

Federal Court



Cour fédérale

Date: 20230424

Docket: T-969-21

Citation: 2023 FC 581

Ottawa, Ontario, April 24, 2023

PRESENT: THE CHIEF JUSTICE

BETWEEN:

TECHNO-PIEUX INC.

Plaintiff

and

**TECHNO PILES INC., TECHNO METAL POST MEDECINE HAT INC.,
TECHNO METAL POST FORT MCMURRAY INC.,
MATHIEU BERGEVIN, AND RONDA BERTRAM**

Defendants

ORDER AND REASONS

Table of Contents

I.	Introduction.....	1
II.	The Parties and Their Disputed Marks/Copyrighted Works.....	2
A.	Techno-Pieux	2
B.	The Defendants	4
III.	Procedural Background.....	5
IV.	Factual Background	6
V.	Issues.....	8
VI.	Analysis.....	8
A.	Trademark Infringement	8
(1)	Introduction and Applicable Legal Principles	9
(2)	Degree of resemblance (s. 6(5)(e)).....	14
(3)	The inherent distinctiveness of the trademarks or trade names and the extent to which they have become known (s. 6(5)(a))	15
(4)	The length of time the trademarks or trade names have been in use (s. 6(5)(b))	17
(5)	The nature of the goods, services or business (s. 6(5)(c))	18
(6)	The nature of the trade (s. 6(5)(d))	20
(7)	Additional relevant surrounding circumstances	30
(8)	Summary and conclusion regarding confusion and the alleged deemed infringement	32
B.	Depreciation of Goodwill.....	33
(1)	Introduction	33
(2)	The first two elements of the test.....	35
(3)	The third element of the test.....	37
(4)	The fourth element of the test.....	38
(5)	Conclusion regarding depreciation of goodwill	41
C.	Passing Off	41
D.	Copyright Infringement.....	45
(1)	Applicable legal principles	45
(2)	Assessment	47
E.	Personal Liability of the Individual Defendants	56
(1)	Applicable principles and introduction.....	56
(2)	The Parties' positions	58
(3)	Assessment	60

F. Techno Piles Inc.....	62
VII. Remedies.....	64
A. Declaratory, Injunctive and Mandatory Relief.....	64
B. Damages.....	65
(1) Trademark infringement.....	66
(2) Copyright infringement.....	72
(3) Summary.....	76
VIII. Costs.....	76
APPENDIX 2: RELEVANT STATUTORY PROVISIONS	81

I. Introduction

[1] In this Motion for summary trial, the Plaintiff, Techno-Pieux Inc. [**Techno-Pieux**], seeks a broad range of declaratory, injunctive, and mandatory relief against the Defendants in relation to alleged infringements of the Plaintiff's trademark rights and copyright. The Plaintiff also seeks \$40,000 in damages.

[2] Regarding declaratory relief, the Plaintiff seeks declarations that the Defendants have:

- infringed and are deemed to infringe its rights in the Registered Marks, as defined below, contrary to sections 19 and 20 of the *Trademarks Act*, RSC 1985, c T-13 (the "*TM Act*");
- used the Registered Marks in a manner likely to have the effect of depreciating the value of the goodwill attached thereto, contrary to section 22 of the *TM Act*;
- directed attention to their goods, services and business in such a way as to cause or be likely to cause confusion in Canada between the Defendants' goods, services and business and those of the Plaintiff, contrary to paragraph 7(b) of the *TM Act*;

- infringed and are deemed to have infringed the Plaintiff's Copyrighted Works, as defined below, contrary to sections 3 and 27 of the *Copyright Act*, RSC 1985, c C-42.

[3] For the reasons set forth below, I find that the corporate Defendants are deemed to have infringed the Plaintiff's rights in the Registered Marks, contrary to paragraph 20(1)(a) of the *TM Act*. I also find that those Defendants have contravened section 22 and paragraph 7(1)(b) of the *TM Act*. In addition, I find that those Defendants have infringed certain of the Plaintiff's Copyrighted Works. Accordingly, I will grant the declaratory, injunctive, and mandatory relief sought by the Plaintiff, except in relation to one of the Plaintiff's Copyrighted Works, which I find has not been infringed. I will also order the corporate Defendants to pay \$30,000 in damages.

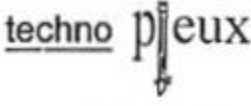

II. The Parties and Their Disputed Marks/Copyrighted Works

A. *Techno-Pieux*

[4] Techno-Pieux is a Quebec-based supplier of helical piles and associated materials and machinery for residential and industrial applications. It markets and sells its products throughout Canada and abroad.

[5] Techno-Pieux is the owner of the following registered Canadian Trademarks [the **Registered Marks**]:

Table 1 – The Plaintiff’s Trademarks

<u>Registration Number</u>	<u>Registration Date</u>	<u>Trademark</u>
TMA562798	May 29, 2002	
TMA596228	December 2, 2003	TECHNO METAL POST
TMA638884	May 3, 2005	
TMA950281	September 23, 2016	TECHNO PIEUX

[6] The first three of the above-mentioned marks are registered in respect of the following goods and services (the “**Relevant Goods and Services**”): (i) goods – foundations pillars, foundations posts, foundations stake, foundations piles; and instruments to determine the load-bearing capacity of foundations footings and piles; (ii) services – engineering services in the design of foundations and performance of test for foundations.

[7] The fourth mark in Table 1, “TECHNO PIEUX,” is registered for the same services as the first three, but for goods that are very different and not within the purview of the parties’ dispute. Accordingly, this fourth mark will not be further discussed in respect of the Relevant Goods and Services.

[8] The Plaintiff also asserts copyright in the Techno-Pieux logo (TMA562798), the Techno Metal Post logo (TMA638884), and the following post design [collectively, the **Copyrighted Works**]:



[9] Through its network of licensees and distributors, Techno-Pieux has offered its goods and services in association with the trade names “Techno Pieux” and “Techno Metal Post” and the Registered Marks since at least 2002.

[10] In Alberta, Techno-Pieux operates through its affiliate Techno Metal Post Alberta Inc., which sells its goods and services to licensees and distributors in that province.

B. *The Defendants*

[11] Techno Metal Post Medicine Hat Inc. [**TMP Medicine Hat**] is an Alberta-based company that began distributing the Plaintiff’s goods and services soon after its incorporation in the fall of 2015, pursuant to a Distributorship and Procurement Agreement, dated October 9, 2015. At that time, TMP Medicine Hat was owned and operated by Rosaire Belisle. However, in the fall of 2018, it was sold to the two individual Defendants, Mr. Bergevin and Ms. Bertram (the “**Individual Defendants**”). Since that time, they have owned and operated that entity, as the sole

shareholders, directors, executives, and employees (with one unimportant exception), although they also work with independent contractors.

[12] Techno Metal Post Fort McMurray Inc. [**TMP Fort McMurray**] is an Alberta-based company that began distributing the Plaintiff's goods and services soon after the latter's incorporation in late 2016, pursuant to a Distributorship and Procurement Agreement dated November 28, 2016. From the outset, TMP Fort McMurray has been owned and operated by Mr. Bergevin and Ms. Bertram, who have also been the sole shareholders, directors, executives, and employees (with one unimportant exception). As with TMP Medicine Hat, it works with independent contractors.

[13] TMP Fort McMurray and TMP Medicine Hat are collectively referred to below as the **"Principal Corporate Defendants."**

[14] Techno Piles Inc. is an Alberta-based entity that was incorporated in January 2020. According to the Defendants, it has not yet operated in any meaningful manner. However, it was used to register the domain name <http://www.technopilesinc.com>, which is linked to email accounts and a website used by some or all of the Defendants.

III. Procedural Background

[15] This Motion for summary trial was filed after I dismissed the Parties' respective Motions for summary judgment in May of last year: *Techno-Pieux Inc v Techno Pile Inc*, 2022 FC 721 (the **"Summary Judgment Decision"**).

[16] In the Summary Judgment Decision, I found in favour of the Plaintiff with respect to four of the five specific factors that must be considered pursuant section 6(5) of the *TM Act*, in considering whether the disputed trademarks or trade names are confusing. Indeed, I found that the Plaintiff had established that there was no genuine issue for trial in respect of those four factors. However, given my inability to reach a similar conclusion with respect to the fifth factor (the “nature of the trade”), as well as “all of the surrounding circumstances” mentioned in section 6(5), I considered it appropriate to order a summary trial.

[17] I reached the same conclusion with respect to the other issues in the underlying action in this proceeding, namely, the Plaintiff’s allegations concerning depreciation of goodwill contrary to section 22 of the *TM Act*, passing off contrary to sections 7(b) and 7(d) of the *TM Act*, copyright infringement, the liability of the Individual Defendants, and the liability of Techno Piles Inc. Likewise, my order for a summary trial also applied to the Defendants’ counterclaims.

[18] In the intervening period, the Plaintiff’s claim pursuant to section 7(d) of the *TM Act*, together with the Defendants’ counterclaims, have been discontinued.¹

[19] The Parties agree that a summary trial is the appropriate manner in which to resolve the Plaintiff’s claims.

IV. Factual Background

¹ In its Statement of Claim, the Plaintiff also sought declarations in relation to section 7(c) of the *TM Act* and section 52 of the *Competition Act*. However, those claims were abandoned prior to its Motion for summary judgment.

[20] The relevant factual background to this proceeding is summarized in the following passage of the Summary Motion Decision:

[16] The relationship between the parties took a significant turn for the worse in June 2020, when the Plaintiff wrote to Mr. Bergevin to summarize various difficulties that had arisen in their dealings. At that time, the Plaintiff informed Mr. Bergevin that it had decided that it was impossible to continue working with him and that, therefore, its distribution agreements with TMP Medicine Hat and TMP Fort McMurray [together, the **Disputed Distribution Agreements**] would be terminated in December of that year.

[17] In February 2021, the Plaintiff sent another letter to Mr. Bergevin to provide notice of the termination of the Disputed Distribution Agreements, effective August 16, 2021.

[18] After further correspondence between the parties, the Plaintiff advised Mr. Bergevin on May 20, 2021 that such termination would be effective at the end of that month.

[19] On May 30, 2021, TMP Medicine Hat and TMP Fort McMurray [the “**Principal Corporate Defendants**”] announced a “rebranding”. Among other things, that announcement stated: “[W]e are shutting down our Techno Metal Post Fort McMurray and Medicine Hat email and moving everything over to Techno Piles Inc. Our personal emails and info email will no longer be valid after today.” After listing the new email addresses, the announcement stated, “We still have our same great companies only the name is changing.” It appears to be common ground between the parties that the Principal Corporate Defendants have been using the trade names TECHNO PILES MEDICINE HAT and TECHNO PILES FORT MCMURRAY, respectively, as well as TECHNO PILES (Corporate Registration #TN23307416 and #TN23307374, respectively) since approximately that time.

[19] In June 2021, the Plaintiff initiated an action for breach of contract in the Court of Queen’s Bench of Alberta [the **Alberta Action**], followed by its underlying action in the present proceeding.

[20] In the Alberta Action, the Defendants maintain that the Plaintiff had no right to terminate the Disputed Distribution Agreements and that therefore those agreements remain in force.

V. Issues

[21] The issues to be determined on this Motion are as follows:

- A. Have the Defendants infringed, or are they deemed to have infringed, the Registered Marks, contrary to sections 19 and 20 of the *TM Act*?
- B. Have the Defendants used the Registered Marks in a manner that is likely to have the effect of depreciating the value of the goodwill attached thereto, contrary to section 22 of the *TM Act*?
- C. Have the Defendants directed attention to their goods, services and business in such a way as to cause or be likely to cause confusion in Canada between their goods, services and business and those of the Plaintiff, contrary to section 7(b) of the *TM Act*?
- D. Have the Defendants infringed upon the Copyrighted Works, contrary to sections 3 and 27 of the *Copyright Act*?
- E. Are the Individual Defendants, Mathieu Bergevin and Ronda Bertram, liable?
- F. Is the corporate defendant Techno Piles Inc. liable?
- G. What, if any, relief is appropriate?

VI. Analysis

A. *Trademark Infringement*

(1) Introduction and Applicable Legal Principles

[22] As noted above, the Plaintiff seeks declarations with respect to both section 19 and section 20 of the *TM Act*. However, the Plaintiff's written submissions focus on its allegation that the TECHNO PILES/Techno Piles trademarks/trade names are confusingly similar to the Registered Marks, as contemplated by section 20(1)(a). The Plaintiff has not alleged that those trademarks/trade names are identical to the Registered Marks, as required by section 19: *Sandhu Singh Hamdard Trust v Navsun Holdings Ltd*, 2019 FCA 295 at para 20 [*Sandhu*].

Consequently, the focus of the discussion below will be on section 20(1)(a).² The full text of section 20(1)(a) and the other provisions discussed below is set forth in Appendix 2 below.

[23] In the Summary Judgment Decision, I described the legal principles applicable to an assessment of trademark infringement as follows:

[42] Paragraph 20(1)(a) deems the exclusive right to use a registered trademark throughout Canada to be infringed by any person who is not entitled to use that trademark and who sells, distributes or advertises any goods or services in association with a *confusing* trademark or trade name.

[43] In considering whether a trademark or trade name is confusing, section 6 of the legislation provides some important parameters. In particular, subsection 6(2) states as follows:

**Confusion – trademark
with other trademark**

6 (2) The use of a trademark causes confusion with another trademark if the use

**Marque de commerce
créant de la confusion
avec une autre**

6 (2) L'emploi d'une marque de commerce crée de la confusion avec une autre

² Section 19 remains relevant to this Motion because it provides the Plaintiff with the exclusive right to use the Registered Trademarks throughout Canada, in respect of the goods and services described in the trademark registration.

<p>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, 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.</p>	<p>marque de commerce lorsque l'emploi des deux marques de commerce dans la même région serait susceptible de faire conclure que les produits liés à ces marques de commerce sont fabriqués, vendus, donnés à bail ou loués, ou que les services liés à ces marques sont loués ou exécutés, par la même personne, que ces produits ou services soient ou non de la même catégorie générale ou figurent ou non dans la même classe de la classification de Nice.</p>
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[44] Subsection 6(3) articulates essentially the same test with respect to confusion caused by the use of a trademark, relative to an existing trade name. The same is true regarding subsection 6(4), albeit in relation to the confusion caused by the use of a trade name, relative to an existing trademark.

