to the LWOB website [Storm affidavit, para 16; Storm transcript, p. 141; Williams affidavit, para 6; Williams transcript, p. 58–59]. Ms. Storm also stated that LWOB reimbursed Ms. Williams and Mr. Mojtahedi for a portion of the costs incurred by them to attend the event [Storm affidavit, Exhibit "A", including a copy of the cheques made out to them, dated "2/14/03" for \$200 each; Williams transcript, p. 53]. I will come back to the role of Ms. Williams and Mr. Mojtahedi later. Suffice it to add at this point that Ms. Williams explained under cross-examination that, at that event, she and Mr. Mojtahedi participated in a panel discussion in which they shared their experience working with LWOB [Williams transcript, p. 55].

[64] Before continuing my discussion of the other exhibits in support of the Storm affidavit that LWOB specifically cited at the hearing to show prior use of the Mark by LWOB in Canada, I list here all the examples provided by Ms. Storm regarding links created by LWOB with Canadian universities.

[65] Ms. Storm referred at paragraph 33 of her affidavit to an email dated April 24, 2003, sent to Ms. Shime and Brigitte St-Laurent (at McGill University) to inform them of “human rights internet internships opportunities” that might interest their students, and an email exchange on December 17, 2003, with Ms. St-Laurent regarding the forwarding of an LWOB December Newsletter displaying the Mark. Ms. Storm attached a copy of the emails in question as Exhibit “RR” in support of her affidavit. I will come back to this type of newsletter later.

[66] At paragraph 31 of her affidavit, Ms. Storm also referred to a presentation given by York University’s Osgoode Hall Law School in 2004, displaying the Mark, a copy of which is attached to her affidavit as Exhibit “G”. Under cross-examination on this point, however, Ms. Storm could not recall precisely the details “of who, what, when and where” for that presentation, adding in particular that “I can tell you until this last week we have an ongoing relationship with Osgoode. We stay in touch with them, we support their students who are interested in pro bono, and I assume this was part of the development of this relationship with Osgoode over the years.” [Storm transcript, pp. 34–40]

[67] At paragraph 32 of her affidavit, Ms. Storm further referred to a group of students at McGill University who reportedly contacted LWOB in 2006, submitting “a request through our online pro bono lawyer assistance request mechanism seeking assistance in a case in Panama.” According to Ms. Storm, that group of students had themselves been contacted by an NGO in Panama called *Los Pescadores*. At paragraph 32 of her affidavit, Ms. Storm added that “LWOB was able to procure lawyers to assist and provide legal services for the project only to discover that the students had opted not to continue with their support of the group in Panama.” Under cross-examination in this regard, however, Ms. Storm could not provide any specific details on this from memory [Storm transcript, pp. 223–225].

[68] Returning to the other exhibits filed in support of the Storm affidavit that LOWB cited more specifically at the hearing to show use of the mark by LWOB prior to the date of first use alleged by ASFQ in association with the goods listed in this application, I note exhibits “B” and “J”.

[69] Exhibit “B” is a copy of the first newsletter entitled “BorderLines”, published by LWOB in April 2002. I note that this newsletter prominently displaying the Mark, as also noted by

Ms. Storm. She further states that this newsletter (and others) was distributed in Canada to lawyers, law firms, university students, NGOs, etc., and at seminars, conferences, etc. [Storm affidavit, para 15]. Ms. Storm noted that an international lawyer who she met while attending training in Nova Scotia in 2001 wrote an article in that issue. Under cross-examination, Ms. Storm indicated in particular that she had take the opportunity of that training to give a presentation on LWOB [Storm transcript, pp. 167–168]. I note that, later in her affidavit, Ms. Storm states that this type of newsletter is the paper version of the digital newsletter “BorderBriefs” published on the LWOB website. On examining Exhibit “B”, I note that it describes LWOB’s activities as follows:

The launch of this newsletter, as well as LWOB itself, signals the commitment by members of the legal profession around the world, to join in a global effort to resolve conflicts and together rebuild societies emerging from turmoil.

LWOB intends to embrace every lawyer and fraternal association of lawyers, every non-profit organization in need of service and counsel, and global human rights issues and initiatives with the particular goal of assembling all available pro bono resources [...]

LWOB is and has been during this last year, the second since its creation, a work in progress.

[Emphasis added]

[70] Exhibit “J” consists of copies of the spring 2006 and summer 2010 issues of LWOB’s digital newsletter “BorderBriefs”, also prominently displaying the Mark. Ms. Storm stated that these digital newsletters have been published on the LWOB website since 2002 and are still published there at this time. On examining Exhibit “J”, I note that it describes the mission of LWOB as follows: “The mission of LWOB is to create a global association of lawyers dedicated to the promotion and protection of justice via pro bono service” [emphasis added]. It also mentions LWOB’s disappointment at not achieving financial independence:

As LWOB moves through the second phase of the ten year plan its founder envisioned [...] The “one” disappointment is fairly critical, however : our failure to realize the financial independence we anticipated achieving by the end of year five—the year that was to make the transition of the organization from a wholly volunteer-run organization to one with full time paid staff overseeing programs and operations. That is still a key goal and one we are working hard to realize late this year.

[71] Also, with respect to these newsletters, Ms. Storm explained that one of their objectives is to educate lawyers, described as follows in her cross-examination:

We feature lawyers and what they're doing for us, and we feature stories about our projects and programming. The newsletter we consider an educational tool because many lawyers don't understand how they can apply their skills, but they read our newsletter and they see biographical sketches of other lawyers and what they've done. And we consider that as a way of educating them and helping them understand the diverse use to which they might be able to put their skills. That was true then and it's true now. We consider that a very key informative educational tool for lawyers.

[Storm transcript, p. 23]

[72] Returning to the role of Ms. Williams and Mr. Mojtahedi, I understand from the evidence that, in addition to his participation in the career day held at McGill University, Mr. Mojtahedi apparently travelled to Iran on three occasions as a volunteer representative of LWOB in about 2001 to 2003 [Storm affidavit, para 17; Storm transcript, pp. 154–157].

[73] The first such trip by Mr. Mojtahedi was reportedly to accompany a Canadian national who was to return to Iran, who feared for his safety and wanted to be accompanied by an observer to attest to his arrest in Iran. Mr. Mojtahedi then travelled to that country a second time to inquire about the nature of the proceedings initiated against that Canadian national. His third trip was reportedly to act as an observer at a trial involving three American nationals. However, Mr. Mojtahedi was apparently unable to attend the trial, as it was reportedly held *in camera*.

[74] In support of her claims, Ms. Storm refers to Exhibits “GG” and “MM” filed in support of her affidavit. Exhibit “GG” is a photograph of Mr. Mojtahedi’s identification card as “Special Counsel”, used by him in Iran in 2003 and displaying the Mark. Exhibit “MM” is a copy of an email dated April 5, 2002, sent by Mr. Mojtahedi (Canadian International Counsel) to Ms. Storm, referring in particular to preparations; “While the Iran project has been placed on hold, I look forward to receiving the ID and other paper work (releases) since the circumstances may change at any time. Particularly in light of Dr. Yazdi’s expected return to Iran in the coming weeks [...]”. I find this evidence to be very piecemeal. Accordingly, I am not prepared to consider that legal services were rendered by LWOB in Canada. At most, I am prepared to consider this evidence as supporting Ms. Storm’s assertions that there are Canadians among

LWOB's volunteers and that, through LWOB, they can gain various volunteer work experience abroad.

[75] Regarding the role of Ms. Williams, I take from my review of the affidavits by Ms. Storm and Ms. Williams and their respective cross-examinations that Ms. Williams acted as LWOB's representative in Canada from about January 2002 to 2005 or 2006 [Williams transcript, pp. 29–30 and 50]. It was essentially volunteer work that Ms. Williams spent part of her free time on [Williams transcript, p. 37]. As Ms. Williams remembers, LWOB had created an email address for her (*mwilliams@lwob.org*) in the two to three months after January 2002 [Williams transcript, pp. 18–20].

[76] It emerges from Ms. Williams' cross-examination that she is not a member of any bar in Canada and is not entitled to practise law in Canada [Williams transcript, p. 15]. In fact, Ms. Williams, who was born in Canada and lived here for a few years at various times in her life, did most of her law studies abroad and completed her bar in the Caribbean. When she was a representative of LWOB in Canada, Ms. Williams was living in Toronto. She returned to live in the Caribbean in about 2006, after splitting some of her time between Canada and the Caribbean [Williams transcript, pp. 6–12].

[77] According to Ms. Williams, she became LWOB's Canadian representative shortly after she began volunteering for LWOB. Ms. Williams stated that she had also acted as "Special Counsel for LWOB and the LWOB – UN ECOSOC Representative for Latin America and the Caribbean, a volunteer position with LWOB" [Williams affidavit, paras 2–3].

[78] Although Ms. Williams asserts that she did various duties in her various positions with LWOB, I find few concrete examples—particularly detailed examples and/or supported by corroborative evidence—emerge from her testimony as a whole. For example, although I do not necessarily question Ms. Williams' general assertions that she had taken part in one or more projects in Africa under the umbrella of the United Nations (particularly in Liberia in about 2005/06), I find that there is not enough evidence on record to reasonably understand and corroborate the nature of the work done by Ms. Williams in such projects as LWOB'S Canadian representative, particularly as they seem to have taken place in part when Ms. Williams was also

the UN ECOSOC representative in Latin America and the Caribbean for LWOB [Williams transcript, pp. 23–25].

