

Federal Court



Cour fédérale

Date: 20150922

Docket: T-155-15

Vancouver, British Columbia, September 22, 2015

PRESENT: The Honourable Mr. Justice Annis

BETWEEN:

RE/MAX, LLC

Plaintiff

and

**PM BRANDING CORP. DOING BUSINESS AS
PM BRAND LTD. AND SOMETIMES DOING
BUSINESS AS PROMO MEDIA AND
PROMOMEDIAUSA**

Defendant

JUDGMENT

UPON MOTION in writing dated September 3, 2015 on behalf of the Plaintiff for:

- (a) An order pursuant to Rule 210 of the *Federal Courts Rules* for Default Judgment against the Defendant, PM Branding Corp. Doing business as PmBrand Ltd. and sometimes doing business as Promo Media and PromoMediaUSA (“PM Branding” or the “Defendant”), in the terms of the draft Judgment attached hereto as Schedule “A”; and
- (b) Such further and other relief which to this Honourable Court may deem just;

AND UPON reviewing the material filed;

THE COURT'S JUDGMENT is that:

1. The Plaintiff, RE/MAX, LLC, is the owner in Canada of the trade-marks listed in Schedule A hereto (the "RE/MAX Trademarks") and the corresponding trademark registrations also listed in Schedule A; said registrations are valid; and the RE/MAX Trade-marks have been infringed by the Defendant, contrary to section 20 of the *Trade-marks Act*.
2. At a minimum, the Defendant has used the trademarks RE/MAX and REMAX, the following RE/MAX design trademark:

RE/MAX

and the following design trademarks, each of which incorporate a red, white and blue colour claim:



in a manner likely to have the effect of depreciating the value of the goodwill attaching thereto.

3. The Defendant has directed public attention to its services and business in such a way as to cause or to be likely to cause confusion in Canada between the Defendant's

services and business and the services and business of the Plaintiff, contrary to section 7(b) of the *Trade-marks Act*.

4. The Defendant has passed off its services as and for those of the Plaintiff, contrary to section 7(c) of the *Trade-marks Act*.

5. The Defendant has used, in association with promotional products and related design, printing and manufacturing services, a description which is false in a material respect and which is of such a nature as to mislead the public as regards to the character, quality and/or composition of such goods and services, and the mode of manufacturing and production of such goods and the mode of performance of such services, contrary to section 7(d) of the *Trade-marks Act*.

6. The Plaintiff, RE/MAX, LLC, is the owner of copyright in and to its famous balloon designs, including Canadian copyright registration nos. 1,057,202 and 1,057,203, copies of which are depicted as follows:



(the “Balloon Copyrights”) and such registrations are valid.

7. The Defendant has infringed the Plaintiff’s copyright in and to the Balloon Copyrights, contrary to ss. 3 and 27 of the *Copyright Act*.

8. The Defendant, by itself and by its servants, workmen, agents and employees, is permanently restrained and enjoined from, directly or indirectly:

- (i) using or further infringing the RE/MAX Trademarks;
- (ii) using the RE/MAX Trademarks, any words, or combination of words, or any other design, likely to be confusing with the RE/MAX Trademarks, as or in a trade-mark or trade-name, or for any other purpose;
- (iii) depreciating the value of the goodwill attaching to the RE/MAX Trademarks;
- (iv) directing public attention to any of the Defendant's goods, services or business in such a way as to cause or to be likely to cause confusion between the goods, services and business of the Defendant and the goods, services and business of the Plaintiff;
- (v) passing off the Defendant's goods and services as and for those of the Plaintiff;
- (vi) using a material description that is false and misleading to the public, or making false or misleading material representations to the public, in promoting either the supply or use of the goods and business interest, through suggesting an association to, or authorization of, the Plaintiff; and
- (vii) infringing the Plaintiff's copyright in and to the Balloon Copyrights.

9. The Defendant shall pay forthwith to the Plaintiff the amount of \$159,000.00, as damages for its breaches of the Plaintiff's trade-marks rights.

10. The Defendant shall pay forthwith to the Plaintiff the amount of \$40,000.00, as statutory damages for its breaches of the Plaintiff's copyrights.

11. The Defendant shall pay forthwith to the Plaintiff the amount of \$15,000.00, as punitive and exemplary damages.

12. The Defendant shall pay forthwith to the Plaintiff lump sum costs of these proceedings in the amount of \$4929.75, inclusive of disbursements.

13. The Defendant shall pay to the Plaintiff post-judgment interest in the amounts awarded in paragraphs 9, 10, 11 and 12, calculated from the date of this Judgment at the current rate of 2.85% and at future rates determined according to the *British Columbia Court Order Interest Act*, RSBC 1996, c.79, Part 2.

14. Within twenty-one (21) days of the Judgment, the Defendant shall, at its own expense:

- (i) remove from any websites in the Defendant's control, including but not limited to <pmbrand.com> and <pmbranding.com>, any and all use of the RE/MAX Trademarks and Balloon Copyrights or other images or trademark or trade name use that is contrary to paragraph 8 to this Order; and

(ii) deliver up to the Plaintiff all articles, including all packaging, stationary, advertising or other material, in its possession, custody or power which are contrary to paragraph 8 to this Order.

15. Within twenty-one (21) days of the Judgment, the Defendant shall execute any and all necessary documents and take whatever other steps are necessary to transfer to the Plaintiff the registration of the Internet domain names <balloonbrand.com> and <balloonbrandusa.com>, and any other domain names owed by the Defendant which use the trademarks REMAX, RE/MAX or any other name that would be likely to suggest a business connection with the Plaintiff.



"Peter Annis"





Judge



Schedule A to Judgment of the Federal Court dated September 22, 2015

T-155-15

	Trade-mark	Registration No.
RE/MAX	RE/MAX	TMA237,425
RE/MAX	RE/MAX	TMA717,562
RE/MAX	RE/MAX	TMA717,564
REMAX	REMAX	TMA575,047
RE/MAX	RE/MAX	TMA840,379
	RE/MAX DESIGN	TMA575,098
	RE/MAX & DESIGN (with red, white and blue colour claim)	TMA275,957

	Trade-mark	Registration No.
	RE/MAX & BALLOON DESIGN (with red, white and blue colour claim)	TMA717,554
	RE/MAX & BALLOON DESIGN (with red, white and blue colour claim)	TMA723,971
	RE/MAX & DESIGN (with red, white and blue colour claim)	TMA246,245
	RE/MAX COMMERCIAL & Design (with red, white and blue colour claim)	TMA771,851