[45] The factors to be assessed in determining whether trademarks or trade names are confusing are set forth in subsection 6(5), which states as follows:

What to be considered

Éléments d'appréciation

6 (5) In determining whether trademarks or trade names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including

6 (5) En décidant si des marques de commerce ou des noms commerciaux créent de la confusion, le tribunal ou le registraire, selon le cas, tient compte de toutes les circonstances de l'espèce, y compris :

(a) the inherent distinctiveness of the trademarks or trade names and the extent to which they have become known;

a) le caractère distinctif inhérent des marques de commerce ou noms commerciaux, et la mesure dans laquelle ils sont devenus connus;

(b) the length of time the trademarks or trade names have been in use;	b) la période pendant laquelle les marques de commerce ou noms commerciaux ont été en usage;
(c) the nature of the goods, services or business;	c) le genre de produits, services ou entreprises;
(d) the nature of the trade; and	d) la nature du commerce;
(e) the degree of resemblance between the trademarks or trade names, including in appearance or sound or in the ideas suggested by them.	e) le degré de ressemblance entre les marques de commerce ou les noms commerciaux, notamment dans la présentation ou le son, ou dans les idées qu'ils suggèrent.

[46] Some of the foregoing factors may not be particularly relevant in a specific case. In any event, their weight will vary with “all the surrounding circumstances”: *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 27 [*Veuve Clicquot*].

[47] In considering the relevant factors and the other surrounding circumstances, the Court’s perspective must be that of a casual consumer, somewhat in a hurry. More specifically:

The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the name [TECHNO PILES on the Defendants’] storefront or invoice, at a time when he or she has no more than an imperfect recollection of the [Techno-Pieux/Techno Metal Post] trademarks, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

Veuve Clicquot, above, at para 20.

[48] Stated differently, the issue to be determined is whether, as a matter of first impression, the “casual consumer somewhat in a hurry” who sees the TECHNO PILES tradenames/marks would likely be confused. In making this determination, it should be assumed that the consumer in question has the additional attributes

described in the passage quoted immediately above: see also *Masterpiece Inc. v Alavida Lifestyles Inc.*, 2011 SCC 27 at paras 40–41 [*Masterpiece*].

[49] For greater certainty, the relevant consumer is the consumer in the market in question. Where, as in the present case, the goods and services are expensive or important, the Court must be alive to the possibility that the relevant consumer may “be somewhat more alert and aware of” the defendant’s marks: *Masterpiece*, above, at paras 69–70. Nevertheless, that consumer must still be considered to have the attributes described in the two immediately preceding paragraphs. The fact that they may be likely to engage in subsequent careful research and deliberation to dispel any confusion that may have arisen on first impression is not germane: *Masterpiece*, above, at paras 72–73.

[50] The relevant confusion is with respect to the *source* of the goods in question, rather than with respect to the trademarks, trade names, or goods that are being used in association with the trademark(s) being asserted: *Masterpiece*, above, at paras 41, 67, 73 and 104–105.

[51] The evidentiary burden is upon the Plaintiff to establish a likelihood – rather than a mere possibility – of confusion, on a balance of probabilities: *Loblaws Inc. v Columbia Insurance Company*, 2019 FC 961 at para 44 [*Loblaws*], aff’d 2021 FCA 29; *Toys “R” Us (Canada) Ltd. v Herbs “R” Us Wellness Society*, 2020 FC 682 at para 6 [*Toys “R” Us*]. However, it is not necessary for the Plaintiff to demonstrate actual confusion: *Mattel, Inc. v 3894207 Canada Inc.*, 2006 SCC 22 at paras 55 and 89 [*Mattel*]; *Veuve Clicquot*, above, at para 6.

[52] In *Masterpiece*, it was suggested that an assessment of the various factors set forth in subsection 6(5) of the *Trademarks Act* should begin with the “degree of resemblance” factor set forth in paragraph 6(5)(e). This is because “if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion”: *Masterpiece*, above, at para 49.

[24] Based on the findings I made in the Summary Judgment Decision in favour of the Plaintiff in connection with paragraphs 6(5)(a), (b), (c) and (e) of the *TM Act*, the Parties made only “limited submissions” in the present Motion in respect of those factors: see para 16 above.

To the extent that those submissions simply repeat prior submissions that have already been addressed, they are not appropriate. They represent an attempt to relitigate matters that were decided upon when I found that there was no genuine issue for trial in respect of those matters. This also applies to the Defendants' attempt to introduce new evidence that could have reasonably been obtained before the Motion for summary judgment by the exercise of reasonable diligence.

[25] The Court's findings in respect of paragraphs 6(5)(a), (b), (c) and (e) will not be revisited. In my view, the same principles that apply to a grant of summary judgment (see e.g., *Gemak Trust v Jempak Corporation*, 2022 FCA 141, at para 73, citing *Milano Pizza Ltd v 6034799 Canada Inc*, 2018 FC 1112, at para 40) also apply to findings made on particular issues that may have been adjudicated during a Motion for summary judgment. If it were otherwise, the Court's effort to streamline the Parties' dispute for this Motion for summary trial would be significantly undermined. The same would be true of the Court's attempt to secure the just, most expeditious, and least expensive outcome for the Parties, having regard to the principle of proportionality: Rule 3, *Federal Courts Rules*, SOR/98-106, as amended (the "**Rules**").

[26] Notwithstanding the above, I fully intend to conduct a global assessment of all of the factors set out in subsection 6(5) of the *TM Act*, as well as "all the surrounding circumstances", in reaching my determination with respect to the issue of confusion contemplated by paragraph 20(1)(a) and subsection 6(5): *Loblaws Inc v Columbia Insurance Company*, 2021 FCA 29, at para 11, citing *Masterpiece*, above, at para 49; *Sandhu*, above, at paras 25-28, However, in doing

so, I will have regard to my prior findings in respect of paragraphs 6(5)(a), (b), (c) and (e), which are summarized below.

[27] I will pause to observe in passing that the new evidence tendered by the Defendants is not such as to warrant different findings in respect of the four factors mentioned above, in any event.

(2) Degree of resemblance (s. 6(5)(e))

[28] The Plaintiff submits that there is a high degree of resemblance between the following design marks:

Table 2 – Comparison of the disputed design marks

TMA562798	TMA638884	Techno Piles' Logo
		

[29] For the reasons set forth at paragraphs 58-64 of the Summary Judgment Decision, I found that a casual consumer who is somewhat in a hurry and has an imperfect recollection is likely to perceive the disputed trademarks/trade names to have a degree of resemblance that is confusing.

[30] The Defendants maintain that this factor should be given little weight in the overall determination of whether the disputed marks are confusingly similar, for three reasons. First, they assert that any degree of resemblance between the disputed marks is no different than the degree of resemblance that the Registered Marks have with any other screw pile business logo, including 15 logos reproduced in Table 1 of their written submissions. Second, they state that

terms like “piles” and “metal post” are widely used in the helical piles business. Third, they state that stylized piles are commonly used in competitors’ logos, as set forth in their Table 1.

[31] I disagree. The similarity between the disputed marks is much greater than any similarity that may be said to exist between the Registered Marks and other marks that have been identified in this proceeding, including those included at Table 1 of the Defendants’ submissions. This is because, among other things, the first word in the disputed marks (TECHNO) is identical and particularly striking: *Masterpiece*, above, at paras 63–64. In addition, the ideas suggested by the remaining words in those trademarks/trade names are also identical. In this latter regard, the Defendants acknowledged that those words all mean the same thing. They also recognized that the term “Pieux” has “a strong French ‘flavor’.” Consequently, the average consumer in this market who is in a hurry may very well (correctly) assume that “Pile” means “Pieux”, and that therefore the disputed trademarks/trade names have the same source.

[32] Given the foregoing, I consider that this factor merits significant weight in the overall assessment. This is so notwithstanding the facts that the terms “piles” and “metal post” may be widely used in the helical piles business, and that stylized piles are commonly used in that business.

- (3) The inherent distinctiveness of the trademarks or trade names and the extent to which they have become known (s. 6(5)(a))

[33] In the Summary Judgment Decision, I found that the word “TECHNO” has a certain degree of distinctiveness in connection with the Relevant Goods and Services. Among other

things, this was because that word is striking in the context of being the first word in the Registered Marks. I further found that this strikingness is not likely to be materially reduced by virtue of the fact that some of the Parties' competitors use the words "Tech", "Technology" or "Technologies" in their trademarks or trade names. I added that my finding in this regard was reinforced by Ms. Bertram's statement, when cross-examined on her affidavit, that when she was a distributor for the Plaintiff, she considered the "brand" to be "Techno", as opposed to the full name of the company: Bertram Cross-Examination Transcript, November 22, 2021, at 109: Summary Judgment Decision, above, at paragraph 69.

[34] In addition to the foregoing, I found that the evidence of the Plaintiff's substantial sales, combined with the extensive advertising and promotion activities that it and its distributors have made over many years, reasonably supports the conclusion that the Registered Marks have acquired meaningful distinctiveness over time: Summary Judgment Decision, above, at para 70. Moreover, I found that there was no material evidence of the inherent or acquired distinctiveness of the Defendants' TECHNO PILES trademarks/trade names, relative to the Registered Marks: Summary Judgment Decision, above, at para 72.

[35] On the present Motion, the Defendants invite me to reconsider the foregoing findings. To the extent that they rely on essentially the same arguments and evidence that they relied upon in their Motion for summary judgment, I fail to ascertain any sound basis for reaching a different conclusion. For greater certainty, this includes the Defendants' arguments and new evidence regarding the widespread use of the prefixes or terms "TECHNO", "TECH", "METAL POST", "POST" and "PIEUX" in the broader construction industry. In brief, there is no evidence that

anyone other than the Plaintiff uses or has used the word “TECHNO” in combination with either “METAL POST” or “PIEUX”, and in relation to the Relevant Goods and Services: Summary Judgment Decision, above, at para 69.

[36] Having regard to all of the foregoing, I find that the factor of inherent/acquired distinctiveness weighs in favour of the Plaintiff. Nevertheless, on the very particular facts of this case, I consider that this factor merits only moderate weight. This is partially because there is some evidence that at least some customers do not remember the full name “Techno Metal Post”. In addition, the terms “Pieux” and “Metal Post” are descriptive of the Plaintiff’s products. Moreover, the Plaintiff declined to provide evidence, such as Google analytics, to demonstrate the effectiveness of its extensive advertising and promotional activities over its website and social media platforms.

(4) The length of time the trademarks or trade names have been in use (s. 6(5)(b))

[37] The Plaintiff has used its TECHNO METAL POST word mark (TMA596228) since 2003. It has also used its two design marks (TMA562798 and TMA638884) since 2002 and 2005, respectively, in connection with the registered goods and services. In addition, it has used its TECHNO PIEUX word mark (TMA950281) since 2016.

[38] By comparison, the Defendants have only used their TECHNO PILES marks in the marketplace since approximately May 2021.³

³ I recognize that the Defendants registered Techno Piles Inc. in January 2020. However, the uncontested evidence is that this entity has not yet operated in any meaningful manner and has only been used to register the domain name

[39] In the Summary Judgment Decision, I found that the foregoing facts weighed in favour of giving this factor a positive weighting in favour of the Plaintiff, despite certain arguments made by the Defendants to the contrary: Summary Judgment Decision, at paras 74-77. While the Defendants continue to advance those same arguments, I maintain my position.

(5) The nature of the goods, services or business (s. 6(5)(c))

[40] In the Summary Judgment Decision, I found that there is direct overlap among the Parties in respect of a broad range of the Relevant Goods and Services. As a result, I found that “the nature of the goods, services or business” factor weighs in favour of the Plaintiff. This is so despite the fact that the overlap does not extend to the goods for which the TECHNO PIEUX word mark is registered, and may not extend to “instruments to determine the load-bearing capacity of foundations, footings and piles”: Summary Judgment Decision, at paras 78 – 81.

[41] The Defendants now maintain that there is a distinct difference between the goods and services associated with the disputed marks. However, they do not explain how this is so. In any event, this is inconsistent with positions they take in connection with the Plaintiff’s allegation of depreciation of goodwill. Specifically, at paragraph 76 of their written submissions, they state as follows:

[76] ... The products and services offered by the TMP Defendants were, and remain, functionally identical goods and services to those that they offered for years under the Plaintiff’s banner with the Plaintiff’s blessing.

<http://www.technopilesinc.com>. That domain began to be used as the Defendants’ “landing page” and for their email on or about May 30, 2021. I also recognize that the TECHNO PILES trade name was registered in March 2021.

[42] At paragraph 80 of those submissions, the Defendants add that they “use supports made to the same technical specifications as the Plaintiff does.”

[43] Having regard to the foregoing, I do not accept the Defendants’ bald assertion that there are meaningful differences between the goods and services associated with the disputed marks, for the purposes of the present analysis.

[44] The Defendants further maintain that confusion with respect to the source of the disputed marks is unlikely because the Plaintiff has not had a dealer in the primary areas of operation (Medicine Hat and Fort McMurray) of the Principal Corporate Defendants, during what they consider to be the relevant timeframe – namely between May 2021 and May 2022.⁴ However, the “geographical separation in the use of otherwise confusingly similar trade-names and trade-marks does not play a role in [the] hypothetical test” contemplated by section 6 of the *TM Act*: *Masterpiece*, above, at para 30. This is because that test is based on the assumption that the trademarks/tradenames in dispute are used “in the same area”: see *Masterpiece*, above, at para 26. In any event, the Defendants also operate elsewhere in Alberta, including in Calgary, Edmonton, Lethbridge, Lloydminster, Red Deer, and Sherwood Park: Plaintiff’s Motion Record, at 155, 162, 617, 621 and 625. The Plaintiff has authorized distributors throughout Alberta and has substantial sales in that province: Summary Judgment Decision, at para 71(i).

⁴ The Principal Corporate Defendants’ disputed “re-branding” occurred at the end of May 2021: Summary Judgment Decision, at para 19. In May 2022, the Principal Corporate Defendants re-branded again, this time to “Screw Pile Pros”. The Plaintiff does not allege that this re-branding perpetuates the alleged violations of the *TM Act*. However, it maintains that the Defendants’ new logos infringe the Copyrighted Works.

[45] In summary, for the reasons set forth above, I maintain my finding that “the nature of the goods, services or business” is a factor that favours the Plaintiff.

(6) The nature of the trade (s. 6(5)(d))

[46] In the present Motion for summary trial, the Plaintiff submitted that this factor weighs in its favour because the allegedly infringing goods and services of the Principal Corporate Defendants are offered and sold in the same channels of trade as its own goods and services. The Plaintiff explained that this is so because the Parties’ respective goods and services are targeted and sold to the same end consumers, namely, builders and contractors who require helical piles and/or installations for their construction projects.