[79] That said, it is clear from Ms. Williams testimony that, in addition to her participation in the career day at McGill discussed above, she prepared a document in 2003 entitled “*Lawyers Without Borders – Skill Sets Concept Paper*” aimed at providing “a summary of skills that LWOB believe lawyers possess.” That document was not specifically about Canadian lawyers, but rather the skills and knowledge of lawyers in general. That report was sent to Ms. Storm once completed. However, that report does not seem to have been distributed or published in any form [Williams affidavit, para 7 and Exhibit “A” in support of it; Williams transcript, pp. 61–63].

[80] It is also clear from Ms. Williams’ cross-examination that she is unable to confirm when LWOB began its activities in Canada, contrary to what she indicates in paragraph 8 of her affidavit, in which she states:

LWOB began operating in Canada in 2001, the organization has been known as “Lawyers without Borders”. We use, and have always used, “Lawyers without Borders” in all areas of our operations [...]

[81] The date of 2001 was given to her by Ms. Storm, “because when [Ms. Williams] joined, apparently Christina [Storm] was already communicating with other lawyers in Canada” [Williams transcript, pp. 67–68]. I will return to this later.

[82] I will end my discussion of the Williams affidavit here and will only highlight certain other parts of her testimony, where relevant to my analysis, as I did above in my discussion of LWOB’s participation in the career day at McGill University.

[83] As well, coming back to Ms. Storm’s testimony, we see that LWOB’s way of operating has evolved since 2001 and the evolution of the Internet, as explained by Ms. Storm under cross-examination:

[...] there’s been a change in how we do it, but not a change in what we do.

[...]

In the early days we sought to go out there and tell the world about what we could help them do. As we have evolved our reputation and our presence, and the evolution of the internet and social media, has given us the opportunity to put ourselves out there, and it is

more common now that people go searching for these opportunities, find us and reach out to us, and then we respond to them; than in the early days when the internet was not so popular and it was not a key vehicle for communicating. It wasn't the way you were going to getting your message out if you relied solely on the internet, so we had to be more physically proactive in the early days that we need to be now.

[Storm transcript, p. 22 and similarly on p. 145]

[84] With respect to the LWO website, Ms. Storm explained at paragraph 43 of her affidavit that the site with the URL *www.lawyerswithoutborders.org* was created in about 2001. Prior to that, LWOB had a website since its creation on January 30, 2000 at *https://lawyerswithoutborders.gobizgo.com*. Ms. Storm attached to her affidavit as Exhibit "K" a copy of a printout of that site, dated February 27, 2001, prominently displaying the Mark. On reviewing that exhibit, I note that LWOB's activities and services in association with the Mark are described as follows:

Welcome to Lawyers Without Borders website. As we bring our first year to a close, we are pleased to boast a membership of over 100 lawyers from around the world including USA, Canada, Australia, UK [...]

Our efforts to connect non-profit organizations with a pool of experienced attorneys and enthusiastic interns are being realized daily now. We will continue to create a clearinghouse of opportunities for practicing attorneys worldwide to share their expertise and experience [...]

[...]

At this site, we intend to provide a forum where you will discover educational opportunities (for younger attorneys and law students) and employment (paid and volunteer) opportunities, long and short term.

Please explore the site thoroughly [sic]. Announcements and links are changed and updated regularly. For special announcements, vacancies and other news, subscribing to our List as a member is advised. There is no fee for joining LWOB at this time. Entering our Database does however involve payment of a nominal fee of \$35.

LWOB is financed largely through the generosity of several attorneys who believe firmly in its mission. You are encouraged to click on the eCharity button to contribute to LWOB. In this regard, LWOB sincerely thanks the International Section of the Connecticut Bar Association for its financial support.

[Emphasis added]

[85] Which brings me to LWOB funding. It emerges from the evidence that LWOB never obtained any funding or formal grants from Canada, despite vague and unsuccessful attempts by Ms. Williams [Storm transcript, pp. 129–132; Williams transcript, pp. 40 and 46]. However, LWOB received some payments or donations from Canada, including:

- A cheque received from an individual in payment of the US\$35 registration fee required, as I understand it, at the time to be included in the LWOB volunteer database. However, I note that the copy of the cheque in question is not included. That cheque is only referred to in a letter, dated January 10, 2001, received from an individual in Toronto (whose identity has been redacted to preserve confidentiality) to send a résumé and the cheque in question [Storm affidavit, para 55, Exhibit “BB”].
- Cheques received from individuals in payment of the subscriber fees once required by LWOB to access its “opportunities board” (discussed below) [Storm affidavit, para 54; Storm transcript, pp. 179–180; Exhibit “Z”, including copies of cheques received from individuals (whose identities were redacted to preserve confidentiality), one from Calgary, the other from Vancouver, in the amount of US\$50 each, dated August 29, 2001 and November 30, 2002, respectively].
- A cheque from McGill University, dated October 21, 2003, in the amount of \$250, in payment of their annual subscription to access LWOB’s “opportunities board” [Storm affidavit, para 22; Storm transcript, pp. 178–180; Exhibit “Z”].
- A type of sponsorship or donation received from a Toronto branch of the Bank of Montreal (BMO), which reportedly provided certain objects to be offered as gifts at a golf tournament (benefit activity) hosted by LWOB in the United States, while Ms. Williams was serving as the Canadian representative of LWOB [Williams transcript, pp. 40–41].

[86] Returning to the payments made in connection with the “opportunities board”, Ms. Storm explained that, since 2002, LWOB has offered an “opportunities board” in association with the Mark for people looking for employment as interns, students or lawyers, in Canada or elsewhere, wanting to take part in international projects on the rule of law. At first, the opportunities board was only available for member who had paid a subscriber fee, or who were part of institutions that had paid a subscriber fee. According to Ms. Storm, “for several years”, at least one

university (McGill) paid fees to have access to the opportunities board. Ms. Storm added that, in 2004, LWOB created a “job board” accessible to the general public [Storm affidavit, paras 22–23]. In support of her assertions, Ms. Storm refers, in addition to Exhibit “Z” mentioned above, to Exhibits “T” and “FF” attached to her affidavit. Exhibit “T” is a copy of an email exchange she had with Ms. St-Laurent at McGill University, in which Ms. Storm told Ms. St-Laurent that, as of March 2004, LWOB’s opportunities board would be converted into a free job board, accessible to the general public. Exhibit “FF” consists of a copy of an invoice “for services rendered,” displaying the Mark and addressed to McGill University by LWOB on September 10, 2003, in the amount of \$250 and bearing the following description: “For: Job Vacancy and Intern Postings List Serv.” I note that, under cross-examination on this matter, Ms. Storm indicated that McGill University had apparently paid subscriber fees for the “pay” opportunities board for about 2–3 years. However, in response to undertaking 7 requesting evidence of other payments made by that university, LWOB replied that “No additional documents could be located” [Storm transcript, pp. 177–181]. I also note that, while Ms. Storm states that this “opportunities board” (converted in 2004 into a free “job board” accessible to the general public) has been offered in association with the Mark since 2002, I find no examples in the evidence of how the Mark was actually used in advertising or delivering such a service prior to the invoice of 2003. Indeed, while I have no reason to believe that such an opportunities board was not offered at the time in association with the Mark, as asserted by Ms. Storm, the fact remains that the printout of the LWOB website in Exhibit “K” dates apparently from before the creation of such a service, as seen on page 101 of Ms. Storm’s cross-examination.

[87] With respect to their job board accessible to the general public, Ms. Storm states at paragraph 23 of her affidavit that Canadians accessed it and used it:

Google analytics confirm substantial access to the job board by individuals from throughout Canada. Since 2005, our job board has received 21 specific applications from Canadians to positions offered by LWOB. Since 2004, our job board has received 119 resumes from Canadians who posted their resumes for registered companies with our job board to review and pick from when conducting an applicant search.

[88] Ms. Storm asserts that LWOB employed full-time interns and lawyers from Canada and/or Canadian universities or hosted them as volunteers. She provides two examples of individuals who reportedly worked at LWOB’s offices in the United States and the United

Kingdom in 2009/10, and two examples of a “major Latin America (LAC) project” in which individuals based in Canada reportedly worked in 2008/09 [Storm affidavit, para 24; transcript, pp. 189–199]. In the absence of further information regarding these examples and corroborating evidence, I will not discuss them further.

[89] Ms. Storm further asserts that Canadian lawyers acting as LWOB representatives and volunteers participate in all kinds of LWOB activities in Canada and abroad. According to Ms. Storm, since 2006, LWOB has had over 200 volunteers registered as living in Canada, representing a significant proportion of their global network [Storm affidavit, para 35; Storm transcript, pp. 232–237, and 272; and response to undertaking 13—this figure represents the number of people registered since 2006, i.e. their status, availability and/or interest may have changed since the time of their registration. As explained by Ms. Storm at pages 232 and 272 of her cross-examination, “the goal of [LWOB] is to match the right person for the right job [...] And sometimes a lawyer enters a database and doesn’t end up getting placed for five, six, seven years.”]. She explains that LWOB remains in contact with its volunteers through an online database that it created several years ago (to replace its listserv distribution list, which according to Ms. Storm also included physical people and organizations in Canada) and that it still maintains. She further asserts that, at least as early as 2001, LWOB used it to promote its activities and services under the Mark:

[LWOB has] 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 trademark LAWYERS WITHOUT BORDERS and continue to do so to this day.

[90] Ms. Storm added at paragraphs 36 and 37 (corrected) of her affidavit that LWOB worked with Canadian lawyers on assessment and observation projects around the world:

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 [...]

In the last few years alone, we have briefed and dispatched a number of Canadians who are lawyers into rule of law assessments, trial observations and other projects around the world. Canadian lawyers have been sent to Kenya, Uganda and Namibia [...]