[47] In response, the Defendants submitted that this factor weighs in their favour and should be given significant weight. In support of this position, they stated that the Plaintiff sells its products primarily to dealers who deal exclusively in those products. They added that those “customers” are unlikely to ever be confused about the source of the Parties’ respective products. They further emphasized that the same is also true for their own customers – namely, builders and contractors – to whom they sell directly. In this regard, Ms. Bertram’s uncontested evidence is that most of the sales made by the Principal Corporate Defendants are through personal contacts or recommendations made by people with whom she and Mr. Bergevin have directly worked. Consequently, the Defendants maintained that branding or advertising is comparatively less important and that customer confusion regarding the source of the goods and services offered by the Principal Corporate Defendants is “highly unlikely”. Ms. Bertram’s affidavit evidence on this point was supported by her evidence on cross-examination, to the effect that a

lot of customers come to the Defendants as a result of personal contacts and referrals, rather than as a result of advertising: Bertram Cross-Examination Transcript, November 22, 2021, at 26–29.

[48] Despite the fact that Ms. Bertram did not provide much support for her statements, I found that her evidence met the low bar to survive the Plaintiff’s Motion for summary judgment with respect to the “nature of the trade” factor in section 6(5)(d). I reached that finding after noting that the Plaintiff’s principal affiant, Mr. Jérôme Chabot, acknowledged on cross-examination that a lot of the Plaintiff’s referrals normally come from personal connections: Summary Judgment Decision, at paragraph 85. Given the distinct possibility that the scope for customer confusion might be very small in a context in which most sales are made through personal contacts, I observed that Ms. Bertram’s evidence had *potentially* important implications for the Court’s assessment of the allegations advanced by the Plaintiff in connection with section 21(1)(a) of the *TM Act*. More specifically, that evidence had potentially important implications for the Court’s assessment of the likelihood of confusion, *as a matter of first impression*, on the part of the casual consumer *in this market* who is somewhat in a hurry.

[49] As it has turned out, the Parties did not avail themselves of the opportunity in the present Motion to provide compelling evidence in support of their respective positions regarding “the nature of the trade” factor. To a large degree, the Parties’ positions with respect to this factor consist largely of evidence provided by their own representatives, as opposed to customers. Ultimately, I have concluded that this factor favours the Plaintiff, although not strongly so.

[50] In assessing “the nature of the trade” factor, important considerations for the Court include any differences or similarities in the level of the industry at which the Relevant Goods and Services are marketed and sold, the types of outlets or channels through which they are marketed sold, and any differences among the persons to whom they are marketed and sold:

United Artists Pictures Inc v Pink Panther Beauty Corp., 1998 CarswellNat 548, at paras 30-33.

[51] Regarding the first of those considerations, and as mentioned above, the Plaintiff supplies the Relevant Goods and Services to its distributors, who then sell those goods and services to builders, contractors, homeowners, and others. By comparison, the Principal Corporate Defendants supply their similar goods and services directly to those customers. The Defendants place great significance on this difference. However, on the particular facts of this case, this difference does not weigh in their favour. This is so for two reasons. First, the Plaintiff markets the Relevant Goods and Services directly to the customers described above on its website and over essentially the same social media platforms as the Defendants. Second, the Plaintiff’s dealers are licensed to supply the Relevant Goods and Services to those end-use customers, pursuant to distribution agreements that provide the Plaintiff with control over the character or quality of those goods and services. In this context, the supply by the Plaintiff’s distributors of the Plaintiff’s goods and services in association with the Registered Marks “has, and is deemed always to have had, the same effect as such a use” of the Registered Marks by the Plaintiff: section 50(1), *TM Act*. Consequently, the Plaintiff is deemed to operate at the same level of the trade as its distributors, who in turn operate at the same level of the trade as the Principal Corporate Defendants. This consideration favours the Plaintiff.

[52] Turning to the types of outlets or channels through which the Relevant Goods and Services are marketed and sold, the Plaintiff's distributors in Alberta compete directly with the Principal Corporate Defendants' outlets. Once again, this consideration favours the Plaintiff. I will simply add in passing that, "to establish the likelihood of confusion it is not necessary to prove that the wares are effectively sold in the same place, so long as the parties are entitled to do so": *Cartier Men's Shops Ltd v Cartier Inc*, 1981 CarswellNat 756, at para 13.

[53] With respect to the persons to whom the Parties sell the Relevant Goods and Services, they are essentially the same, namely, builders, contractors, homeowners and others. In this regard, Ms. Bertram testified that the Principal Corporate Defendants continued to sell to "the same kind of customers that Techno Metal Post distributors were selling to", after they began using the disputed Techno Piles marks/trade names: Plaintiff's Motion Record, at 1121. This consideration favours the Plaintiff.

[54] Despite all of the foregoing, the Defendants maintain that a particularly important consideration, on the particular facts of the present dispute, is that the substantial majority of their sales are made through personal contacts, referrals and repeat business. In this context, they insist that confusion is unlikely to arise as to the source of the Relevant Goods and Services. According to Ms. Bertram, when the Principal Corporate Defendants operated under the Techno Metal Post name, most of their work came from people who were seeking to work with her and Mr. Bergevin, rather than because of the Techno Metal Post name. This was because of their personal reputations in the industry.

[55] In support of her position, Ms. Bertram stated that over the period 2017 to 2021, less than 3% of the Principal Corporate Defendants' sales came from referrals from the Plaintiff. In terms of annual sales, she added that in 2017, 48% of their customers were from tradeshow introductions, 28% were from referrals in their own network, 19% were from Mr. Bergevin's connections in the field, and 5% were from unknown sources.⁵ For 2018, Ms. Bertram reported that 39% of the sales made by the Principal Corporate Defendants that year came from returning customers, 27% from unknown sources, 6% from tender bids, 4% from tradeshow introductions, and 1% from Mr. Bergevin's connections in the field. For 2019, the breakdown was 40% for returning customers, 28% from unknown sources, 23% from referrals within the Defendants' network, 7% from the Plaintiff, and 2% from tender bids. For 2020, the breakdown was 36% for returning customers, 28% from unknown sources, 21% from referrals within the Defendants' network, 10% from the Plaintiff, and the remainder from tradeshow introductions and tender bids. Finally, in 2021, the corresponding breakdown was 38% returning customers, 38% from referrals within the Defendants' network, 10% from tender bids, and the remainder from tradeshows and unknown sources: Affidavit of Ronda Bertram, July 29, 2022, at paras 32 – 47.

[56] The foregoing statistics do not significantly assist the Defendants. This is because, prior to May 31, 2021, the Principal Corporate Defendants were the Plaintiff's distributors. So, any reputation that they may have had was intimately linked with the Relevant Goods and Services that they marketed and supplied on behalf of the Plaintiff. In so doing, they handed out business cards with the Plaintiff's branding and wore the Plaintiff's corporate clothing. This included at

⁵ According to Ms. Bertram, none of the referrals from the Plaintiff in 2017 were converted into a customer.

trade shows, which Ms. Bertram described as being “critical to our business in both cities, Medicine Hat and Fort McMurray”: Plaintiff’s Motion Record, at 966-967; see also 922-923.

[57] It is also relevant that neither Ms. Bertram nor Mr. Bergevin had any involvement in the helical piles business prior to 2016, when they began to work with TMP Medicine Hat: Plaintiff’s Motion Record, at 922. Moreover, it appears that their reputation was significantly enhanced by the fact that they installed approximately 2,000 helical piles in their first year as the Plaintiff’s distributor, following the fire in Fort McMurray: Plaintiff’s Motion Record, at 922. It is reasonable to infer that the demonstrated quality of those piles, and the manner in which they were installed (pursuant to the Plaintiff’s process), had a lot to do with the reputational enhancement that the Defendants’ achieved as a result of those installations. It is also reasonable to infer that some of the business the Defendants obtained from unknown sources resulted from the Plaintiff’s substantial promotional and advertising efforts.

[58] Moreover, there is evidence that it was not until the second re-branding by the Principal Corporate Defendants in May 2022, that some customers perceived that the Principal Corporate Defendants were no longer associated with the Plaintiff. Specifically, Ms. Bertram stated that following the rebranding from Techno Piles to Screw Piles Pros, three separate customers advised her that they had previously not wished to work with Techno Metal Post, “but were able to work with us now that we were no longer associated with them”: Affidavit of Ronda Bertram, July 29, 2022, at para 11. This suggests that, prior to the second re-branding, there was confusion in the market as to whether the Techno Piles marks/trade name was associated with the Plaintiff.

[59] Finally, Ms. Bertram stated that “Screw Pile installation is a matter that is generally extensively researched by [the Principal Corporate Defendants’] clientele, due to the cost and importance of the product.” Bertram Affidavit, July 29, 2022, at para 19. In this latter regard, she stated that the “smallest jobs that the [Principal Corporate Defendants] do are for residential decks and are priced in the \$600-\$3,000 range, without including the cost of the engineering work”: Bertram Affidavit, July 29, 2022, at para 20. Given the foregoing, the Defendants maintain that there is a low likelihood of confusion between the disputed marks/trade names in this particular industry.

[60] I accept that *some* customers in this industry are likely to be more alert and aware than the average customer, of the differences between the sources of disputed marks/trade names. I also accept that persons in the former group *may* be less likely to be confused when they encounter the disputed marks/trade names. Unfortunately, there is very little evidence going to this issue.

[61] During the hearing, the only specific customer-related evidence adduced by the Plaintiff was conceded to be hearsay. That evidence was provided by Mr. Jared Holmans, who is an independent installer employed by Techno Metal Post Central Alberta Inc., one of the Plaintiff’s licensed distributors. In his affidavit, dated July 28, 2022, Mr. Holmans described how an e-mail that was sent by Mr. Painchaud to info@technopiles.com and addressed to “Ronda”, had been forwarded to him for follow-up as a job opportunity. That e-mail address is owned by the Plaintiff and is similar to an e-mail address (info@technopilesinc.com) maintained by the Defendants. Mr. Holmans explained that when he called Mr. Painchaud, he was told that Mr.

Painchaud had intended to reach out to the same people who had done a previous job for him a couple of years ago. According to Mr. Holmans, Mr. Painchaud explained that he had been trying to contact Mr. Holmans when he reached out to “Ronda” at Techno Piles. Mr. Painchaud further explained that he conducted a Google search for “Techno” and “helical piles”, and thought that Techno Piles was part of the same business that had installed helical piles for him in the past. Given the hearsay nature of this evidence as it relates to Mr. Painchaud’s alleged confusion, the evidence is presumptively inadmissible: *R v Khelawon*, 2006 SCC 57, at para 3.

[62] That evidence does not fall under any of the traditional exceptions to hearsay, and I do not see any basis to admit it under the principled approach. I note that the Plaintiff made no argument to admit the evidence as such. The Plaintiff also failed to explain why it did not offer any other evidence directly from Mr. Painchaud. Consequently, I find the evidence inadmissible and have not given it any weight.

[63] Likewise, Mr. Christian Rousseau testified on behalf of the Plaintiff that following the Defendants’ rebranding from Techno Metal Post to Techno Piles, he had communications with an unstated number of people who told him that they were confused about what was happening. However, once again, this evidence is hearsay as it relates to the alleged confusion of those people. For essentially the same reasons provided in the immediately preceding paragraph, I find that this evidence does not fall under any of the traditional exceptions to hearsay, and I do not see any basis to admit it under the principled approach. Accordingly, the evidence is inadmissible and I have given it no weight.

[64] I pause to note that Mr. Holmans conceded on cross-examination that he was personally not confused in any way when he received the e-mail dated May 20, 2021, announcing the Defendants' initial re-branding to Techno Piles, because that email was from "Mat and Ronda," the two individual Defendants: Defendants' Motion Record, at 962.

[65] I also note that Ms. Bertram and Mr. Bergevin both stated in their affidavits that they are "not aware of any instances in the marketplace of customers confusing the goods of [the Principal Corporate Defendants] with those of Techno-Pieux": Affidavit of Ronda Bertram, July 29, 2022, at para 26; Affidavit of Mathieu Bergevin, July 28, 2022, at para 18. Ms. Bertram also noted that "customers are typically obtaining multiple quotes from different companies, and usually do a lot of research on screw piles to make sure they can ask the right questions of the companies they are considering for the installation of the piles": Affidavit of Mathieu Bergevin, July 28, 2022, at para 21.

[66] Notwithstanding the foregoing, as previously mentioned, Ms. Bertram also stated that three separate persons contacted her and stated that "they did not wish to work with Techno Metal Post but were able to work with us know that we were no longer associated with them": Affidavit of Ronda Bertram, July 29, 2022, at para 11. This suggests that those three individuals were confused, prior to the Defendants' second rebranding to Screw Piles Pro, regarding the source of the Defendants' Techno Piles marks/trade names.

[67] Moreover, it bears underscoring that the test to be applied focuses "on the first impression of consumers *when they encounter* the marks in question": *Masterpiece*, above, at

para 70 [emphasis in original]. Therefore, the fact that customers may subsequently conduct extensive research before making a final purchase decision is not relevant: *Masterpiece*, above, at para 71. To quote the Supreme Court of Canada:

It is confusion when [consumers] encounter the trade-marks that is relevant. Careful research which may later remedy confusion does not mean that no confusion ever existed or that it will not continue to exist in the minds of consumers who did not carry out that research.

Masterpiece, above, at para 72.

[68] Having regard to the foregoing, I find that the expensive nature of the Relevant Goods and Services, together with the heightened awareness that *some* customers may have of the differences between the disputed marks/trade names, are considerations that, at best, weigh only moderately in favour of the Defendants. In reaching this finding, I was mindful of Ms. Bertram's evidence that most of the Defendants' business comes from personal contacts and that about 80% of the Defendants' business is residential building work, with the remaining 20% being commercial work.

[69] However, when combined with the other considerations that are relevant to an assessment of "the nature of the trade", which are discussed at paragraphs 50-53 above, I find that the "nature of the trade factor" as a whole weighs slightly in favour of the Plaintiff. In reaching this conclusion, I am mindful of Mr. Holmans' evidence that a lot of the Plaintiff's business with homeowners comes from the Plaintiff's website: Defendants' Motion Record, at 966. For the record, I did not give this evidence substantial weight.

[70] I will observe in passing that although the Defendants submitted that the absence of a high degree of geographic overlap between the Parties is a factor that is relevant to “the nature of the trade” factor in section 6(5)(d) of the *TM Act*, I considered it to be more appropriate to deal with this consideration in assessing “the nature of the goods, services or business” factor in section 6(5)(c) of the Act: see paragraph 44 above.

(7) Additional relevant surrounding circumstances

[71] In the Summary Judgment Decision, I found that it was unnecessary to consider the other relevant surrounding circumstances, beyond the five factors specifically listed in section 6(5) of the *TM Act*. However, in view of the fact that the Parties’ dispute might well proceed to trial, I considered it appropriate to observe that the Defendants’ conduct after they began to use their TECHNO PILES trade name and marks in the marketplace would be relevant to the Court’s ultimate assessment of the likelihood of confusion. I further observed that such conduct included the following:

- a) Sending an email blast on May 30, 2021 from “Techno Metal Post Fort McMurray and Medicine Hat,” entitled “Spreading the Word – New Contact Information for Techno Metal Post Fort McMurray and Medicine Hat”. Among other things, that email stated, “We still have the same great companies *only the name is changing*” (emphasis added). It then listed the same addresses and telephone numbers previously used by the Defendants in their capacity as distributors of the Plaintiff’s products. After also stating that their personal and “info” emails would no longer be valid, the announcement provided new emails with the suffix @technopilesinc.com.

- b) Announcing a “*rebranding*” and posting a video on Techno Piles’ Facebook page entitled “Rebranding”.
- c) Rebranding a number of social media accounts that had been used when they were still going to market as distributors of the Plaintiff’s products, and that *continued to display pictures or other material containing one or more of the Registered Marks*, including on the Plaintiff’s equipment, which is described as “our unique helical screw pile installation equipment”.
- d) Stating on Ms. Bertram’s LinkedIn profile: “Ronda Bertram, Senior Project Manager at techno Piles previously known as Techno Metal Post Fort McMurray and Techno Metal Post Medicine Hat Inc. ... *Same great company, same great people just a name change*” (emphasis added).
- e) Stating the following, in the “About Us” section of a web page that is specific to Medicine Hat: “Both Mat and Ronda work full-time in their business which is rare for Techno Metal Post dealerships ...”
- f) Referring, on their website, to a list of “Completed Projects” that consisted primarily of projects that were completed by TMP Fort McMurray in its capacity as an authorized distributor of the Plaintiff’s products.
- g) Posting an ad on Kijiji that, among other things, stated: “technoPILES is operating under the building code of Alberta and the CCMC Evaluation Report from ALMITA PILING, ROTERRA PILLING and TECHNO METAL POST for is [sic] BUILDING CODE COMPLIANCE”.

- h) Stating, on their website, that Techno Piles is “Alberta Building Code CCMC Compliant”, and then referencing CCMC-13059-R, which is the certification number received by the Plaintiff from the Canadian Construction Materials Centre [“CCMC”].

- i) Sending out one or more estimates with (i) *the Plaintiff’s logo*, CCMC certification number, and ISO certification prominently featured at the top of the page; and (ii) the Defendants’ new email address (estimates@technopiles.com) at the bottom of the page.

[72] Taken cumulatively, I consider that the matters listed in subparagraphs 71(a) – (f) and (i) above likely contributed to sowing confusion regarding the source of the disputed marks/trade names. This is particularly so with respect to the passages that I have italicized.

[73] Given this finding and the conclusions that I have reached in favour of the Plaintiff with respect to the five factors listed in section 6(5) of the *TM Act*, I find it unnecessary to consider the Plaintiff’s allegations relating to the Defendants’ use of the CCMC certification number that applies to the process for installing the Plaintiff’s products.⁶

- (8) Summary and conclusion regarding confusion and the alleged deemed infringement

⁶ The Defendants maintain that CCMC certification numbers are not proprietary and that the Defendants are permitted to indicate to the public that they use the same certified process to install their helical piles, which they assert have virtually identical technical specifications as the Plaintiff’s helical piles.

[74] In summary, for all of the reasons set forth in parts VI.A(1)-(6) above, I find that each of the five specific factors to be considered in determining whether trademarks or trade names are confusing, as per paragraphs 6(5)(a)–(c) and (e) of the *TM Act*, weigh in favour of the Plaintiff. I also find that the additional relevant circumstances described at paragraphs 71(a) – (f) and (i) above, taken cumulatively, weigh in favour of the Plaintiff.

[75] Consequently, I find that the Plaintiff has demonstrated that the Principal Corporate Defendants sold, distributed, and advertised their goods and services in association with a confusing trademark or trade name, as contemplated by section 20(1)(a) of the *TM Act*. They are therefore deemed to have infringed the Registered Marks during the period when they engaged in such sales, distribution and advertising. I find that such period (the “**Relevant Period**”) began on May 30, 2021, when the Principal Corporate Defendants rebranded from TECHNO METAL POST to TECHNO PILES and Techno Piles (the “**Confusingly Similar Marks/Trade Names**”). The Relevant Period ended when the Principal Corporate Defendants rebranded a second time, to Screw Pile Pros, sometime in May 2022, presumably after their new entity Screw Pile Pros Inc. was incorporated, on May 20, 2022

B. *Depreciation of Goodwill*

(1) Introduction

[76] Section 22 of the *TM Act* prohibits the use of a trademark registered by another person in a manner that is likely to have the effect of depreciating the value of the goodwill attaching thereto.

[77] For the reasons set forth below, I find that the Principal Corporate Defendants have contravened section 22.

[78] Goodwill is the “positive association that attracts customers towards its owner's wares or services rather than of its competitors”: *Veuve Clicquot*, above, at para 50. It has also been described as “the good repute associated with a name or mark”: *Veuve Clicquot*, above, at para 50, quoting *Inland Revenue Commissioners v Muller & Co's Margarine Ltd*, [1901] AC 217, at 224.

[79] To demonstrate a contravention of section 22, a plaintiff must demonstrate that the defendant has “made use of marks sufficiently similar to [the plaintiff’s mark] to evoke in a relevant universe of consumers a mental association of the two marks that is likely to depreciate the value of the goodwill attaching to the [plaintiff’s] mark”: *Veuve Clicquot*, above, at para 38.

[80] To meet this test, a plaintiff must demonstrate four things:

Firstly, that a claimant's registered trade-mark was used by the defendant in connection with wares or services – whether or not such wares and services are competitive with those of the claimant. Secondly, that the claimant's registered trade-mark is sufficiently well known to have significant goodwill attached to it. Section 22 does not require the mark to be well known or famous (in contrast to the analogous European and U.S. laws), but a defendant cannot depreciate the value of the goodwill that does not exist. Thirdly, the claimant's mark was used in a manner *likely* to have an effect on that goodwill (i.e. linkage) and fourthly that the *likely* effect would be to depreciate the value of its goodwill (i.e. damage).

[Emphasis in original.]

Veuve Clicquot, above, at para 46.

[81] The Plaintiff submits that the Defendants have violated section 22 by using the Confusingly Similar Marks/Trade Names in a manner that is likely to depreciate the goodwill in the Registered Marks. In this regard, the Plaintiff asserts that the Defendants' marketing and sales of the Confusingly Similar Marks/Trade Names have weakened the uniqueness of the Registered Marks and the impression they make on the relevant class of consumers. The Plaintiff also contends that those marketing and sales activities have interfered with and reduced the impact of the Plaintiff's own marketing activities.

[82] In response, the Defendants maintain that the Plaintiff has not demonstrated *how* the marketing and sales of their products have produced these alleged results. More generally, they state that the Plaintiff has not demonstrated on a balance of probabilities that their use of the Confusingly Similar Marks/Trade Names is *likely* to have an effect on the Plaintiff's goodwill. In support of this position, the Defendants state that the goods and services they offered were, and remain, functionally identical to those that they offered for years under the Plaintiff's banner and with the Plaintiff's blessing.

(2) The first two elements of the test

[83] In the Summary Judgment Decision, I found that there was no genuine issue for trial with respect to the first two elements of the four-part analysis described at paragraph 80 above.

[84] With respect to the first element, I found that the Defendants have made use of marks and names (i.e., the Confusingly Similar Marks/Trade Names) that are "sufficiently similar" to the

Registered Marks to come within the purview of section 22: Summary Judgment Decision, at para 99; citing *Veuve Clicquot*, above, at para 38.

[85] Turning to the second element, I found that the Registered Marks are sufficiently well known to be associated with significant goodwill: Summary Judgment Decision, at para 100. I based that finding on the evidence of the Plaintiff's substantial sales, combined with the extensive advertising and promotion activities that it and its distributors have made over a broad geographic area and over many years: Summary Judgment Decision, at paras 70-71; see also *Veuve Clicquot*, above, at para 54; and *H-D U.S.A., LLC and Harley-Davidson Canada LP*, 2021 FC 620, at para 47 [*"Harley Davidson"*].

[86] However, I found that the evidence adduced on the Motion for summary judgment was not sufficient to demonstrate that the Confusingly Similar Marks/Trade Names have been, or are being, used in a manner *likely* to have an effect on the Plaintiff's goodwill. I reached the same finding with respect to the fourth element, namely, whether the *likely* effect of the Defendants' use of the Confusingly Similar Marks/Trade Names would be to depreciate the value of the Plaintiff's goodwill. I noted that, for both the third and fourth elements of the test, additional evidence was required. I added that this was particularly so with respect to the extent to which builders, contractors and others in the relevant universe of consumers are likely to make a mental association between disputed marks, such as to likely depreciate the value of the goodwill associated with the Registered Marks.: Summary Judgment Decision, at 101-102. Nevertheless, it bears underscoring that I made the foregoing findings having regard to the high bar required to succeed on a Motion for summary judgment – namely, demonstrating that the Defendants' case

“is clearly without foundation”: *Canmar Foods Ltd v TA Foods Ltd*, 2021 FCA 7, at para 24. The bar is materially lower on the present Motion, where the Plaintiff need only establish the four elements of the test contemplated by section 22 on a balance of probabilities.

(3) The third element of the test

[87] The linkage required to establish the third element of the test is a use of a registered trademark, or trademark sufficiently similar to the registered trademark, *in a manner* that is likely to have an effect on the goodwill of the registered trademark: *Veuve Clicquot*, above, at para 46. This can be demonstrated by establishing use in a manner that is likely to evoke “in a relevant universe of consumers a mental association of the two marks”: *Veuve Clicquot*, above, at para 38; *Boulangerie Vachon Inc v Racioppo*, 2021 FC 308, at para 115 [***Boulangerie Vachon***].

[88] For this third element of the test, the relevant universe of consumers is limited to those consumers who are interested in purchasing the relevant goods or services and are “somewhat-hurried”: *Veuve Clicquot*, above, at para 56. It can be inferred from a high degree of similarity of the disputed marks and evidence of significant use, sales, and advertising that such consumers are likely to make the requisite mental association between those marks: *Bean Box, Inc v Roasted Bean Box Inc*, 2022 FC 499, at para 66 [***Bean Box***]; *Boulangerie Vachon*, above.

[89] On the particular facts of this case, I find that it is appropriate to make such an inference. In brief, I consider that the average builder, contractor and homeowner who is “somewhat hurried” would likely make a mental association between the disputed marks/trade names. I

make this finding based on the Parties' substantial marketing and promotional activities, as well as their significant levels of sales, in Alberta. Evidence of the Plaintiff's activities and sales in this regard is summarized at paragraphs 70-71 of the Summary Judgment Decision.

Corresponding evidence with respect to the Defendants is provided at paragraph 71 above.

Additional evidence is provided at paragraphs 54-58 above. Indeed, I consider it reasonable to infer from the evidence of confusion on the part of three of the Defendants' customers, discussed at paragraph 66 above, that those customers were making a mental association between the Defendants' marks/trade names and the Registered Marks, prior to the Defendants' second re-branding to Screw Piles Pros.

[90] Based on all of the foregoing, I consider it reasonable to infer from the manner in which the Principal Corporate Defendants used their Confusingly Similar Marks/Trade Names that the requisite mental linkage required for the purposes of the third element of the four-part test contemplated by section 22 has been established.

(4) The fourth element of the test

[91] I will now turn to the fourth element of the test. This requires a demonstration of a likely depreciation of the value of the Plaintiff's goodwill. This can be established by demonstrating a likely "blurring" of the brand image evoked by [the Plaintiff's] trademark, or of its positive associations, or a "whittling away" of its power to distinguish the products of the [Plaintiff] and attract consumers": *Veuve Clicquot*, above, at para 64; *Bean Box*, above, at para 67; *1196278 Ontario Inc DBA Sassafraz v 815470 Ontario Ltd DBA Sassfras Coastal Kitchen and Bar*, 2022 FC 116, at para 101 [*"Sassafraz"*]. Another way in which the value of a mark can be lowered is

when it is “bandied about” by others: *Veuve Clicquot*, above, at para 63. These types of reductions of the goodwill associated with the Registered Marks can be inferred from the evidentiary record: *Veuve Clicquot*, above, at para 76; *Boulangerie Vachon*, above, at para 115. As in “passing off” cases, this includes evidence that the Parties are direct competitors and sell very similar products: *Group III International Ltd v Travelway Group International Ltd*, 2017 FCA 215, at para 84 [**“Travelway Group”**]; *Alliance Laundry Systems LLC v Whirlpool Canada LP*, 2019 FC 724, at para 60.

[92] It is abundantly clear from the record in this proceeding that the Parties are direct competitors for the sale of the Relevant Goods and Services. This is so despite the fact that the Plaintiff has not established another distributor in Medicine Hat and Fort McMurray. At the time of their re-branding to TECHNO PILES, the Defendants announced in their e-mail and social media locations that they had several other locations throughout Alberta, in areas where the Plaintiff also sells through distributors. Moreover, during cross-examination, Ms. Bertram explained that she was reluctant to disclose her customer list to the Plaintiff’s counsel because the Plaintiff is a competitor: Plaintiff’s Motion Record, at 979. Later, in addressing the Plaintiff’s counsel, the Defendants’ counsel referred to the Plaintiff as “your competing client”: Plaintiff’s Motion Record, at 991. In her affidavit dated July 29, 2022, at paragraph 60, Ms. Bertram added: “Since we stopped working with Techno-Pieux, we are finding that we are working an increasing number of commercial jobs that we were previously not competitive for.” Elsewhere in the record, in an e-mail exchange between Mr. Holmans and Ms. Bertram, Mr. Holmans stated: “... your competition is the last thing we are worried about”: Plaintiff’s Motion Record, at 1172. In addition, in their written submissions, the Defendants included a chart of the helical pile logos of

six different suppliers of helical piles, who were described as “competing companies”. That chart included the logos of both the Plaintiff and the Defendants.

[93] In addition to the foregoing, as previously discussed, Ms. Bertram testified that three separate customers contacted her and stated that “they did not wish to work with Techno Metal Post but were able to work with us now that we were no longer associated with them”: see paragraph 66 above. It is implicit in those statements that those customers view the Defendants as being an alternative to sourcing helical piles from Techno Metal Post.