She also cites the following examples:

- Stephanie Case: Ms. Storm explains that she is an LWOB volunteer who, under LWOB direction and supervision, worked during her law studies and then as a lawyer in various developing countries, on all kinds of programs regarding the rule of law, particularly on international human rights issues, including:
 - In 2007–2008, Ms. Case worked with us during the CUD Trial Observation in Ethiopia, networking with the local legal community and conducting legal research [...]
 - In 2006–2007, 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 [...] Marked as Exhibit “H” is a report by Ms. Case detailing her observations from hearings held in the Supreme Court, Temple of Justice.
 - In 2007, Ms. Case travelled to Liberia to conduct a post-program evaluation of one of our projects in that area [...] She and the other volunteer were also involved in observing trials and reaching out to the community through various promotional activities [...]
 - Most recently, Ms. Case traveled to the West Bank to conduct due diligence and investigate partner prospects in connection with [...]

It emerges from Ms. Storm’s cross-examination that, in each of these projects, Ms. Case reported to Ms. Storm and that it was LWOB that [TRANSLATION] “sent and paid to send” Ms. Case, at least in the case of the observation mission in Ethiopia. Ms. Case’s last mission with LWOB was in 2013. Ms. Case apparently now lives in Gaza, where she reportedly works for the United Nations [Storm transcript, pp. 237–240].

- Michael Wicklum: Ms. Storm explains that he is 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 attached to her affidavit as Exhibit “I” an assessment report prepared by Mr. Wicklum, dated December 29, 2008. According to Ms. Storm, Mr. Wicklum “also served as an observer of the ‘Caprivi Treason Trial’ in Windhoek, Namibia for LWOB.” However, no further information is provided in this regard.
- Jenny Mboutsiadis “of Toronto [...] served as an observer in Namibia.” However, no further information is provided in this regard.

[91] Ms. Storm also adds that, in 2008 LWOB “dispatched a Canadian lawyer and law graduate Adam Samarillo, to manage our UK operations in London” [Storm affidavit, para 38].

[92] Ms. Storm further asserts that, in the summer of 2010, she spoke with a Canadian judge “about an effort to create a training program, focused on highlighting the similarities and differences between common law trials and civil law trials, in French for launch in francophone Africa.” However, under cross-examination on this, Ms. Storm indicated that she could not remember at the time the name of the judge in question, and that there was no follow up on their exploratory discussions [Storm affidavit, para 18; Storm transcript, pp. 157–159].

[93] According to Ms. Storm, LWOB “also connects Canadian NGOs in need of legal services in Canada with student groups and/or lawyers in Canada” [Storm affidavit, para 19]. Although Ms. Storm added that LWOB “manages, oversees and controls the quality of the legal services provided by the individuals and any of its representatives in varying degrees depending upon the entity involved”, I note that the only concrete examples of Canadian NGOs provided by Ms. Storm relate only to the aspect of “linkage” between such NGOs and students/lawyers in Canada, as described below:

- Winnipeg NGO RESPECT (Refugee Education Sponsorship Program: Enhancing Communities Together). Ms. Storm’s testimony reveals that LWOB was contacted by this Canadian NGO, which was seeking the services of a Canadian lawyer as a volunteer representative. RESPECT completed the LWOB intake form available on the LWOB website and LWOB then announced RESPECT’s request for volunteer assistance to members of the LWOB listserv on January 8, 2004, as seen in a copy of the announcement, displaying the Mark, filed as Exhibit “DD” in support of the Storm affidavit. According to Ms. Storm, LWOB reportedly made considerable efforts to find a Canadian volunteer lawyer for this NGO, which ultimately did not materialize given that LWOB had subsequently been informed by RESPECT that it had another counsellor [Storm transcript, pp. 162–165].
- Ottawa NGO MBAs Without Borders. It emerges from Ms. Storm’s testimony that LWOB was contacted by this Canadian NGO, which was seeking the services of a Canadian lawyer as a volunteer representative. MBAs Without Borders completed the

LWOB intake form, displaying the Mark, available on the LWOB website, as seen in a copy of that form completed on September 8, 2006, filed as Exhibit “V” in support of the Storm affidavit. Although Ms. Storm states at paragraph 21 of her Affidavit that LWOB reportedly provided that NGO with “pro bono lawyers providing legal services under the quality control of LWOB,” it emerges from Ms. Storm’s cross-examination that the only services provided by LWOB instead apparently consisted of the “linkage” between that NGO and a Canadian lawyer [Storm transcript, p. 172; “That was one of our successful matches”]. Indeed, LWOB was not involved in the relationship that was then established between the NGO and the lawyer/law firm that were linked [Storm transcript, pp. 170–174].

[94] Ms. Storm also attached to her affidavit as “recent examples of our efforts to connect NGOs with Canadian volunteers” an email exchange (partly redacted), dated October 18, 2014 (included in Exhibit “HH”), between LWOB and a person whose identity has been redacted who contacted LWOB as follows: “We need assistance in submitting the non-profit paperwork necessary to establish ourselves as a functioning, registered non-profit Canadian organization. This –”. The rest of the message is cut off (redacted). In her response, Ms. Storm wrote: “We can send you an intake form to fill out – and ‘shop’ your request to various Canadian firms in an effort to recruit one to take you on as a pro bono client. The ‘intake form’ will be forwarded to you on Monday [...]”

[95] Specifically with respect to the “linkage” provided by LWOB for NGOs, it emerges from Ms. Storm’s testimony that there was a short period during which LWOB attempted to automate this “linkage”, as seen in the 2010 copy of the intake form found on the LWOB website, filed as a Exhibit “Y” in support of the Storm affidavit, which included the following message:

If we feel that simple queries cannot be managed between your NGO and our offices, we will not even begin the process of attempting to profile your request to the law firms.

[...]

Our new policy will simply take your information and post it to our website. It will remain there until you advise us in writing to please remove it. We will no longer undertake to recruit lawyers to assist you, but invite lawyers viewing our site to make direct contact with you, so be sure your “contact” person be someone knowledgeable about your legal need.

[96] However, LWOB apparently did not continue that automation, as they were not satisfied with the result (neither NGOs nor volunteers liked this new method), and LWOB reportedly returned “to a more – more engagement on our part than an automatic linking partnering system permits” [Storm transcript, pp. 251–252].

[97] With respect to the promotional activities carried out by LWOB, in addition to the “paper” and digital newsletters in Exhibits “B” and “J” discussed above, Ms. Storm mentions at paragraph 32 of her affidavit that, between 2006–2008, she was reportedly, “on at least one occasion [...] a guest speaker for a live 30 minute radio talk-show in Canada [...]” However, under cross-examination on this, Ms. Storm could not provide the name of the network, the exact date, etc., as she could not remember [Storm transcript, pp. 246–249].

[98] At paragraphs 43–52 of her affidavit, Ms. Storm also provides various data regarding LWOB’s website *www.lawyerswithoutborders.org* and LWOB’s social media presence, including:

- Exhibit “U”: A printout showing the number of hits on the LWOB website in May 2002, according to which it had over 200 hits from Canada.
- Exhibit “L”: A printout regarding the number of hits on the LWOB website between June 26, 2010 and July 26, 2010, according to which it had over 300 hits from 70 Canadian cities.
- Exhibit “M”: A printout regarding the number of hits on the LWOB website between August 8, 2009 and August 8, 2010, according to which it had 1,396 hits from 186 Canadian cities. Although Ms. Storm added that, between September 22, 2014 and October 21, 2014, LWOB had 337 hits from Canada, the third most worldwide, no supporting documents were provided.
- Exhibit “NN”: An email summarizing statistics on the number of hits on the LWOB website in January 2004 from seven Canadian provinces.
- Exhibit “N”: A printout of statistics on hits per page, between (according to Ms. Storm) 2009 and 2010. Although Ms. Storm explained that “along with the home page, our job board and newsletter pages are amongst the most frequently visited pages”, there is no data specific to Canada.

- Exhibit “JJ”: A report on the number of Facebook fans, showing 177 fans from Canada. According to Ms. Storm, this figure is for the last quarter, provided by Facebook when her affidavit was signed. Ms. Storm also provides further information regarding Facebook for October 2014, generated from *www.simplymeasured.com*, for the “People Talking About This by Country” and “Reach by Country” headings, showing 2 and 31 people from Canada, respectively. She also provided a printout of LWOB’s Facebook page, displaying the Mark, dated October 21, 2014, in Exhibit “II”.
- Exhibit “AA”: A printout of the LWOB Twitter page, displaying the Mark and showing 1,080 followers as of October 22, 2014. Of these, 5.83% are reportedly from Canada, i.e. 63 Canadians according to my calculation.

[99] In addition to her overall testimony regarding LWOB’s activities in Canada, Ms. Storm also attached to her affidavit various correspondence and email exchanges, including several dated from 2001 and 2002. Some examples (not comprehensive):

- Also included jointly in Exhibit “BB” mentioned above:
 - A copy of a letter dated February 11, 2001, from Ms. Storm to a person living in Ontario (whose identity has been redacted to preserve confidentiality) who reportedly worked as a volunteer for LWOB in developing promotional material and/or the LWOB newsletter in April 2002. However, the work done by that volunteer could not be clarified during Ms. Storm’s cross-examination, as she could not remember [Storm transcript, pp. 256–259].
 - A copy of a letter dated October 23, 2002, from Ms. Storm to a lawyer in Vancouver, sending him “some materials regarding Lawyers Without Borders” and asking if he could send them a copy “of the Bar Article about LWOB?” In the same letter, Ms. Storm adds: “Please consider joining our Yahoo Group as well as our listserv to stay informed about developments. (See the “Join” page at our website).”
- Exhibit “CC”: A copy of a letter dated November 1, 2001, from Ms. Storm to a professor at the University of Connecticut School of Law, in which Ms. Storm refers to the model developed with the University of Ottawa.