[94] Furthermore, in his affidavit dated July 29, 2022, Mr. Chabot stated:

[16] The customers that are serviced by Techno Pieux's authorized distributors, under license from Techno Pieux, are the same kinds of customers serviced by TMPMH and TMPFM, both when they acted as licensed distributors for Techno Pieux and since their purported "rebrand" to TECHNO PILES...

[95] It is also clear from the record that the Parties sell very similar products. For example, as previously noted, in responding to allegations made by the Plaintiff with respect to their use of the same CCMC certification number as the Plaintiff, the Defendants stated that they use the same certified process to install their helical piles, and that those helical piles have virtually identical technical specifications as the Plaintiff’s helical piles. In addition, in their written submissions, the Defendants state that they continue to use helical piles that meet the same specifications as the Plaintiff’s helical piles. They added:

76. The products and services offered by the TMP Defendants were, and remain, functionally identical goods and services to those that they offered for years under the Plaintiff's banner with the Plaintiff's blessing.

[96] Based on all of the foregoing, I consider it appropriate to infer that the Defendants used their Confusingly Similar Marks/Trade Names in a manner that was likely to have the affect of depreciating the goodwill attached to the Relevant Marks. Such use likely had this effect by “blurring” or “whittling away” the goodwill associated with the Registered Marks. It also constituted the type of “bandying about” that is likely to lower the goodwill in the Registered Marks: *Veuve Cliquot*, above, at para 63.

(5) Conclusion regarding depreciation of goodwill

[97] Given that the Plaintiff has established the four elements of the test contemplated by section 22 of the *TM Act*, I find that the Plaintiff has established that during the Relevant Period, the Principal Corporate Defendants have contravened section 22.

C. *Passing Off*

[98] The Plaintiff seeks a declaration that the Defendants have contravened section 7(b) of the *Trademarks Act*.

[99] That provision states:

Unfair Competition and Prohibited Signs Prohibitions

7 No person shall

(b) direct public attention to his goods, services or business in such a way as to cause or be likely to cause confusion in Canada, at the time he commenced so to direct attention to them, between his goods, services or

Concurrence déloyale et signes interdits Interdictions

7 Nul ne peut :

b) appeler l’attention du public sur ses produits, ses services ou son entreprise de manière à causer ou à vraisemblablement causer de la confusion au Canada, lorsqu’il a commencé à y appeler ainsi l’attention, entre

business and the goods, services or business
of another;

ses produits, ses services ou son entreprise et
ceux d'un autre;

[100] To demonstrate a contravention of this provision, the Plaintiff must initially establish that it had a valid and enforceable trademark at the relevant time: *Sandhu*, above, at para 39. In the Summary Judgment Decision, I found that this requirement had been met based on evidence with respect to the registrations of each of the Registered Marks. Summary Judgment Decision, at paragraph 107.

[101] Once a plaintiff establishes a valid and enforceable trademark at the relevant time, it must then establish (i) the existence of goodwill, (ii) deception of the public due to wilful, negligent or careless misrepresentation, and (iii) actual or potential damages: *Kirkbi AG v Ritvik Holdings Inc*, 2005 SCC 65 at paras 66–68 [**“Kirkbi”**].

[102] In the Summary Judgment Decision, I found that the Plaintiff had established the first element of this test, relating to the existence of goodwill in the Registered Marks: Summary Judgment Decision, above, at 108. In reaching that finding, I was mindful that the purposes of the goodwill assessment contemplated by section 22 of the *TM Act* are different from those for passing off under paragraph 7(b): *Sandhu*, above, at para 48; *Harley Davidson*, above, at para 46. However, I was also mindful of the fact that a number of the factors that are considered for the purposes of assessing the existence of goodwill under section 22 are also relevant for conducting that assessment for the purposes of paragraph 7(b): *Sandhu*, above, at paragraph 48. For the latter purpose, the relevant factors include the inherent and acquired distinctiveness of the Registered Marks, the length of time those marks have been in use, and the extent and duration of the

Plaintiff's advertising and marketing activities in connection with those marks: *Sandhu*, above, at para 48; *Group III International Ltd v Travelway Group International Ltd*, 2017 FCA 215, at para 77 [**"Travelway Group"**];

[103] The second element of the test, pertaining to the deception of the public, is assessed by reference to the same factors in subsection 6(5) of the *TM Act* that are considered in assessing confusion: *Sadhu Singh Hamdard Trust v Navsun Holdings Ltd*, 2016 FCA 69, at para 21 [**"Hamdard Trust"**]; see also *Kirkbi*, above, at para 68 ("[t]he second component is misrepresentation creating *confusion* in the public"(emphasis added)); and *Travelway Group*, above, at para 80. In the Summary Judgment Decision, I found that the conduct summarized at paragraph 71 above amounted to a wilful or careless misrepresentation. However, I proceeded to find that the Plaintiff had not demonstrated that there was no genuine issue for trial with respect to the "deception of the public" element of the test. I reached the latter finding because I was unable to reach a conclusion with respect to the "the nature of the trade" factor in paragraph 6(5)(d) of the *TM Act*: Summary Judgment Decision, at para 109. Now that I have found in favour of the Plaintiff with respect to both that particular factor and the confusion analysis as a whole, I find that the Plaintiff has established the deception element of the test for passing off.

[104] I will now turn to the third element of the test, which requires a demonstration of actual or potential damage to the plaintiff.

[105] The Defendants maintain that the Plaintiff did not suffer any damages during the Relevant Period because the evidence demonstrates that its sales revenues in Alberta increased

for each of the three fiscal years preceding the hearing in this matter. The Defendants add that the Court should draw an inference that the Plaintiff's revenues in the various regions also increased during those years because the Plaintiff refused to provide a regional breakdown of its Alberta revenues, after having provided an undertaking to do so.

[106] The fact that the Plaintiff's revenues may have increased throughout Alberta during the Relevant Period does not imply that they would not likely have increased even more, in the absence of the Defendants' use of the Confusingly Similar Marks/Trade Names.

[107] A likelihood of damage, in the form of a loss of sales and business, can be inferred from the fact that the Parties are direct competitors: *Travelway Group*, above, at para 84; *Alliance Laundry Systems LLC v Whirlpool Canada LP*, 2019 FC 724, at para 60. Such likely damage can also be established through a loss of control over reputation, image or goodwill: *Hamdard Trust*, above, at para 31; *Target Event Production Ltd v Cheung*, 2010 FCA 255, at paras 26-27; *Bean Box*, above, at paras 54-56; *Harley Davidson* at para 42.

[108] As noted at paragraph 92 above, it is abundantly clear from the record in this proceeding that the Parties are direct competitors for the sale of the Relevant Goods and Services. As further noted at paragraph 96, the manner in which the Defendants have used their Confusingly Similar Marks/Trade Names has likely had the effect of "blurring" or "whittling away" the goodwill associated with the Registered Marks. Consequently, I have no difficulty concluding that the Plaintiff has established actual or likely damage, for the purposes of the third element of the test for passing off.

[109] In summary, the Plaintiff has established that all three requirements of the test have been met. Accordingly, I find that the Defendants have contravened paragraph 7(b) of the *TM Act*.

D. *Copyright Infringement*

(1) Applicable legal principles

[110] In the Summary Judgment Decision, I provided the following summary of the legal principles applicable to an assessment of the Plaintiff's allegations of copyright infringement:

[113] The *Copyright Act* protects the expression of ideas in *original* works, but not the ideas themselves: *CCH Canadian Ltd. v Law Society of Upper Canada*, 2004 SCC 13 at para 8 [*CCH*].

[114] Copyright subsists in every original literary, dramatic, musical and artistic work if any one of certain enumerated conditions, which are not in dispute on the present Motion, is met: *Copyright Act*, s 5(1).

[115] For a work to be *original* within the meaning of that legislation, it must be more than a mere copy of another work. However, the work need not be “creative, in the sense of being novel or unique.” Instead, “[w]hat is required to attract copyright protection in the expression of an idea is an exercise of skill and judgment”: *CCH*, above, at para 16. Skill can be demonstrated by “the use of one’s knowledge, developed aptitude or practice ability in producing the work”, whereas judgment is demonstrated through “the use of one’s capacity for discernment or ability to form an opinion or evaluation by comparing different possible options in producing the work”: *CCH*, above, at para 16.

[116] The requisite degree of skill and judgment is something more than something so trivial that it could be characterized as a purely mechanical exercise: *CCH*, above, at para 16.

[117] “Copyright”, in relation to a work, includes the sole right to produce or reproduce the work or any substantial part thereof in any material form whatsoever: *Copyright Act*, s 3. Consequently, copyright infringement occurs whenever anyone reproduces the copyrighted work, or a substantial part thereof, without the consent

of the owner: *Copyright Act*, s 27(1). The same is true whenever anyone makes a “colourable imitation”: *Copyright Act*, s 2.

[118] What constitutes a “substantial” part of a work is a flexible notion and is a matter of fact and degree – “[a]s a general proposition, a substantial part of a work is a part of the work that represents a substantial portion of the author’s skill and judgment expressed therein”: *Cinar Corporation v Robinson*, 2013 SCC 73 at para 26 [*Cinar*].

[119] In considering whether there has been a reproduction of a substantial part of a work protected by copyright, regard must be had to the copyrighted work as a whole, rather than to isolated parts thereof: *Cinar*, above, at paras 35–36. For greater certainty, the focus is not upon whether that which is alleged to have been copied amounts to a substantial part of the defendant’s work: *Cinar*, above, at para 39. Moreover, the alteration of copied features or their integration into a work that is notably different from the copyrighted work does not necessarily preclude a determination in favour of the plaintiff: *Cinar*, above, at para 39.

[120] A “colourable imitation” of a work is a form of the original work that has been altered or modified in such a way as to deceive: *Rains v Molea*, 2013 ONSC 5016 at para 45, quoting May M. Cheng and Michael Shortt, “Colourable Imitation: The Neglected Foundation of Copyright Law” (2012) 17 *Intellectual Property* at 1131.

[121] In the absence of evidence of actual copying, an allegation of copyright infringement may be inferred from evidence of substantial similarity and access to the copyrighted work: *Philip Morris Products S.A. v Marlborough Canada Limited*, 2010 FC 1099 at para 320 [*Philip Morris*], *aff’d* 2012 FCA 201 at para 119; *Pyrrha Design Inc. v Plum and Posey Inc.*, 2019 FC 129 at para 121. However, this inference may be rebutted by establishing that the allegedly infringing work was created independently of the copyrighted work, even though recourse may have been had to common source material: *Philip Morris*, above, at para 320.

[122] Pursuant to paragraph 34.1(1)(b), in any civil proceedings taken under the *Act*, the author is presumed to be the owner of copyright.


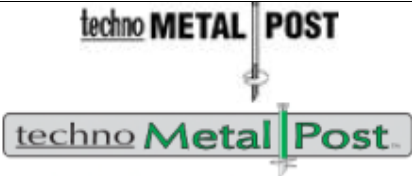

(2) Assessment

(a) *Introduction*

[111] As previously noted, the Copyrighted Works asserted by the Plaintiff consist of the Techno-Pieux logo covered by registration TMA562798, the Techno Metal Post logo (TMA638884) and the Plaintiff's post design: see paras 5 and 8 above.

[112] For convenience, the Copyrighted Works are reproduced immediately below:

Table 3 – The Plaintiff's Copyrighted Works

Logo TMA562798	Logo TMA638884	Post Design
		

[113] In the Summary Judgment Decision, I found that each of the Copyrighted Works represent original artistic works and that there was no genuine issue for trial in this regard: Summary Judgment Decision, at paras 135 – 140.

[114] I also noted that the Defendants did not dispute that Ms. Bertram had access to the Copyrighted Works. However, given the widespread use of helical piles in market participants' logos in this particular industry, I found that mere access to the Copyrighted Works did not necessarily support a strong inference of copying. Moreover, on cross-examination, Ms. Bertram

testified that she obtained the representation of the helical pile that appears in the Defendants' logos from something that Mr. Bergevin made in a ceramics class. She also stated that she and Mr. Bergevin consciously chose the colour red for their logos in an effort to "be as far away from green as possible" and to avoid confusing the marketplace. She added that they wanted to distinguish their mark by inserting the mathematical "less than" sign (<) towards the bottom of their helical pile, to convey the idea of engineering technology: Summary Judgment Decision, at paras 141-142.

[115] Based on the foregoing, I concluded that the Defendants had raised a genuine issue for trial as to whether they can rebut the presumption of copying that arises from their uncontested access to the Copyrighted Works. In view of that conclusion, I added that it was unnecessary to address the Plaintiff's allegation that the Defendants copied a "substantial" part of the Copyrighted Works.






(b) *The Parties' submissions*

[116] The Plaintiff submits that the Court should infer copying from the Defendants' access to the Copyrighted Works and from the substantial similarity of the disputed works.

[117] In this latter regard, the Plaintiff alleges that the substantial similarity is readily apparent from the following side-by-side comparisons, as well as the coaster that the Defendants say they used as a model for their post design:⁷

⁷The Defendants sometimes use other logos, including one with various cities included beside their helical pile. On cross-examination, Ms. Bertram acknowledged that the Defendants make use of the version without the city names, depicted above.

Table 4 – Comparison of the Disputed Works

Techno Pieux Work	Techno Piles Logos	Techno Piles' Alleged Model
		
		

[118] Specifically, the Plaintiff maintains that the helical pile designs set forth above have the same shapes, the same orientation of the screw piles (vertical with the point coming down on the left side), the same white shading going down the left side of the pile, and the same proportions (length/diameter). The Plaintiff adds that the hole(s) at the top of the piles are also lined up in the same orientation. The Plaintiff further notes that the Defendants' Techno Piles logo and helical pile image bear a closer resemblance to the Copyrighted Works than to the coaster depicted in the right-hand column of the chart above. In addition, the Plaintiff states that the Defendants have not identified any model that gave them the idea for their Techno Piles logo in the bottom-centre of Table 4 above.

[119] Given the foregoing, the Plaintiff submits that the similar elements of the Defendants' logo and helical pile image collectively represent a substantial part of the skill and judgment that its employees expressed in the Copyrighted Works. Consequently, it requests that the Court

conclude that the reproduction of the Defendants' Techno Piles logos constitutes an infringement of its copyright.

[120] In response, the Defendants maintain that Mr. Bergevin independently created the screw pile portion of their Techno Piles and Screw Pile Pros logo marks when he made the ceramic coaster depicted in the right-hand column of Table 4 above. Ms. Bertram then inserted that hand-drawn creation into what became the TECHNO Piles logos, on her computer. She stated that this took place long before the breakdown in the relationship between the Parties began to materialize.

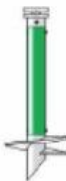




[121] The Defendants further assert that there was common source material widely available in the industry. In this regard, they provide the following examples of third-party logos that incorporate a stylized screw pile as a prominent feature of the logo:

Table 5 – Third Party Logos

[122] The Defendants add that several of the stylized screw piles used by third parties are far more similar to the screw pile used by the Plaintiff, than the Defendants' screw pile. Specifically, they state that the screw piles used by Post Tech Screw Piles and Pro Post Foundations bear a closer resemblance to the Plaintiff's screw pile than does their stylized screw pile:

Table 6 – Selected Helical Pile Images

				
Techno Pieux	Post Tech Screw Piles	Torsion Screw Piles	Pro Post Foundations	Techno Piles/ Screw Pile Pros

[123] In addition to the foregoing, the Defendants submit that there are substantial differences between the disputed logos. These include the differences in their colours,⁸ the differences in the screw portion of the depicted piles, and the differences in the number of holes at the top of the screw pile. In her affidavit, Ms. Bertram stated that the Defendants’ logos use a different font from the Plaintiff’s logo and do not use the underlining that appears under the word “techno” in the Plaintiff’s logos. On cross-examination, Ms. Bertram added that she and Mr. Bergevin consciously chose the colour red for their logos, in an effort to “be as far away from green as possible” and to avoid confusing the marketplace. She explained that they wanted to further distinguish their mark by inserting the mathematical “less than” sign (<) towards the bottom of their helical pile, to convey the idea of engineering technology.

[124] The Defendants also note that one of the creators of the Copyrighted Works, Ms. Nadia Tardif, was unable to identify any differences between the Plaintiff’s stylized helical pile and a real helical pile: Defendants’ Motion Record, at 952. The Defendants maintain that this evidence, together with the images of third party logos reproduced above, indicates a common source of

⁸ The helical piles in the Plaintiff’s logos are green, whereas they are red in the Defendants’ logos.

material for the disputed stylized logos. In support of this submission, the Defendants add that the first person to draw a penguin does not get to claim the exclusive right to do so. They assert that the fact that others who draw penguins may end up with a similar-looking image does not reflect copying, but rather that penguins look like each other.

[125] In the alternative, the Defendants submit that the Plaintiff has not provided a sufficient basis for the Court to determine that a “substantial part” of the Copyrighted Works has been copied.

(c) *Analysis*

[126] For the following reasons, I find that the Defendants’ Techno Piles design logo infringes the Plaintiff’s design logos registered as TMA562798 and TMA638884, which are reproduced in Table 4 above. However, I find that the Defendant’s stylized helical pile design does not infringe the Plaintiff’s helical pile design, which are reproduced in Tables 4 and 6 above.

[127] Insofar as the disputed design logos are concerned, I consider that they have a very high degree of similarity, despite the differences discussed at paragraph 123 above. This is readily apparent upon viewing the size-by-side portrayal in Table 4. When taken together, the specific similarities listed below give rise to an overall very substantial degree of similarity. In particular, the disputed design logos:

- Have the same first word, in lower case font, portrayed in essentially the same way;

- Have the stylized helical pile placed within the second word, which begins with a capital letter “P”;
- Have grey shading around the words, in a similar rectangular shape;
- Have somewhat similar stylized piles – in terms of their shape, their proportions relative to the words, their orientation (point coming down on the left-hand side), the white shading going down the left-hand side, and their dual rings at the top.

[128] Having regard to the foregoing, I consider that the disputed design logos bear a much closer resemblance to each other than either of them do to any of the third party design logos depicted in Table 5 above. This is so despite the differences identified by the Defendants, including regarding to the colours used in the logos (red versus green) and the fact that the Defendants’ stylized helical pile has a unique mathematical sign (<).

[129] Considering the very high degree of similarity between the disputed design logos, the Defendants have not rebutted the inference of copying that arises from a demonstration of such similarity and their access to the Plaintiff’s logos: see cases cited at paragraph 121 of the Summary Judgment Decision, reproduced at paragraph 110 above. Although the Defendants have provided evidence of independent creation their stylized helical pile (see discussion below), they have not provided any material evidence of their independent creation of their logo.

[130] For essentially the same reasons set forth at paragraph 127 above, I also find that the Defendants have copied a “substantial part” of the Plaintiff’s design logos. That is to say, the parts of the Defendants’ Techno Piles logo that I find have been copied from the Plaintiff’s Copyrighted design logos constitutes a substantial part of the Plaintiff’s design logos.

[131] I reach a different finding with respect to the disputed helical pile images. Taken by themselves, the side-by-side comparison reflected in the top row of Table 4, above does not leave the viewer with an impression of a degree of similarity that is materially greater than what each of them have to the various stylized piles of third parties that are depicted in Tables 5 and 6, above. Indeed, I agree with the Defendants that the Plaintiff’s stylized pile bears a closer resemblance to at least two of the other piles set forth in Table 5, above – namely, those of Post Tech Screw Piles and Pro Post Foundations, than to the Defendants’ stylized pile.

[132] When just the helical piles are viewed side by side, the presence of the mathematical sign (<) in the Defendants’ logo, is striking. This difference from the Plaintiff’s stylized pile is accentuated by the differences in colour (red versus green), and, to a lesser extent, by the number of holes at the top of the vertical pile. Based on the evidence of Mr. Bergevin and Ms. Bertram with respect to the creation of their stylized helical pile, as well as the prevalence of other stylized helical piles in their industry, I find that the Defendants’ stylized pile was created independently, without any conscious or unconscious copying of the Plaintiff’s stylized helical pile. For greater certainty, the Defendants have rebutted any presumption of copying that may have arisen based on their access to the Plaintiff’s Copyrighted Works.

[133] In summary, based on all of the foregoing, I conclude that the Defendants have infringed the Plaintiff's copyright in its design marks (TMA562798 and TMA638884). However, they have not infringed its copyright in its stylized helical pile.

[134] I pause to add that, in certain passages of its written submissions, the Plaintiff referred to the similarity between the screw pile image portion of Defendants' new Screw Piles Pros design logo.⁹ The Plaintiff also referred to the continued use and reproduction of the allegedly infringing works even after the Defendants' rebranded to Screw Piles Pros. However, during the hearing of this Motion, the Plaintiff clarified that it was not alleging that the Defendants' entire Screw Piles Pros logo infringes their design logos. The Plaintiff is simply seeking an injunction to prevent further use of Copyrighted Works by the Defendants and by other entities controlled by them, including Bergevin Contracting Ltd. and Screw Piles Pros Inc., which was incorporated on May 20, 2022. The Plaintiff also appeared to suggest that it wished to prevent the continued use of the stylized helical pile image that is used in the Screw Pile Pros logo. Given my conclusion that the Defendants' helical pile image does not infringe the Plaintiff's copyright in its own helical pile image, I will not accede to this request by the Plaintiff.

E. *Personal Liability of the Individual Defendants*

(1) Applicable principles and introduction

[135] It is common ground among the Parties that the test for imposing personal liability on a director and/or officer of a corporation is as follows:

⁹ See for example, paragraphs 20, 77, 81 and 88.

[T]here must be circumstances from which it is reasonable to conclude that the purpose of the director or officer was not the direction of the manufacturing and selling activity of the company in the ordinary course of his relationship to it but the deliberate, wilful and knowing pursuit of a course of conduct that was likely to constitute infringement *or reflected an indifference to the risk of it*. The precise formulation of the appropriate test is obviously a difficult one. Room must be left for a broad appreciation of the circumstances of each case to determine whether as a matter of policy they call for personal liability. [Emphasis added.]

Mentmore Manufacturing Co. v National Merchandise Manufacturing Co., 1978 CarswellNat, 14 at para 142; (1978), 89 DLR (3d) 195 at 204–205 (FCA) [***Mentmore***]:

[136] The first sentence of the passage quoted immediately above was adopted in *Cinar Corporation v Robinson*, 2013 SCC 73, at para 60: see also *Dunn's Famous International Holdings Inc v Devine*, 2021 FC 64, at para 20; and *Tommy Hilfiger Licensing Inc v Produits de Qualité IMD Inc*, 2005 FC 10 at paragraph 142.

[137] In the course of reaching the conclusion set forth in the quoted passage above, the Court in *Mentmore* cited (at paragraph 140) the following passage from *Normart Management Ltd v West Hill Redevelopment Co*, [1998], 37 OR (3d) 97 (OCA), at 102 [***Normart***]:

It is well established that the directing minds of corporations cannot be held civilly liable for the actions of the corporations

they control and direct unless there is some conduct on the part of those directing minds that is either tortious in itself *or exhibits a separate identity or interest from that of the corporations* such as to make the acts or conduct complained of those of the directing minds: see *Scotia McLeod Inc. v Peoples Jewellers Ltd.* (1995), 26 O.R. (3d) 481 at p. 491, 129 D.L.R. (4th) 711 (C.A.). [Emphasis added.]

[See also *Living Sky Water Solutions Corp v ICF Pty Ltd*, 2018 FC 876 [*Living Sky*], at paras 38-39.]

[138] In the Summary Judgment Decision, I found that there was a genuine issue to be tried with respect to whether the purpose underlying the impugned actions of Mr. Bergevin and Ms. Bertram amounted to a deliberate, wilful, and knowing pursuit of a course of conduct that was likely to constitute infringement *or reflected an indifference to the risk of it*. An additional issue that has been raised on this Motion is whether the actions in question exhibit a separate identity or interest from the interests of the Principal Corporate Defendants.

(2) The Parties' positions

(a) *The Plaintiff*

[139] The Plaintiff submits that the test for imposing personal liability on the Individual Defendants is satisfied in this case because Ms. Bertram and Mr. Bergevin intentionally engaged in a course of conduct that was likely to constitute infringement.

[140] In support of this position, the Plaintiff notes that the Individual Defendants are the only directors of the Corporate Defendants, and together make all major decisions about the businesses of the Corporate Defendants. This fact is not contested. The Plaintiff asserts that, given their time working as authorized distributors for the Plaintiff, Mr. Bergevin and Ms. Bertram acted with the full knowledge and reckless disregard of the Plaintiff's rights. The Plaintiff adds that Mr. Bergevin and Ms. Bertram actively cultivated confusion and demand for products associated with the Confusingly Similar Trade Marks/Trade Names. The Plaintiff states that such conduct is outside the scope of the legitimate duties of an officer or director of a company. The Plaintiff further contends that Mr. Bergevin and Ms. Bertram misled consumers in

their personal capacities, including by posting infringing content to their personal social media pages and by personally designing the infringing works.

(b) *The Defendants*

[141] In response, the Defendants maintain that the claims against the Individual Defendants are without basis and do not meet the test for piercing the corporate veil, as set forth at paragraph 135 above. They maintain that at all times, the Individual Defendants acted in their capacities as executives of the Principal Corporate Defendants.

[142] Among other things, the Defendants contend that when they posted materials on their personal social media accounts, they believed they were permitted to do so because they believed (and continue to believe) that the Principal Corporate Defendants had paid their dealership fees up until at least the end of 2021.¹⁰ They add that they did not pursue any interest that was separate from the interests of the Principal Corporate Defendants. They further maintain that they believed (and continue to believe) that their use of the TECHNO PILES/Techno Piles trademarks/trade names does not infringe the Registered Marks or the Copyrighted Works.

[143] Having regard to the foregoing, the Defendants assert that the present situation is not one in which it could be found that they “deliberately, wilfully or knowingly pursued a course of conduct to incite infringement.” For greater certainty, they underscore that they had a legitimate basis to believe they were entitled to take the actions that are now impugned by the Plaintiff. They also note that it was necessary to send their various e-mail and social media

¹⁰ The Court understands that the Defendants are maintaining this position in the Alberta Action.

communications on May 30, 2021 because the e-mail address they had been using was being taken away from them by the Plaintiff – allegedly in violation of their contractual rights, which continues to be the subject of litigation in the Alberta Action.

[144] In cross-examination on her affidavit, Ms. Bertram explained that she simply “shared” material that had been posted by the Corporate Defendants. However, some of the material that was allegedly “shared” on her personal Facebook page was accompanied by new text written by Ms. Bertram. The same is true for material that was posted or reposted on Mr. Bergevin’s personal Facebook page. There were also postings or repostings of disputed material on their respective Twitter accounts and in Ms. Bertram’s profile on LinkedIn.

(3) Assessment

[145] For the following reasons, I find that the test for imposing personal liability on the Individual Defendants is not met.

[146] The conduct that was the focus of the Plaintiff’s submissions on this issue is summarized at paragraph 71 above.

[147] The evidence does not establish on a balance of probabilities that Ms. Bertram or Mr. Bergevin deliberately, wilfully or knowingly engaged in any conduct that was directed towards infringing the Registered Marks or the Copyrighted Works. Nor does the evidence establish that Ms. Bertram or Mr. Bergevin were indifferent to the risk of infringing the Registered Marks or the Copyrighted Works. Instead, they appear to have held an honest, albeit mistaken, belief that

the TECHNO PILES/Techno Piles trademarks/trade names and design logos were sufficiently different from the Registered Marks and the Copyrighted Works to not constitute infringing works. In reaching this finding, I place particular weight on the following evidence from Ms. Bertrand, which I accept:

- She and Mr. Bergevin believed that the Plaintiff had breached the terms of the distribution agreements to which TMP Medicine Hat and TMP Fort McMurray were parties. I understand that this remains a matter of dispute in the Alberta Action.
- She and Mr. Bergevin believed that their TECHNO PILES/Techno Piles trademarks/trade names, design logo, and stylized helical pile were sufficiently different from the Registered Marks and the Copyrighted Works as to not constitute infringing works – see in particular the evidence summarized at paragraph 123 and 131-132 above.
- She and Mr. Bergevin believed (and continue to believe) that they are entitled to use the CCMC certification number that applies to the Plaintiff's products and processes, which the Defendants maintain are virtually identical to their own products and processes: see footnote 6, above.