- Exhibit “LL”: Jointly, copies of various emails received or exchanged with potential volunteers in Canada, mostly inquiring about whether there was a Canadian chapter of LWOB and/or wanting to become members of LWOB, including:
 - An email dated June 15, 2002, received from a student at McGill University (whose identity has been redacted to preserve confidentiality) wanting to become a member of LWOB.
 - An email dated May 2, 2002, received from a Canadian lawyer sending LWOB his résumé.
 - An email dated July 5, 2002, received from a person (whose identity has been redacted to preserve confidentiality) introducing themselves as “one of the Student Co-ordinators for the [PBSC] at the University of Toronto Faculty of Law”, referring in particular to the work done by PBSC at the University of Ottawa with LWOB.
 - An email dated August 12, 2002, received from a lawyer in British Columbia (whose identity has been redacted to preserve confidentiality) wanting to become a member of LWOB and referring to receive “of my monthly edition of BarTalk in which there is an article about LWOB”.
- Exhibit “PP”: An email dated April 2, 2003, sent by LWOB to listserv members registered with its “LWOB Subscriber Internships, Scholarships and Fellowships Posting Service”. In this regard, Ms. Storm added that “[a] number of Canadian [sic] were on LWOB’s listserv at that time” [See also Storm transcript, pp. 269–270].
- Exhibit “QQ”: Copies of automated emails dated June 11, 2002, July 18, 2002, and July 19, 2002, attesting to the registration of three new subscribers (whose identities have been redacted to preserve confidentiality) from Canada (“This is your automated subscriber report”).

[100] In the penultimate section of her affidavit, Ms. Storm refers to cases in which LWOB learned of articles in journals, newspapers or other publications that refer to “*Avocats sans*

frontières” as “lawyers without borders”. It emerges from Ms. Storm’s cross-examination that some of those cases were not related to ASFQ, but rather to other entities in the *Avocats Sans Frontières* international movement, particularly the Belgian organization, and were not necessarily related to Canada. Regardless, Ms. Storm attached to her affidavit as exhibits “O”, “P”, “Q”, and “S” copies of letters or emails sent by LWOB to Canadian or foreign publications in 2002, 2004, 2008, and 2009 to inform them, on the one hand, of the existence of LWOB and its alleged rights to the Mark and, on the other hand, of the fact that ASFQ or any other entity referred to as “lawyers without borders”, as applicable, were in no way related to LWOB. There was no subsequent follow-up by LWOB. In addition, LWOB apparently took no further steps to advise ASFQ of its rights to the Mark in about 2002–2004 because, as Ms. Storm remembers, ASFQ could not be reached and had no website at the time [Storm transcript, pp. 67–86].

[101] Finally, Ms. Storm concludes her affidavit by returning to the purpose of LWOB’s work in Canada, arguing at paragraphs 72 and 73 of her affidavit that:

LWOB’s work in Canada is to encourage the growth of pro bono legal services, and to raise awareness amongst NGOs, and residents in Canada of the potential and opportunities for pro bono legal services in Canada [...] and find opportunities for Canadian lawyers to become employed or volunteer in internationally oriented rule of law programming [...]

[...] our Canadian oriented work is not segregated from our work throughout UK, Europe and North America. LWOB is a globally oriented group of lawyers and Canada has always been a big part of that global orientation [...]

[102] In closing, I would like to return to certain aspects of LWOB’s evidence that were discussed in cross-examination.

[103] First, with respect to the fact that several exhibits filed by Ms. Storm in support of her affidavit include redacted information, I find that this does not necessarily make these exhibits inadmissible or unusable. Indeed, Ms. Storm explained under cross-examination (and/or in her responses to the undertakings) why some of that information had been redacted, including to preserve the confidentiality of the identities of the people involved, who might be looking for a new job, etc. As well, if the information redacted in that way does not, for example, hinder the understanding of the document filed as an exhibit and/or the determination of its geographic origin, I find that such redactions do not necessarily affect the probative value of those exhibits.

[104] Moreover, regarding the fact that several responses provided by Ms. Storm under cross-examination were vague or uncertain, I find that that does not necessarily undermine the credibility of her testimony as a whole. Indeed, I note that, in some places in her cross-examination, Ms. Storm replied to the best of her memory at the time, while offering to check LWOB files later to precisely reply to ASFQ questions, which was refused by ASFQ. As explained by Ms. Storm, several of the questions were about events that happened over a dozen years ago. As well, in that the responses provided by Ms. Storm were corroborated by other probative and sufficiently specific evidence, I find that some of the imprecision or uncertainties expressed by Ms. Storm in her cross-examination are not necessarily problematic.

[105] In this regard, bearing in mind the Invalidating Judgment in which the Federal Court was of the view that it could give only “little weight” to Ms. Storm’s affidavit in that case, due in particular to “significant contradictory evidence”, I note that, at times in her cross-examination in this case, Ms. Storm referred to some of her statements that were twisted during the proceedings that led to the Invalidating Judgment, such as:

Q. 441 Okay. I have a proposition to make to your counsel. In order to save time on some of the statements that may or may not be inconsistent, why don’t we just mark the previous cross and I can skip over all those questions.

A. No, I’d rather go through the inconsistencies. I really felt in the first proceeding that my words were often twisted, and I’d like to have the opportunity to clarify if I can on the record.

[106] This leads me to discuss exhibits “CS-A”, “CS-B”, and “CS-C” filed during Ms. Storm’s cross-examination.

[107] It emerges from it that the purpose apparently sought by ASFQ in introducing those three affidavits was to question or contradict Ms. Storm’s assertions regarding certain dates of LWOB’s first use of the Mark in Canada, alleged in Ms. Storm’s affidavit filed in this case.

[108] Specifically with respect to the McKenna affidavit in Exhibit “CS-C”, Ms. McKenna states in it that, in or around September 2004, she and Yasmin Shaker entered into discussions with Ms. Storm to explore the possibility of creating a Canadian chapter of LWOB. After some exploratory discussions, Ms. Shaker and Ms. McKenna decided not to pursue their discussions with LWOB and to instead start their own organization. According to Ms. McKenna, LWOB’s

philosophy did not correspond to what she and Ms. Shaker were considering. Ms. McKenna added that she had never worked, as a volunteer or otherwise, for LWOB and that the CLA business model is not based on the LWOB model. In the Invalidating Judgment, the Federal Court was of the view that the McKenna affidavit impugned “parts” of Ms. Storm’s affidavit in that case.

[109] Under cross-examination regarding the McKenna affidavit in this case, Ms. Storm indicated that she agreed with Ms. McKenna’s statements regarding their past discussions, while taking care to correct the fact that it was initially Ms. Shaker who entered into discussions with LWOB and who then got Ms. McKenna involved in their discussions [Storm transcript, pp. 208–215]. Regarding the issue of whether the business model adopted by CLA was based on the LWOB model, Ms. Storm replied in particular that:

[Answer to Q. 732] You know, the issue isn’t invented, we worked with Yasmeen [sic] Shaker and she became aware of our organization and what we did through our work with students. She and her friend decided that they wanted to create an organization that was exclusively used and had access to tremendous resources in Canada, financial resources, which she wanted to take advantage of, doing student-oriented focused program. Were we the first people to come up with doing student-oriented focused programs, I’m sure we weren’t. Did they get their inspiration from LWOB, I’d like to think that they did. I don’t think it’s relevant.

The point is we were going to embark on doing a chapter of LWOB with them, but it was clear that their focus was going to be students and our focus was broader, more diverse, we mutually agreed that what they did was admirable, what they were going to do was admirable, I wished them the best of luck, and we parted our ways. We’re doing two different things and hopefully we’re both doing them well.

[110] Given Ms. Storm’s overall testimony, I do not see how the McKenna affidavit, filed during the proceedings that led to the Invalidating Judgment, contradicts or weakens the evidence presented by LWOB in this case. In this regard, as will be seen from my analysis below, the mere fact that LWOB has never had a Canadian chapter is not enough in itself to necessarily question or contradict certain assertions by Ms. Storm regarding LWOB’s use of the Mark in Canada.

[111] With respect to exhibits “CS-A” and “CS-B”, ASFQ specifically discussed certain paragraphs of Ms. Storm’s earlier affidavits regarding the period in which Ms. Williams acted as LWOB’s Canadian representative. In her affidavit filed in support of the proceedings that led to

Opinion Decision 45 (Exhibit “CS-B”), Ms. Storm stated at paragraph 8 that “Since at least 2003 LWOB has had a permanent representative in Toronto, Marion Williams.” In her affidavit filed in support of the proceedings that led to the Invalidating Judgment (Exhibit “CS-A”), Ms. Storm stated at paragraph 6: “Marion Williams is a Canadian lawyer, and has been operating under the directions of LWOB since its inception, and was LWOB’s representative in Canada from about 2001 to the present.” In her affidavit filed in support of the proceedings that led to the Invalidating Judgment (Exhibit “CS-A”), Ms. Storm stated at paragraph 6: “Marion Williams is a Canadian lawyer, and has been operating under the directions of LWOB since its inception, and was LWOB’s representative in Canada from about 2002 to the present.” In response to a question from ASFQ regarding these various dates, Ms. Storm commented as follows:

[Answer to Q. 393] Yeah, I understand the question. The question is: Was it 2001, was it 2002? The answer is that Marion apparently her records reflect her involvement initiated in January 2002. The records -- I believe we went with actually the date Marion confirmed her involvement, but I was -- able to find documents in the last week or two -- not documents, online portals that reflected that her involvement with us may have actually predated even what she and I had originally thought were her first communications with us and worked with us.