[148] It bears underscoring that the communications posted to the personal social media accounts of Ms. Bertram and Mr. Bergevin in connection with the Defendants' initial corporate

change from Techo Metal Post to TECHNO PILES/Techno Piles fell well short of achieving the purported objective of advising the market that the Defendants were no longer associated with the Plaintiff. I have found that those communications contributed to confusion in the marketplace. This is particularly true with respect to the messages sent on May 30, 2021, stating that the Defendants were “rebranding” and that “[w]e still have the same great companies only the name is changing.” This language was inaccurate, sloppy, and even irresponsible. This being said, I do not believe these communications were intended to deceive or that they rose to the level of being reckless: *Monsanto Canada Inc v Schmeiser*, [2001] FCJ No 436, at paras 144-145; *aff’d* 2002 FCA 309, 2004 34.¹¹

[149] Likewise, I find that the conduct of Ms. Bertram and Mr. Bergevin did not “exhibit a separate identity or interest” from the interests of the Principal Corporate Defendants: *Living Sky*, above, at para 39; see also *Normart*, above. At all times, they appear to have been entirely focused on the interests of the Principal Corporate Defendants.

[150] Based on all of the foregoing, I conclude that Ms. Bertram and Mr. Bergevin are not personally liable for the infringing conduct of the Principal Corporate Defendants or for the conduct that I have found constitutes a contravention of the passing off provisions in paragraph 791)(b) of the *TM Act*.

F. *Techno Piles Inc.*

¹¹ It appears that the issue of personal liability was not argued on appeal: *Schmeiser v Monsanto Canada Inc*, 2002 FCA 309, at para 73.

[151] The Defendants submit that Techno Piles Inc. is not a proper party to the within action. In support of this position, they note that this entity has never engaged in any operations or used any trademarks in association with any goods or services. For greater certainty, they add that it has not made any transactions, distributions, conveyances, purchases, sales or transfers. Nor does it have a registered GST or HST account, a registered payroll number, or a bank account. The Defendants add that they incorporated Techno Piles Inc. solely because they were having issues with the Plaintiff, and that the company was ultimately “shelved”. They maintain that the only use made of it was for registering the domain name www.technopilesinc.com and for sending e-mails when the Plaintiff cut off their access to the e-mail that the Principal Corporate Defendants used prior to their split from the Plaintiff. They assert that this domain name is no longer being used due to the Defendants rebrand to Screw Pile Pros.

[152] In response, the Plaintiff notes that Techno Piles Inc. is the owner of the www.technopiles.com domain name registration. As such, the Plaintiff states that Techno Piles Inc. is presumptively responsible for the infringing content that was posted on the landing page of technopilesinc.com and for the infringing e-mails that were sent from that address at the time of the Defendants’ initial rebranding to Techno Piles: see paragraph 71 above.

[153] I agree with the Plaintiff’s position. For the reasons advanced by the Plaintiff and summarized immediately above, the Defendant Techno Piles Inc. is a proper party to the within action and is jointly liable for infringing the Registered Marks and the Plaintiff’s copyright in its two design marks (TMA562798 and TMA638884).

[154] My understanding is that despite the fact that Techno Piles Inc. is a dormant company, the Plaintiff wishes to ensure that the Order it sought would be directly enforceable against this Defendant. As stated in the Summary Judgment, maintaining Techno Piles Inc. as a Defendant is the appropriate manner in which to achieve this result: Summary Judgment Decision, at para 194.

VII. Remedies

[155] The Plaintiff seeks a broad range of declaratory, injunctive, and mandatory relief against the Defendants, together with an award of \$40,000 in damages.

A. *Declaratory, Injunctive and Mandatory Relief*

[156] Regarding declaratory relief, the Plaintiff seeks declarations that the Defendants have:

- infringed and are deemed to infringe its rights in the Registered Marks, contrary to sections 19 and 20 of the *TM Act*;
- used the Registered Marks in a manner likely to have the effect of depreciating the value of the goodwill attached thereto, contrary to section 22 of the *TM Act*;
- directed attention to their goods, services, and business in such a way as to cause or be likely to cause confusion in Canada between the Defendants' goods,

services and business and those of the Plaintiff, contrary to paragraph 7(b) of the *TM Act*; and

- infringed and are deemed to have infringed the Plaintiff's Copyrighted Works, contrary to sections 3 and 27 of the *Copyright Act*.

[157] Insofar as the injunctive relief sought is concerned, in essence, it corresponds to the alleged contraventions of the *TM Act* and the *Copyright Act*, described above.

[158] The mandatory relief sought essentially consists of the destruction of all allegedly infringing articles in the Defendants' possession, custody or power; the change of the names of the three corporate Defendants; and the delivery up of the domain name registration for the technopiles.com domain name.

[159] Based on the findings I made in parts VI.A – F. above, I will grant the declaratory injunctive and directive relief sought by the Plaintiff against the Corporate Defendants and certain related individuals/entities, except with respect to the alleged breach of the Plaintiff's copyright in its stylized helical pile image. For the reasons set forth at paragraphs 131-132 above, I find that the Defendants did not infringe that particular Copyrighted Work.

[160] The Order granting the foregoing relief is attached at Appendix 1 to these reasons.

B. *Damages*

(1) Trademark infringement

[161] Pursuant to subsection 53.2(1) of the *TM Act*, the Court may make any order that it considers appropriate in the circumstances, including an order for the recovery of damages or profits.

[162] The Plaintiff seeks compensatory damages in an amount of \$20,000 for the Defendants' infringement of the Registered Trademarks.¹²

[163] In making this request, the Plaintiff acknowledges that it has not provided any evidence of actual damages or profits earned by the Defendants as a result of their infringing activities. The Plaintiff explains that such proof was difficult to obtain in the absence of expert evidence, which was not adduced on this Motion for a Summary Trial. Nevertheless, the Plaintiff notes that the Court may award damages for loss of goodwill without proof of actual damage: *Harley Davidson*, above, at para 52; *Pick v 1180475 Alberta Ltd*, 2011 FC 1008, at paras 49-51 [**"Pick"**]; see also *Lululemon Athletica Canada Inc v Campbell*, 2022 FC 194, at para 45 [**"Lululemon"**]; and *Trans-High Corporation v Hightimes Smokeshop and Gifts Inc*, 2013 FC 1190, at paras 24-26; and *Ragdoll Productions (UK) Ltd v Jane Doe*, 2022 FCT 918, at paras 43-45 [**"Ragdoll"**].

[164] In support of its request for an award of \$20,000, the Plaintiff notes that TMP Fort McMurray had substantial revenues during the Relevant Period. In this regard, a chart at page

¹² The Plaintiff did not seek any damages in respect of passing off.

1145 of the Plaintiff's Motion Record indicates that such revenues amounted to \$299,210.82 during that timeframe.¹³ The Plaintiff adds that Screw Pile Pros' revenue was \$38,197.34 for the period April 12, 2022 to June 30, 2022; and \$138,452.58 for the (slightly overlapping) period June 1, 2023 to August 7, 2022. Given that the Plaintiff did not allege infringement of the Registered Marks after May 2022, it is not immediately apparent why these figures were provided.¹⁴

[165] Evidence regarding TMP Medicine Hat's revenues during the Relevant Period was not provided.

[166] The Plaintiff further notes that evidence adduced by the Defendants shows that 38% of the Defendants' customers in 2021 were returning customers. This is consistent with the years 2018–2020, when returning customers accounted for 39%, 40%, and 36% of the Defendants' revenues, respectively: see para 55, above. Coincidentally, another 38% revenues of the Defendants' revenues in 2021 were from “their own network”. The Plaintiff maintains that it is reasonable to infer that the Defendants' network includes contacts made during the preceding years at trade shows and in other circumstances when Ms. Bertram and Mr. Bergevin were dressed in Techno Metal Post clothing and handed out Techno Metal Post business cards, as acknowledged by Ms. Bertram: Plaintiff's Motion Record, at 965-966.

¹³ The Plaintiff asserts that TMP Fort McMurray's revenues amounted to \$641,791.00 during the longer period May 30, 2021 to August 2022. It is not clear why there is such a discrepancy between this figure and the \$299,210.82 amount for the Relevant Period.

¹⁴ See paragraph 14 above.

[167] The Defendants respond that the Plaintiff's claim of having suffered damage is belied by the fact that its gross revenue in Alberta for the period February 2021 to January 2022 increased to \$1,781,000, from \$1,600,000 in the period February 2020 to January 2021. The Defendants add that the Plaintiff failed to respond to an undertaking requesting a breakdown of its revenues by dealer. The Defendants request the Court to draw the adverse inference that the Plaintiff's regional sales figures would have demonstrated that it did not lose revenues in any region of Alberta during the Relevant Period. The Court is prepared to draw that adverse inference.

[168] The Defendants further assert that the evidentiary record indicates that if the Plaintiff did experience any sales losses, they were due to other factors, including the fact that its prices for the Relevant Goods and Services were higher than those of its competitors: Defendants' Motion Record, at 538 and 590.

[169] Ultimately, the Defendants submit that if they are found to have infringed the Relevant Marks, the Plaintiff should be awarded no more than \$5,000 in compensatory damages. The Defendants maintain that this would be appropriate based on the fact that in *Pick*, the Court awarded total compensatory damages of \$10,000 for lost sales *and* damages to reputation and goodwill: *Pick*, above, at para 53.

[170] However, *Pick* is distinguishable. Among other things, that case involved a default judgment and the \$10,000 award was what the Plaintiff requested. Moreover, the infringement in that case was for a significantly shorter period (approximately 6 months), it involved sales at only two local locations (a farmer's market and a retail bakery), and it concerned much less

expensive wares and services (baked goods and related services). I will add in passing that, adjusted for inflation, the \$10,000 award issued in 2011 is equivalent to approximately \$13,000 in today's dollars.¹⁵ Moreover, there was no evidence of lost sales in *Pick*, above, so nothing really turns on the Court's reference to "lost sales."

[171] A somewhat better precedent for the present purposes is *1196278 Ontario Inc DBA Sassafraz v 815470 Ontario Ltd DBA Sassfras Coastal Kitchen and Bar*, 2022 FC 116 [*"Sassafraz"*]. There, the Court granted the applicant's request for "nominal" damages of \$15,000 for an ongoing infringement of the applicant's registered trademark that, as a practical matter, persisted for roughly a similar amount of time as the infringing activities in the present case.¹⁶ Another similarity to the present case is that the respondent was advised of the applicant's rights in its registered trademark approximately contemporaneously with the launch of its business, yet persisted with its infringement. However, a noteworthy difference from the present situation is that the infringing activities were essentially confined to a single restaurant location in the Niagara Peninsula, although the defendant also used its infringing marks/trade name on its social media accounts. This difference, together with the similarities to the present situation discussed above, would suggest that the \$20,000 in damages sought by the Plaintiff is entirely reasonable. The same is true when one considers the present value of the damages award granted in *Pick*, above, together with the distinguishing facts mentioned in the immediately preceding paragraph above.

¹⁵ See Inflation Calculator - Bank of Canada.

¹⁶ Although the Respondent in *Sassafraz* technically began its infringing activities when it opened its social media accounts in February 2020, its restaurant did not open until the end of June of that year, and was then forced to close for several lengthy periods due to the COVID-19 pandemic. So, that restaurant operated for approximately one year prior to the Court's decision in February 2022.

[172] In the absence of any evidence of lost sales or other actual damages suffered from the Defendants' infringement, the Court must rely on "the available evidence, reasonable inferences and a dose of common sense": *Louis Vuitton Malletier SA v Wang*, 2019 FC 1389, at para 143 [**Wang**].

[173] Put differently, the Plaintiff is "entitled to the Court's best estimate of [its] damages without necessarily being limited to nominal damages", whatever "nominal" may mean: *Ragdoll*, above, at para 45.

[174] The point of departure is that the goodwill associated with registered trademarks will be reduced to some extent whenever those marks have been infringed by sales of goods or services over a sustained period of time: *Wang*, above, at para 122, quoting *Fox on Canadian Law of Trade-Marks and Unfair Competition*, by Kelly Gill, 4th ed., #13.6(e).

[175] The more significant the nature, scope, and duration of the infringing activity, the greater the damages that may be inferred. However, account must also be taken of other factors that may be relevant, including the extent of any quality differences between the infringing goods and services and those of the Plaintiff; the extent of likely confusion in the market; and any intent, willful blindness, recklessness or disregard for the Plaintiff's rights after having received notice of them.

[176] In my view, the following factors weigh in favour of awarding the full \$20,000 that the Plaintiff is seeking, which I consider to be conservative:

- The duration of the Defendants' infringing activity (approximately one year).
- The fact that the Defendants sold their infringing goods and services in at least six different cities in Alberta during the Relevant Period.
- The high level of TMP Fort McMurray's revenues during the relevant period (close to \$300,000).
- The fact that approximately 38% of the Defendants' customers during the Relevant Period were "returning customers", while another 38% were from the Defendants' "own network", which was largely built up while they were distributors for the Plaintiff.
- The significant nature of the likely confusion caused by the Defendants' infringing goods and services, and their behaviour/communications at the time of their "rebranding" from Techno Metal Post to Techno Piles: see paragraphs 71 and 147 above.
- The consequential loss of control over the Registered Marks, and the related "blurring" and "whittling away" of the image of those marks and their power to distinguish the Plaintiff's goods and services.

- The absence of any evidence regarding the Defendant’s profit margins – from which I draw an adverse inference that they were likely significant.

[177] In concluding that an award of \$20,000 would be appropriate, I have taken into account the fact that the infringing goods and services were virtually identical to the Plaintiff’s Relevant Goods and Services. In other words, they were not inferior goods and services. I have also considered that the Defendants “rebranded” a second time, and thereby ceased their infringing activities, following the issuance of the Summary Judgment Decision, where I found that four of the five factors listed in subsection 6(5) of the *TM Act* weighed in favour of the Plaintiff. In addition, I have considered that the Defendants appear to have honestly believed they had the legal right to use the Relevant Marks for much of the Relevant Period.

(2) Copyright infringement

[178] Pursuant to paragraph 38.1(1)(a) of the *Copyright Act*, a copyright owner may elect an award of statutory damages “in a sum of not less than \$500 and not more than \$20,000 that the court considers just, with respect to all infringements involved in the proceedings *for each work or other subject matter*, if the infringements are for commercial purposes” (emphasis added).

[179] Having regard to paragraph 38.1(1)(a), the Plaintiff submits that an award of \$10,000 per work should be awarded:

“... taking into consideration the bad faith of the Defendants and [their] intentional adoption of a number of copyrighted works that reproduce the Plaintiff’s Copyrighted Works, the widespread infringement and reproduction of the Defendants’ copyrighted works in many different contexts, and the continued use and

reproduction of the infringing works even after the Defendants rebrand to Screw Pile Pros.

[180] For clarity, and to avoid any suggestion of double recovery, the Plaintiff only seeks compensation for infringement of its screw pile design and the TECHNO PIEUX design logo, but not the TECHNO METAL POST design logo.