Q. 394: Okay. So just going back to my questions, in 2010 you said she started in 2001. I’m showing you another affidavit [Exhibit “CS-B”] [...] and I see there at paragraph 8 that you refer to Ms. Williams’ beginning since at least 2003. Do you see that?

A. Yes, this is an argument you made at the last hearing to the Court.

Q. 395: Yes, and I --

A. And the thing I wanted to mention to you, which we’re not allowed to do in Canadian Courts than you can do in American courts, is that that says “at least”.

Q. 397: Yes.

A. And that is true, that at least as of 2003, and I probably should amend my affidavit here to say “at least 2002”, because our records evidence the fact that Marion was involved with us probably as early as 2001.

Q. 398: Okay.

A. And that’s the truth.

[112] As can be seen from this excerpt and from some other passages from Ms. Storm’s cross-examination and Ms. Williams’ testimony in this case, it can be understood that the first interactions between LWOB and Ms. Williams began in 2001, before she began working as the LWOB “representative” in Canada in early 2002. In any event, I have already indicated that the

only evidence that I was prepared to accept, essentially from Ms. Williams' testimony, was her participation at the career day at McGill university and her preparation of the "*Skill Sets Concept Paper*" that was apparently never distributed. To conclude, I find that exhibits "CS-A" and "CS-B" do not necessarily weaken LWOB's evidence in this case.

[113] This leads me to review the evidence filed by ASFQ in addition to the exhibits filed during Ms. Storm's cross-examination in this case.

III.3.3 Review of the evidence filed by ASFQ

[114] Considering, first of all, the affidavits sworn by Mr. Potter and Mr. Headon, they essentially assert three things: 1) that they always associated the use of the trademark AVOCATS SANS FRONTIÈRES and/or the Mark with ASFQ, as they remember, since at least their respective terms as President of the CBA; 2) that any use of which they have knowledge of the trademarks AVOCATS SANS FRONTIÈRES and LAWYERS WITHOUT BORDERS in Canada was in association with ASFQ; and (3) they have never known of any use of the Mark in Canada by LWOB. I agree with LWOB that such assertions are not enough in themselves to necessarily question or contradict Ms. Storm's allegations regarding LWOB's use of the Mark in Canada. At most for ASFQ, I find that such assertions are instead related to the extent to which the Mark has become known in Canada or the reputation acquired by LWOB.

[115] Now considering the Paradis affidavit, it has 80 paragraphs and includes exhibits "PP-1" to "PP-126", totalling 10 volumes. In addition, this lengthy affidavit must be read in light of the transcript of Mr. Paradis's cross-examination on this affidavit, which has some 178 pages, and includes exhibits and responses to undertakings.

[116] I will summarize here the portions of the affidavit that I find are most relevant to my analysis. That being said, I find that this summary nonetheless requires a fair amount of detail in order to assess the context of certain assertions by Mr. Paradis that are apparently intended to question or contradict certain allegations by Ms. Storm regarding LWOB's use of the Mark in Canada. I will also take this opportunity to comment on certain aspects of ASFQ's evidence regarding its use of the Mark, including some of the observations made by ASFQ in this case.

[117] Mr. Paradis states at paragraph 2 of his affidavit that he was one of ASFQ's founding members, was secretary of its board of directors since November 25, 2002, and has been Executive Director of the organization since October 2004.

[118] At paragraphs 3 and 6 of his affidavit, Mr. Paradis states that ASFQ has been running a non-profit enterprise in Canada since May 2002 (incorporated on October 23, 2002), the mission of which is to support the defence of the rights of vulnerable people in developing countries, countries that are fragile or countries in crisis by improving access to justice and legal representation. More specifically, ASFQ works in Canada to promote justice and the defence of human rights around the world, particularly by managing international cooperation programs and organizing volunteer missions abroad, organizes fundraising in Canada to fund those missions and conferences, organizes awareness campaigns and distributes information across Canada on various themes related to ASFQ activities.

[119] At paragraph 7 of his affidavit, Mr. Paradis asserts that ASFQ has employed over 45 people at its Québec City head office since 2012, 14 of whom were employed full-time at the time of his affidavit. ASFQ also has 20 employees in its offices in Bamako (Mali), Bogota (Columbia), Guatemala City (Guatemala) and Port-au-Prince (Haiti), long-term and full-time volunteers in Colombia, Peru, Guatemala, Honduras, Costa Rica, Haiti, Mali, Côte d'Ivoire, Tunisia, and Morocco, in addition to a team of 600 volunteers from several Canadian provinces.

[120] At paragraph 8 of his affidavit, Mr. Paradis states that, in the past five years, ASFQ's average annual budget has exceeded C\$2 million. In this regard, it emerges from his testimony as a whole, particularly paragraphs 9 to 15 of his affidavit, that ASFQ can count on many Canadian contributors and funders, including government agencies, corporations, other non-profit organizations and individuals. Without repeating the full list of them provided by Mr. Paradis, I will simply note here, for example, Quebec's *Ministère de la Justice*, several Bar sections in Quebec, Global Affairs Canada, etc. Also, the honorary chair of ASFQ is the Honourable Claire L'Heureux-Dubé, a retired justice of the Supreme Court of Canada. That being said, this was not always the case, as explained as follows on page 1 of the ASFQ activity report for January 1, 2008 to June 30, 2009 [Exhibit "PP-4"]:

[TRANSLATION]

Since the last membership meeting in June 2008, [ASFQ] has made so much progress that we can practically talk about a new NGO.

In terms of funding, [ASFQ] has gotten itself out of the precarious situation in which the association has been perpetually immersed since its creation and which limited its ability to act. With modest flexibility, [ASFQ] can now consider the development of its activities and its organization as the Board of Directors intended in adopting the 2005–2008 Strategic Plan.

[...]

Although [ASFQ]’s financial situation is not yet secure, by far, revenues from the latest funding events and new contributions received allowed it to take a giant step by opening its offices in Québec City and hiring its second and third full-time employees in early 2009 [...]

[121] It should be noted here that, prior to the opening of the office in question in 2008, Mr. Paradis was working from home, his apartment having [TRANSLATION] “become to some extent the office, the centre of action for [ASFQ]”. Indeed, Mr. Paradis started working full-time for ASFQ in 2004, working without pay until about May 2005 [Paradis transcript, pp. 21–24 and 163–164].

[122] It also emerges from Mr. Paradis’s testimony, particularly paragraphs 16–18 of his affidavit, that ASFQ has a significant presence at several Canadian universities. In particular, ASFQ oversees the following student associations:

- *Avocats sans frontières Université Laval (ASF Université Laval)*, founded in 2006.
- *Avocats sans frontières Université de Montréal (ASF Université de Montréal)*, founded in 2008.
- *Lawyers Without Borders McGill (LWB McGill)*, founded in 2008.
- *Avocats sans frontières – Section Université d’Ottawa (ASF Ottawa)*, founded in 2008.
- *Avocats sans frontières Université de Sherbrooke (ASF Université de Sherbrooke)*, founded in 2008.

[Exhibits “PP-10” to “PP-16” attached to his affidavit].

[123] Dr. Paradis further explained that, through its partnership with the International Human Rights Clinic at the University of Toronto, ASFQ distributes information about its activities at that University, while ASFQ’s partnership with *Level/Égalité* (formerly known as *Avocats canadiens à l’étranger / Canadian Lawyers Abroad*) allows it to reach students in the following

law schools to inform them about its activities and recruit interns and volunteers: University of Victoria, University of British Columbia, University of Calgary, University of Alberta, University of Saskatchewan, University of Manitoba, University of Windsor, University of Western Ontario, Queen’s University, University of New Brunswick, Dalhousie University.

[124] More specifically regarding the trademarks used by ASFQ in its activities, Mr. Paradis states at paragraph 19 of his affidavit that, in association with its goods and services, ASFQ uses the trademarks AVOCATS SANS FRONTIÈRES, LAWYERS WITHOUT BORDERS, and ASF, which he collectively defines as the “ASF Marks”. It must be noted at this stage of my analysis that the trademarks ASF and LAWYERS WITHOUT BORDERS are registered respectively as numbers TMA766,649 and TMA954,925 [Exhibit “PP-17” attached to his affidavit; and a certified copy mentioned above]. I also note that the goods and services listed in those registrations and the alleged dates of first use of them are the same as in this application, except the date of [TRANSLATION] “at least as early as June 2005” (instead of “at least as early as November 2006”) claimed in relation to the products for the trademark AVOCATS SANS FRONTIÈRES.

[125] In the rest of his affidavit, Mr. Paradis never separately discusses the use of the Mark by ASFQ, but always the ASF Marks collectively.

[126] Mr. Paradis thus argues that:

- Since its creation, ASFQ has been the subject of an extensive press review in association with the ASF Marks across Canada, including hundreds of mentions in the print media, periodicals and magazines, etc., in addition to its own promotional and funding activities [paras 25–36, 54, and 65–73; and exhibits “PP-22” to “PP-60”; “PP-73” to “PP-82”; and “PP98” to “PP-111”].
- ASFQ has used and continues to use each and every ASF Mark in association with the goods and services covered by this application, in a continuous manner, since at least as early as the dates claimed in its corresponding applications and/or registrations [para 38 (corrected); and exhibits “PP-17” to “PP-19”].

- With the permission of ASFQ, the student associations overseen by ASFQ also use the ASF Marks in their activities, always under the control and direction and for the benefit of ASFQ [para 39].
- Since June 2005, ASFQ has been publishing regular newsletters in association with the ASF Marks regarding ASFQ activities. Mr. Paradis stated that, at the date of signing his affidavit, 2,161 people were subscribed to and received the ASFQ newsletter [paras 40–42; and exhibits “PP-61” to “PP-64”].
- ASFQ uses the ASF Marks in association with the organization of international cooperation missions and activities to defend and promote human rights (since its creation, ASFQ has conducted no less than 270 international cooperation activities in Canada and 23 other countries) [paras 43–46; and exhibits “PP-65” and “PP-66”].
- ASFQ has a social media and online presence. In particular, Mr. Paradis states that:
 - Since January 2004, ASFQ has managed a website in association with the ASF Marks at *www.asfcanada.ca* that allows the legal community and the general public learn about ASFQ activities, their results and the concrete changes that they bring on the ground, etc. For the period from January 2005 to February 2016, statistics compiled automatically by the traffic management software on the ASFQ site indicate more than 200,000 open sessions, more than half of which were from new visitors. The ASFQ website has more than 500,000 page views [paras 47–48 of his affidavit].
 - ASFQ has had an institutional Twitter account since February 2010, which had 290 followers when Mr. Paradis’s affidavit was signed. Also, Mr. Paradis’s Twitter account associated with the role of Executive Director of ASFQ had 723 followers when his affidavit was signed [para 49; and exhibits “PP-67” and “PP-68”].
 - ASFQ has had a Facebook account since December 2013 and had 2,824 “likes” at the time of his affidavit. The ASFQ groups also have Facebook accounts that use the ASF Marks. Mr. Paradis states that, when his affidavit was signed, the Université Laval account had 919 “likes”, the Université de Montréal account had 670, the McGill University account had 489, the Université de Sherbrooke

account had 1,109, and the University of Ottawa account had 450. [para 50; and Exhibit “PP-69”].

- Since November 1, 2006, ASFQ has also published, in association with the ASF Marks, a blog specifically intended for the Canadian legal community and the general public, offering news on ASFQ activities and files being monitored by the organization. Mr. Paradis stated that the statistics compiled by the traffic management software on the ASFQ website for the period from January 2005 to February 2016 confirm over 55,000 views. Mr. Paradis added that some of the posts on the ASFQ blog have also been published nationally on the FP Legal Post [paras 51–52; and Exhibits “PP-70” and “PP-71”].
- ASFQ has conducted numerous awareness campaigns on several issues related to access to justice and human rights in Canada. Without repeating the full list of them provided by Mr. Paradis, I will simply note here, for example, those related to the repatriation of Omar Khadr to Canada and the release of Saudi blogger Raïf Badawi [paras 55 to 64; and exhibits “PP-22”, “PP-79”, and “PP-83” to “PP-97”].
- Since November 2002, ASFQ has conducted fundraising activities in Canada to fund ASFQ’s international cooperation missions and its activities in Canada. Mr. Paradis also states that, since 2002, ASFQ has continuously conducted financing activities and campaigns in association with the ASF Marks with public and private institutions and with the general public in Canada [paras 65 to 73; and exhibits “PP-13” to “PP-16” and “PP-98” to “PP-111”].
- Since 2002, ASFQ has organized or presented over 100 conferences and information or training sessions in association with the ASF Marks [paras 74–75; and exhibits “PP-82” and “PP-112” to “PP-126”].

[127] On reviewing all the evidence filed by Mr. Paradis in support of his assertions, I note that the Mark, when it is displayed, is almost always accompanied by other words and/or graphic elements, as in the main examples reproduced below:



AVOCATS SANS FRONTIÈRES
LAWYERS WITHOUT BORDERS
QUÉBEC

Pascal Paradis

McCarthy Tétrault s.r.l./LLP
1150 rue de Claire-Fontaine, 7^e étage
Québec (Québec) Canada G1R 5G4
Ligne directe / direct line: (418) 521-3015
Télécopieur / Fax: (418) 521-3099
pparadis@mccarthy.ca



AVOCATS SANS FRONTIÈRES
LAWYERS WITHOUT BORDERS
ABOGADOS SIN FRONTERAS



LAWYERS WITHOUT BORDERS
AVOCATS SANS FRONTIÈRES
ABOGADOS SIN FRONTERAS
Canada

[I will refer to this example as the “old model” of a business card.]

[I will refer to this example as the “old trilingual signature” of ASFQ.]

[With or without the word “Canada”. I will refer to this example as the “new trilingual signature” of ASFQ, which appears to have been adopted in the winter/spring of 2008, according to one of the newsletters in Exhibit “PP-63”.]

[128] Before further discussing the issue of the variation of the Mark, I would like to return to some aspects of Mr. Paradis’s testimony regarding the history of the Mark’s use.

[129] It emerges from Mr. Paradis’s cross-examination that the first meetings to create the ASFQ, as a member of the *Avocats sans frontières* international movement, took place in February 2002 [Paradis transcript, p. 8]. From then until the date of ASFQ’s incorporation on October 23, 2002, the founding members of ASFQ held various meetings, in which they began using the designation “AVOCATS SANS FRONTIÈRES”. Although Mr. Paradis refers to certain exhibits to support his assertions regarding the use of the ASF Marks during the period prior to ASFQ’s incorporation [see in particular Exhibit “PP-42”, including an article in the June 15, 2002 edition of the *Journal du Barreau* titled “*Avocats sans frontières pourrait avoir une antenne au Québec*”; and Exhibit “PP-94”, including the minutes of a public meeting held on August 28, 2002], I find in the evidence no reference to the English version “LAWYERS WITHOUT BORDERS” during this period, but only to the French version “AVOCATS SANS FRONTIÈRES”.

[130] In this regard, it emerges from Mr. Paradis’s cross-examination that ASFQ had conducted some research prior to its incorporation and the selection of the name “LAWYERS WITHOUT BORDERS”. However, it is not clear on reviewing his testimony what type of research it was (for example, if it was simply a registrability search or a more comprehensive availability

search, etc.). In any event, it emerges from Mr. Paradis's testimony that, at the time of ASFQ's incorporation, there was no "LAWYERS WITHOUT BORDERS" trademark registered in Canada, and that ASFQ learned of LWOB in the United States at some point, around either the incorporation of ASFQ or 2003 or 2004 [Paradis transcript, pp. 33–39, and 41–42]. I will return to this point later.

[131] With respect to the incorporation of ASFQ, the excerpt from the Quebec Enterprise Register produced by Mr. Paradis, as Exhibit "PP-1" in support of his affidavit, refers under the heading [TRANSLATION] "Versions of name in another language" to "LAWYERS WITHOUT BORDERS QUÉBEC" as at October 23, 2002. Under [TRANSLATION] "Other names used in Quebec," we also see a certain number of other names (including "LAWYERS WITHOUT BORDERS CANADA"), all with the [TRANSLATION] "date of declaration of the name" indicated as February 17, 2009. According to Mr. Paradis, the date of first use of the Mark claimed as being "at least as early as November 2002" in association with the services (1) identified in this application was chosen conservatively, considering the date of ASFQ's incorporation [Paradis transcript, pp. 69–70].

[132] In Mr. Paradis's cross-examination, several questions focused on the first use of the MARK by ASFQ. In particular, LWOB wanted confirmation from Mr. Paradis that the oldest specimen referring to the words "LAWYERS WITHOUT BORDERS" or the Mark filed in support of his affidavit was a specimen of the first model of Mr. Paradis's personal business card, printed in April 2003, found in Exhibit "PP-75" (reproduced above). Mr. Paradis replied that he could not answer that question, for the following reason:

[TRANSLATION]

[Answer to Q. 82] We have tens of thousands if not hundreds of thousands of usages of our mark in English and French beginning from February 2002 up until today. We produced 10 volumes of written evidence, some of which really come from our archives. And for the purposes of this litigation, we endeavoured to find as many documents as possible from the archives. And I really can't answer whether or not this was the first time it appeared in English, the document you referred.

[...]

Q. 87 For the early years 2003, 2004, 2005, what you found that showed use of "Lawyers Without Borders", will that be in your Affidavit?

A. It's not an easy question to answer. Because as I mentioned earlier, we have hundreds of not thousands of uses of the mark "Avocats sans frontières" [*sic*] in English and in French. I can confirm that from the very first month of activity, we sent written communications, some of which were in French, "Avocats sans frontières..." [*sic*] and others in English, "Lawyers Without Borders...". It's a bilingual country and we were soliciting particular people in Montreal. And the English and French are currently used in the Montreal legal community.

Could we have produced and identify all of those documents, I can't answer that today.

[133] I do not wish to imply here that ASFQ was required to demonstrate use of the Mark in association with all the goods and services covered by this application on the dates of first use claimed in the application. I would simply like to note that my review of all of the exhibits filed by Mr. Paradis in support of his affidavit leads me to conclude that the oldest specimens possibly making any use of the Mark, found in the evidence on record, consist of Mr. Paradis's business card, which he claims was printed in April 2003 [Exhibit "PP-75"], and the membership and donation form [Exhibit "PP-98"], which Mr. Paradis said was [TRANSLATION] "used by [ASFQ] and distributed in Canada since 2003, in English and French", and which includes various statements such as "I wish to become a member of Lawyers without Borders Canada". However, I note that it seems doubtful that the sample form filed as Exhibit "PP-98" corresponds exactly to the one used in 2003, as it contains the new trilingual signature of ASFQ just above the title "Membership and Donation Form" and as Mr. Paradis confirmed during his cross-examination that the name "Lawyers without Borders Canada" was added as [TRANSLATION] "other name" in 2009 [Paradis transcript, p. 36; and Exhibit "PP-1"].

[134] I would also like to note that many of the exhibits filed by Mr. Paradis in support of his affidavit bear only one or the other of the ASF Marks alleged by him, not all of them. For example, I note that the first ASF newsletter in June 2005 filed as Exhibit "PP-61" contained no reference to the Mark (either in word or logo form), from which I understand the different date of first use claimed by ASFQ for the goods covered by this application, compared to that claimed in the registration of the trademark AVOCATS SANS FRONTIÈRES. In this regard, I note that ASFQ itself asserts at paragraph 61 of its written arguments that: [TRANSLATION] "For all [ASFQ] activities listed in the Paradis [a]ffidavit, without exception, [ASFQ] proudly and prominently displays the Mark, either in French (AVOCATS SANS FRONTIÈRES) or in English (LAWYERS WITHOUT BORDERS)." Here again, it must be emphasized that,

although the Mark corresponds to the English version of the trademark AVOCATS SANS FRONTIÈRES, that does not necessarily mean that the use of the French version is the same as use of the Mark. They are two distinct trademarks, although identical in terms of the ideas conveyed. I also disagree with the position expressed by ASFQ at paragraph 48 of its written arguments that [TRANSLATION] “if the Mark was used and was known in French, then it must be concluded that its English version was also used and known, and *vice versa*, given that in both cases the Mark conveys the same concepts [...]” I will return to this later.

[135] Returning to the issue of the variation of the Mark, I find that the use of the Mark with the addition of the word “QUEBEC” or “CANADA”, as applicable, substitutes for the use of the word mark LAWYERS WITHOUT BORDERS, as the descriptive nature of the words “QUEBEC” and “CANADA” serve to indicate the geographic origin of the ASFQ goods and services and do not cause the Mark to lose its identity.

[136] With respect to the use of the Mark as shown in the specimen business card reproduced above, I find that it also substitutes for the use of the nominal mark LAWYERS WITHOUT BORDERS, given the clearly bilingual character of the card in question. Indeed, I find that such use would be seen as a reference, on the one hand, to the mark AVOCATS SANS FRONTIÈRES and, on the other hand, to the mark LAWYERS WITHOUT BORDERS, not a single element consisting of the words “AVOCATS SANS FRONTIÈRES LAWYERS WITHOUT BORDERS” [see by analogy *Kruger Products LP v Cascades Canada ULC*, 2014 TMOB 237].

[137] That being said, I find it hard to apply the same reasoning to the use of the Mark as illustrated in the old and new trilingual signatures of ASFQ as reproduced above. As an argument in support of the position that the new trilingual signature of ASFQ may substitute for use of the Mark, I note the presentation, on three separate lines, of each of the expressions “LAWYERS WITHOUT BORDERS”, “AVOCATS SANS FRONTIÈRES”, and “ABOGADOS SIN FRONTERAS”, with emphasis in bold on the expression “AVOCATS SANS FRONTIÈRES” on the middle line. An argument can be made that such a presentation can be seen as three distinct trademarks—one “main” one, consisting of the French version “AVOCATS SANS FRONTIÈRES”, the other two “secondary” ones consisting of the

translation of the main mark into English and a foreign language (in this case Spanish) set on either side of the main mark—and not necessarily an indication of a single element consisting of a trilingual block with a stylized globe design, together invoking an idea of internationality. However, it is harder to make such an argument in the case of the old trilingual signature, as the mark in that case is on the middle line without any emphasis or distancing to distinguish it from the other elements represented (thus causing the Mark to lose its identity). In any event, I do not find that I need to decide whether the use of the Mark in either of the old and new trilingual ASFQ signatures also substitutes for the use of the Mark since, as shown in my analysis below, it does not change the outcome of this opposition.

[138] Finally, in the final part of his affidavit, Mr. Paradis addresses LWOB's activities. At paragraphs 76 to 80 of his affidavit, he states the following:

[TRANSLATION]

[...] I have extensive knowledge of the [NGO] community working in Canada, or from Canada, in the fields of international cooperation, justice, human rights and the promotion of the rule of law.

To my knowledge, [LWOB] is an American organization based [...] in Connecticut.

At the time of signing this affidavit, I am not aware of any [LWOB] activities in Canada.

On March 25, 2009, at the ASF Ottawa launch cocktail, I met a man named Jerry D. Kovacs. Mr. Kovacs told me that he had been given a mandate by Ms. Christina Storm, then the head of [LWOB], to establish the chapter of [LWOB] in Canada.

Based on that information, I understand that, on March 25, 2009, [LWOB] had no Canadian chapter.

[139] As indicated above (and further explained below), the fact that LWOB had no Canadian chapter is not enough in itself to necessarily challenge or contradict certain assertions by Ms. Storm regarding LWOB's use of the Mark in Canada.

[140] In closing, I would like to return to the circumstances surrounding the moment when ASFQ learned of the existence of LWOB. As indicated above, it is not clear whether ASFQ learned of LWOB when ASFQ was incorporated or in 2003 or 2004. In any event, on reviewing the transcript of Mr. Paradis's cross-examination, it is my understanding that ASFQ apparently learned of LWOB's application for registration of the Mark (resulting in registration

No. TMA631,359, which was ultimately invalidated and expunged) when it was advertised in the *Trademarks Journal* or when it was registered. According to Mr. Paradis:

[TRANSLATION]

[Answer to Q. 58]: The first actual time that we had dealings with [LWOB] is when we learned through one of the members of our Executive Committee [...] because he gets a regular newsletter mentioning the creation of marks and trade names. He sent us a notice of the application by [LWOB], of their application for a [...] We were stupefied. We were very stupefied because we didn't know how they could make this application without realizing that we already had these marks and trade names. We had a great deal of difficulty understanding an American organization would what to take it away and register this mark in Canada. Because please understand in our field, this way that [LWOB] was managing its trade names is quite unique [...] it is very unique for some organisation come say: "Even if there is another organisation already engaged in these activities in a given country, we're going to go and register our [...] and we're going to say that we are the international movement." This didn't lend itself through a friendly exchange of greetings. But in the ensuing years we did exchange communications. Because the President, especially because the President of [LWOB] [...] took part in an international observation mission that we were financing and organising in Columbia. [*sic*] That's when we began to talk together. If we could come to this settlement of the question of trade name and mark and this was because without that, this was prejudicial to our relations or cooperation.

Q. 59: Okay. That was a long answer [...] When you [ASFQ], found out about [LWOB] you did not contact them to find out if they had Canadian activities? Is that right?

R. Yes.

Q. 60: Did you visit their website when you find out about them?

R. Yes.

Q. 61: Did you look for Canadian activities?

R. Yes. And we didn't find any.

Q. 62: Did you contact lawyers in Canada for example, universities, any universities to find out whether [LWOB] was working with them?

R. Yes. And you will find the affidavit from the President at the time of the [CBA] and of the current... an affidavit of the current President of the [CBA]. And with all our partners in the area of legal affairs, human rights and international cooperation they all repeated the same thing. "Your client [LWOB] is unknown."

[141] Also under cross-examination by LWOB to find out why ASFQ had not filed its applications for the ASF Marks earlier (i.e. when its activities first started in Canada), Mr. Paradis explained that it was because ASFQ did not have [TRANSLATION] "a lot of time" or money and [TRANSLATION] "resources" to do so [Paradis transcript, pp. 66–68]. It also emerges

from Mr. Paradis's cross-examination that ASFQ did not think at the time that another entity could try to register such trademarks in Canada, or that ASFQ would try to register the ASF Marks outside Canada:

[TRANSLATION]

[Answer to Q. 70]: [...] given the field that we're working in, international solidarity, human rights, I could never imagine somebody else would come and register a trade name.

[Answer to Q. 229]: And again, as I mentioned earlier, and I think this is very important in this case, this is not a usual practice in our field. I think of Dentists Without Borders USA, UK, France will not try to register a mark in Canada or Belgium or Switzerland. That's not the way we operate. We're not going to come into another country saying: "We are the Lawyers Without Borders, Avocats sans frontières." That's why we don't register trademarks in other countries. As I mention in the [a]ffidavit, we're part of a movement with national branches, which has national branches in other countries. Several of whom have their own trademarks in their own countries. There's a trademark in France which is "Avocats sans frontières France". Avocats sans frontières in Brussels has its trademarks in Belgium, and European, I think [...]

[Emphasis added]

[142] As with the Potter and Headon affidavits, I find that these assertions by Mr. Paradis are not enough in themselves to necessarily question or contradict some of the assertions by Ms. Storm regarding LWOB's use of the Mark in Canada. At most for ASFQ, I find that such assertions are instead related to the extent to which the Mark has become known in Canada or the reputation acquired by LWOB. On this, I would add that I give no weight to the gratuitous allegations by Mr. Paradis regarding the alleged practices of other entities in the *Avocats sans frontières* movement in terms of registering trademarks.

III.3.4 Did LWOB meet its initial evidentiary burden?

[143] I find that the answer to this question must be yes for the following reasons.

[144] First, regarding the fact that LWOB has never had a Canadian chapter or real establishment in Canada, it is well established by jurisprudence that this cannot prevent the owner of a given trademark from offering or providing services in Canada.

[145] Indeed, as noted by the Registrar in *Norman M. Cameron Law Corporation v CMS Cameron McKenna LLP*, 2009 CanLII 82159 (TMOB), section 4(2) of the Act does not impose such a burden to demonstrate the use of a given trademark in association with services. As indicated above, once the trademark has been used in the advertisement of such services and its owner is prepared to offer them in Canada, that is enough to meet the requirements of section 4(2) of the Act [see in particular *Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) (TMOB); and other jurisprudence cited in *Hilton Worldwide Holding LLP v Miller Thomson, supra*, including the “evolution” of the concept of use in association with services, along with “the expansion of the delivery of services offered ‘online’”].

[146] Secondly, with respect to the nature of the goods and services in association with which I am satisfied that prior use of the Mark by LWOB in Canada and the non-abandonment of it was demonstrated on the relevant dates for the purpose of assessing this ground of opposition, I find that they consist, at a minimum, of “linkage” services and newsletters.

[147] I take from my review of all of LWOB’s evidence that, since at least 2001, one of its objectives was to provide Canadian legal communities, particularly lawyers and law students, with resources to connect with the international community of volunteers in the legal sector and various volunteer organizations. In this regard, I find that LWOB’s goods and services are similar to those of an association intended to provide its members with various resources, as is seen from certain excerpts from various brochures, newsletters, and descriptions on the LWOB website, reproduced above in my detailed review of LWOB’s evidence.

[148] As explained by Ms. Storm, and corroborated by various exhibits filed in support of her affidavit, individuals from Canada wanted to join LWOB as early as 2001, by registering as a “member” on the LWOB Listserv, sending it their résumés and even, for some, paying the fees that LWOB charged at the time to be registered in its volunteer database or to have access to their “opportunities board”. Moreover, with respect to that opportunities board, were it not for the fact that I could not identify examples in the evidence to show how the Mark was actually used in advertising or delivering such a service at the time of its implementation, I would also have concluded that there was previous use and non-abandonment of the Mark in association with such a service at the relevant dates for the propose of assessing this ground of opposition.

[149] Returning to the “linkage” services, I take from my review of the evidence, including the Taylor affidavit and its attachments, that it was LWOB, in 2001, that connected PBSC with the NGO *Kosovo Criminal Defense Resource Centre*. At the time, PBSC was looking for opportunities for its students interested in taking part in projects focusing on the rule of law and contacted LWOB through its website. A “partnership” was then developed between PBSC and LWOB, as described by Mr. Taylor. In this regard, I find that PBSC, as a Canadian organization, directly benefited from a service from LWOB. That LWOB acted as an intermediary or “link” between PBSC and that NGO, from the United States, does not change the fact that PBSC benefited, in Canada, from an LWOB service, although it could not necessarily be described as “legal services”. It must be recalled here that Mr. Taylor was not cross-examined on his affidavit, which was also not included in the evidence filed by LWOB in the proceedings that led to the Invalidating Judgment.

[150] Again regarding the “linkage” services, I take from my review of the evidence that at least two Canadian NGOs (namely RESPECT in 2004 and MBAs Without Borders) in 2006) used LWOB’s referral services (and completed the LWOB’s intake form) to try to find a volunteer Canadian lawyer, and that such “linkage” was successful for one of them. Although there are few concrete examples of “linkage” services provided by Ms. Storm, I find that it cannot be reasonably concluded from the evidence on record that LWOB had ceased providing such services in Canada (although not necessarily finding any takers), let alone that it had intended to abandon the Mark in association with such services at the date of the announcement of this application, on June 26, 2013. Indeed, I note that the page visit statistics for the LWOB website provided by Ms. Storm in Exhibit “N” of her affidavit for 2009/10 refer to the “intake form” pages. While these statistics are not broken down by country, the fact remains that they show the presence of that form on the LWOB website, for which there are other statistics showing visits from Canada. Moreover, in the October 18, 2014 email exchange in Exhibit “HH” filed in support of Ms. Storm’s affidavit, she specifically refers to the LWOB intake form: “We can send you an intake form to fill out – and ‘shop’ your request to various Canadian firms in an effort to recruit one to take you on as a pro bono client [...]” Although that email exchange was after June 26, 2013, I find that it supports a certain continuity in the offer of services by LWOB or, at the very least, that LWOB could not have intended to abandon the Mark in association with such a “linkage” service some 16 months earlier.

[151] With respect to the newsletters, I take from my review of the evidence that such newsletters displaying the Mark have been published since at least April 2002. More specifically, with respect to the April 2002 “BorderLines” paper newsletter in Exhibit “B” filed in support of Ms. Storm’s affidavit, given LWOB’s lobbying and recruitment efforts with, among others, McGill University and the University of Toronto in 2002 and 2003, I see no reason not to have faith in Ms. Storm’s assertions that such a paper newsletter was, in fact, distributed in Canada to lawyers, law firms, university students, etc. This is particularly true given that such newsletters also resemble a marketing and/or recruitment tool. Here again, page visit statistics for the LWOB website in Exhibit “N” also refer to the pages of the digital version of the “Newsletter”.

[152] Returning to all the statistics in Exhibit “N”, I note that it would have been preferable for them to go beyond 2010. It seems that, essentially, Ms. Storm has, on this point, in fact merely repeated the statistics provided in her affidavit of August 13, 2010 [Exhibit “CS-A”] in the proceedings leading to the Invalidating Judgment. Nevertheless, considering Ms. Storm’s testimony as a whole, including the print-out of the homepage of the LWOB website dated October 20, 2014, attached to her affidavit as Exhibit “EE”, still including hyperlinks to the “NGOs” and “BorderBriefs” sections, among others, I have no reason to not have faith in her assertions that the digital newsletter and intake form still existed when her affidavit was signed.

[153] If I err in concluding this, I find that I still cannot conclude, under the circumstances of this case, that LWOB intended to abandon the mark on June 26, 2013 [see *Iwaski Electric Co Ltd v Hortilux Schreder B.V.*, *supra*]. Indeed, if I were to conclude that there was a period of non-use since 2010, I find that such a period is not enough to conclude that LWOB intended to abandon the mark as of June 26, 2013, given the information provided by Ms. Storm regarding LWOB’s social media presence and the fact that LWOB still has Canadian volunteers interested in benefiting from various work experiences.

III.3.5 Analysis of the likelihood of confusion

[154] The test for confusion is one of first impression and imperfect recollection. According to section 6(2) of the Act, the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, or hired or that the

services associated with those trademarks are hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[155] In determining whether trademarks create confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time the trademarks have been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them. This list is not comprehensive and a different weight may be given to each of these factors based on the context [see *Mattel, Inc v 3894207 Canada Inc* (2006), 2006 SCC 22, 49 CPR (4th) 321; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 2006 SCC 23, 49 CPR (4th) 401; and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 2011 SCC 27, 92 CPR (4th) 361, for a more thorough discussion of the general principles that govern the test for confusion].

[156] In light of my detailed analysis above of the evidence from the parties, I find that I do not need to discuss at length all these factors to conclude that there is a likelihood of confusion in this case. Although the inherent distinctiveness of the Mark is very low (in this regard, I find that it cannot be concluded that the distinctiveness of the Mark was significantly increased by use of the Mark on the dates of first use alleged in this application), the fact is that we have two identical word trademarks and that there is direct overlap between the parties' goods and services.

III.3.6 Conclusion

[157] In view of the foregoing, I maintain the ground of opposition based on section 16(1)(a) of the Act.

[158] Before turning to the ground of opposition based on the non-distinctiveness of the Mark, I would like to briefly discuss an argument put forth by ASFQ that [TRANSLATION] “it would be absurd for [ASFQ] to not be able to obtain the registration of the English version of the Mark when it is the registered owner of the French version.”

[159] As noted above, the fact that the Mark corresponds to the English version of the trademark AVOCATS SANS FRONTIÈRES does not change the fact that they are two distinct trademarks. Furthermore, it is well established that section 19 of the Act does not confer on the owner of a registration the right to automatically obtain registration of other trademarks, even those closely linked to the mark covered in the initial registration [*Groupe Lavo v Proctor & Gamble Inc* (1990), 32 CPR (3d) 533 (TMOB); *Coronet-Werke Heinrich Schlerf GmbH v Produits Ménagers Coronet Inc* (1984), 4 CPR (3d) 108 (TMOB); *American Cyanamid Co v Stanley Pharmaceuticals Ltd* (1996), 74 CPR 571 (TMOB); and *385229 Ontario Limited v ServiceMaster Company*, 2012 TMOB 59]. I must decide this ground of opposition based on the specific facts of the case. In this regard, I note that this ground of opposition is related not to ASFQ's right to use the Mark in Canada, but ASFQ's right to register it.

III.4 Ground of opposition based on non-distinctiveness under section 2 of the Act

[160] It is appropriate here to cite the ground of opposition argued by LWOB in its entirety:

The [Mark] is not distinctive within the meaning of section 2 of the Act. The [Mark] is not adapted to distinguish nor capable of distinguishing the wares and services in association with which it will be used from the wares and services used in association with [LWOB's] Mark as outlined in the previous [section 16(1)(a) ground of opposition]. On the contrary, the [Mark] and its use by [ASFQ] is calculated to give rise to confusion, and to enable the Applicant to benefit from and trade-off the goodwill of [LWOB's] Mark.

[161] To meet its initial evidentiary burden on this ground, LWOB had to demonstrate that, at the date on which the statement of opposition was filed, November 26, 2013, its trademark LAWYERS WITHOUT BORDERS had become known sufficiently to negate the distinctiveness of ASFQ's identical trademark [*Motel 6, Inc v No. 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International, LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427 (FC)].

[162] In this case, although I concluded that LWOB had previously used the Mark and had not abandoned it at the relevant dates for assessment of the ground of opposition under section 16(1)(a) of the Act, I find that the evidence on record does not allow me to conclude that, at the relevant date for assessment of this ground of opposition, it had become known at least enough to negate the distinctiveness of the ASFQ Mark.

[163] Indeed, as seen in my analysis above, the evidence of use of the Mark in Canada filed by LWOB remains very slight. Moreover, none of the statistical data regarding hits on the LWOB website are related to the relevant date for assessing this ground of opposition. Under the circumstances, I find LWOB's evidence insufficient to allow me to conclude that it had become known at least enough to negate the distinctiveness of the ASFQ Mark.

[164] I therefore find that LWOB did not meet its initial evidentiary burden regarding this ground of opposition and it is therefore dismissed.

IV. DECISION

[165] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

Annie Robitaille
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Certified translation

Gerald Woodard

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2020-01-21

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FOR THE APPLICANT