[181] Considering my conclusion that the Defendants' stylized screw pile design does not infringe the Copyrighted Works, I will not be granting the \$10,000 in statutory damages requested in respect of the alleged infringement of the Plaintiff's screw pile design.

[182] Turning to the \$10,000 in damages requested in respect of the infringement of the Plaintiff's TECHNO PIEUX design logo, subsection 38.1(5) of the *Copyright Act* requires the Court to consider all relevant factors, including (a) the good faith or bad faith of the defendant, (b) the conduct of the parties before and during the proceedings, and (c) the need to deter other infringements of the copyright in question.¹⁷

[183] Insofar as "good faith or bad faith" is concerned, I disagree with the Plaintiff's allegation of bad faith. As discussed at paragraph 147 above, the Defendants appear to have held an honest, albeit mistaken, belief that the TECHNO PILES/Techno Piles trademarks/trade names and design logos were sufficiently different from the Registered Marks and the Copyrighted Works as to not constitute infringing works. Moreover, the Defendants demonstrated good faith by

¹⁷ A fourth factor, set forth in paragraph 38.1(d), is limited to infringements for non-commercial purposes.

rebranding to Screw Piles Pros following the Summary Judgment Decision, despite the fact that the Plaintiff's motion was unsuccessful.

[184] Regarding “the conduct of the parties before and during the proceedings”, there is very little evidence in the record concerning the alleged “continued use and reproduction of the infringing works even after the Defendants rebrand to Screw Pile Pros.” However, it is relevant to consider that the Defendants persisted with their infringing activities for approximately one year, and on a fairly widespread basis, after having been advised to stop using the Registered Marks, which included the TECHNO PIEUX design logo. It is also relevant to consider the “inaccurate, sloppy and even irresponsible” nature of the communications issued by the Defendants at the time of their rebrand from TECHNO METAL POST to TECHNO PILES/techno piles: see para 148 above.

[185] The Defendants submit that their conduct is much less egregious than the conduct of the respondent in *Wing v Van Velthuizen (cob Gratitude Press Canada)*, [2000] FCJ No 190, at paragraph 74 [**“Wing”**], where the Court granted statutory damages of \$10,000. In granting that award, the Court noted the “blatant” and “reprehensible” nature of the respondent’s conduct, including the reproduction of the infringed work in its entirety and the respondent’s attempt to “sell” the copyright back to the applicant. The Defendants in the present case maintain that their conduct was not similarly blatant, as they attempted to distinguish their works from the Plaintiff’s Copyrighted Works: see para 123 above).

[186] I pause to note that the inflation-adjusted value of the \$10,000 damages award in *Wing* is approximately \$16,418.70.¹⁸

[187] The Defendants maintain that the facts in the present case are closer to those in *Young v Thakur*, 2019 FC 835 at paragraph 64 “[*Young*”], where the Court awarded statutory damages of \$1,000 in respect of each of two works that were infringed. In making that award, the Court noted that there were no aggravating factors similar to those noted in the jurisprudence when statutory damages at the higher end of the range have been awarded. The Defendants submit that in the absence of evidence of such aggravating factors in the present case, statutory damages of \$1,000 are appropriate, in accordance with this Court’s decision in *Young*.

[188] However, *Young* is distinguishable because the Respondents in *Young* attested that they did not make any profit and there was no evidence to the contrary. In addition, the infringing activity in *Young* simply consisted of the posting of a music video and a related sound recording on (i) the website of the Respondents (who produced the video for the applicants), and (ii) Vimeo, a video hosting, sharing, and services platform. By contrast, I consider it appropriate to draw an adverse inference that the Defendants profited from their infringing conduct: see paragraph 176 above. Moreover, the Defendants engaged in repeated infringements of the Plaintiff’s Copyrighted Works over the course of approximately one year.

[189] Considering all of the foregoing, I find that the award of \$10,000 requested by the Plaintiff is reasonable. In summary, while the Defendants’ conduct cannot be described as

¹⁸ See <https://bankofcanada.ca/rates/related/inflation-calculator/r/>.

“blatant”, “reprehensible” or as having been in “bad faith”, their market communications were “inaccurate, sloppy and even irresponsible”: see para 148 above. In addition, the Defendants persisted with their infringing activities for approximately one year after having been advised by the Defendant to stop using the Plaintiff’s works. Finally, I find that there is a need to deter others from engaging in similarly infringing conduct. This is so despite the fact that the Defendants rebranded to “Screw Pile Pros”, and thereby ceased their infringing activities, after the Summary Judgment Decision was issued.

(3) Summary

[190] In conclusion, I find that it appropriate to award compensatory damages of \$20,000 for the Defendants’ infringement of the Plaintiff’s Registered Marks; and to award statutory damages of \$10,000 for the Defendants’ infringement of the Plaintiff’s TECHNO Pieux design logo. The Order awarding these damages is attached at Appendix 1 to these reasons.

VIII. Costs

[191] Shortly before the hearing of this Motion, I issued a Direction encouraging the Parties to attempt to reach an agreement regarding a lump sum amount of costs to be paid to the prevailing party. In the event that the Parties were unable to reach such an agreement, they were directed to provide submissions, preferably in support of a lump sum cost award.

[192] At the end of the hearing, I was advised that the Parties had agreed to fix costs at \$10,000, on the understanding that the prevailing party’s entitlement would depend on whether

the decision is more favourable to the Plaintiff than an offer that was apparently made before the hearing on this Motion for summary trial. This is something the Parties will discuss. If they are unable to reach an agreement, they may return to seek an Order from the Court.

APPENDIX 1 – ORDER

Court File No. T-969-21

FEDERAL COURT

BETWEEN

TECHNO-PIEUX INC.

PLAINTIFF

AND:

**TECHNO PILES INC., TECHNO METAL POST MEDICINE HAT INC., TECHNO
METAL POST FORT MCMURRAY INC., MATHIEU BERGEVIN, and RONDA
BERTRAM**

DEFENDANTS

ORDER

UPON MOTION filed August 17, 2022, on behalf of the Plaintiff for Summary Trial against the Defendants;

AND UPON reviewing the written materials filed by the Parties;

AND UPON considering the oral submissions of the Parties made on August 31, 2022;

AND UPON considering the attached Reasons for Order;

IT IS HEREBY ORDERED THAT:

- (a) The Defendants have infringed and are deemed to have infringed the Plaintiff's exclusive rights in Canadian trademark Nos. TMA562798, TMA596228, TMA638884, and TMA950281 (the "Registered Marks"), as set out in paragraph 5 of the attached Reasons for Order, contrary to sections 19 and 20 of the *Trademarks Act*,
- (b) The Defendants have used the Registered Marks in a manner likely to have the effect of depreciating the value of the goodwill attaching thereto, contrary to section 22 of the *Trademarks Act*,
- (c) The Defendants have directed public attention to their goods, services and business in such a way as to cause or to be likely to cause confusion in Canada between the Defendants'

goods, services, and business and the goods, services and business of the Plaintiff, contrary to section 7(b) of the *Trademarks Act*;

- (d) The Defendants have infringed and are deemed to have infringed the copyright in the Techno Pieux design logo and the Techno Metal Post design logo (the “**Copyrighted Works**”), as set out at paragraphs 5 and 8 of the attached Reasons for Order, contrary to sections 3 and 27 of the *Copyright Act*;
- (e) The Defendants, by themselves and their servants, workmen, agents and employees, affiliates, related entities, or corporations or other entities under their direction or control, are hereby permanently restrained and enjoined from, directly or indirectly, doing any of the following acts:
 - i. further infringing the Registered Marks;
 - ii. using the Registered Marks, the trademark TECHNO PILES, the trade name and corporate name Techno Piles Inc., the trade name and corporate name Techno Metal Post Fort McMurray Inc., the trade name and corporate name Techno Metal Post Medicine Hat Inc., and any words, or combination of words, or any other design, likely to be confusing with the Registered Marks, as or in a trademark or trade name, or for any other purpose;
 - iii. depreciating the value of the goodwill attaching to the Registered Marks;
 - iv. directing public attention to any of the Defendants’ goods and services in such a way as to cause or to be likely to cause confusion between the goods services and business of the Defendants and the goods, services and business of the Plaintiff, as contemplated by paragraph (c) above; and
 - v. further infringing copyright in the Copyrighted Works;
- (f) The Defendants, at their own expense and within a time and upon such terms as may be fixed by this Honourable Court, shall destroy all articles in their possession, custody or power which offend in any way against any order which is made herein, and provide the Plaintiff with a signed representation under oath that such destruction has taken place;

- (g) The Defendants, at their own expense and within a time and upon such terms as may be fixed by this Honourable Court, shall deliver up and transfer the domain name registration for the technopilesinc.com domain name to the Plaintiff;
- (h) The Defendants shall pay forthwith to the Plaintiff the amount of \$30,000, as damages; and
- (i) The Defendants Techno Piles Inc., Techno Metal Post Fort McMurray Inc., and Techno Metal Post Medicine Hat Inc., at their own expense and within a time and upon such terms as may be fixed by this Honourable Court, change their respective registered corporate names to names that do not offend against the Order of this Honourable Court.

“Paul Crampton”

Chief Justice

APPENDIX 2: RELEVANT STATUTORY PROVISIONS

Trademarks Act, RSC 1985, c T-13

Interpretation

Definitions

2 *distinctive*, in relation to a trademark, describes a trademark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or that is adapted so to distinguish them; (*distinctive*)

[...]

When mark or name confusing

6 (1) For the purposes of this Act, a trademark or trade name is confusing with another trademark or trade name if the use of the first mentioned trademark or trade name would cause confusion with the last mentioned trademark or trade name in the manner and circumstances described in this section.

[...]

What to be considered

6 (5) In determining whether trademarks or trade names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including

(a) the inherent distinctiveness of the trademarks or trade names and the extent to which they have become known;

Définitions et interprétation

Définitions

2 *distinctive* Se dit de la marque de commerce qui distingue véritablement les produits ou services en liaison avec lesquels elle est employée par son propriétaire de ceux d'autres personnes, ou qui est adaptée à les distinguer ainsi. (*distinctive*)

[...]

Quand une marque ou un nom crée de la confusion

6 (1) Pour l'application de la présente loi, une marque de commerce ou un nom commercial crée de la confusion avec une autre marque de commerce ou un autre nom commercial si l'emploi de la marque de commerce ou du nom commercial en premier lieu mentionnés cause de la confusion avec la marque de commerce ou le nom commercial en dernier lieu mentionnés, de la manière et dans les circonstances décrites au présent article.

[...]

Éléments d'appréciation

6 (5) En décidant si des marques de commerce ou des noms commerciaux créent de la confusion, le tribunal ou le registraire, selon le cas, tient compte de toutes les circonstances de l'espèce, y compris :

a) le caractère distinctif inhérent des marques de commerce ou noms commerciaux, et la mesure dans laquelle ils sont devenus connus;

(b) the length of time the trademarks or trade names 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 or trade names, including in appearance or sound or in the ideas suggested by them.

[...]

Unfair Competition and Prohibited Signs

Prohibitions

7 No person shall

(b) direct public attention to his goods, services or business in such a way as to cause or be likely to cause confusion in Canada, at the time he commenced so to direct attention to them, between his goods, services or business and the goods, services or business of another;

[...]

Rights conferred by registration

19 Subject to sections 21, 32 and 67, the registration of a trademark in respect of any goods or services, unless shown to be invalid, gives to the owner of the trademark the exclusive right to the use throughout Canada of the trademark in respect of those goods or services.

Infringement

20 (1) The right of the owner of a registered trademark to its exclusive use is deemed to be

b) la période pendant laquelle les marques de commerce ou noms commerciaux ont été en usage;

c) le genre de produits, services ou entreprises;

d) la nature du commerce;

e) le degré de ressemblance entre les marques de commerce ou les noms commerciaux, notamment dans la présentation ou le son, ou dans les idées qu'ils suggèrent.

[...]

Concurrence déloyale et signes interdits

Interdictions

7 Nul ne peut :

b) appeler l'attention du public sur ses produits, ses services ou son entreprise de manière à causer ou à vraisemblablement causer de la confusion au Canada, lorsqu'il a commencé à y appeler ainsi l'attention, entre ses produits, ses services ou son entreprise et ceux d'un autre;

[...]

Droits conférés par l'enregistrement

19 Sous réserve des articles 21, 32 et 67, l'enregistrement d'une marque de commerce à l'égard de produits ou services, sauf si son invalidité est démontrée, donne au propriétaire le droit exclusif à l'emploi de celle-ci, dans tout le Canada, en ce qui concerne ces produits ou services.

Violation

20 (1) Le droit du propriétaire d'une marque de commerce déposée à l'emploi exclusif de cette dernière est réputé être violé par une

infringed by any person who is not entitled to its use under this Act and who

(a) sells, distributes or advertises any goods or services in association with a confusing trademark or trade name;

[...]

Depreciation of goodwill

22 (1) No person shall use a trademark registered by another person in a manner that is likely to have the effect of depreciating the value of the goodwill attaching thereto.

Copyright Act, RSC 1985, c C-42

Copyright in works

3 (1) For the purposes of this Act, copyright, in relation to a work, means the sole right to produce or reproduce the work or any substantial part thereof in any material form whatever, to perform the work or any substantial part thereof in public or, if the work is unpublished, to publish the work or any substantial part thereof, and includes the sole right

(a) to produce, reproduce, perform or publish any translation of the work,

[...]

and to authorize any such acts.

Infringement of Copyright

Infringement Generally

27 (1) It is an infringement of copyright for any person to do, without the consent of the owner of the copyright, anything that by this

personne qui est non admise à l'employer selon la présente loi et qui :

a) soit vend, distribue ou annonce des produits ou services en liaison avec une marque de commerce ou un nom commercial créant de la confusion;

[...]

Dépréciation de l'achalandage

22 (1) Nul ne peut employer une marque de commerce déposée par une autre personne d'une manière susceptible d'entraîner la diminution de la valeur de l'achalandage attaché à cette marque de commerce.

Droit d'auteur sur l'oeuvre

3 (1) Le droit d'auteur sur l'oeuvre comporte le droit exclusif de produire ou reproduire la totalité ou une partie importante de l'oeuvre, sous une forme matérielle quelconque, d'en exécuter ou d'en représenter la totalité ou une partie importante en public et, si l'oeuvre n'est pas publiée, d'en publier la totalité ou une partie importante; ce droit comporte, en outre, le droit exclusif :

a) de produire, reproduire, représenter ou publier une traduction de l'oeuvre;

[...]

Est inclus dans la présente définition le droit exclusif d'autoriser ces actes.

Violation du droit d'auteur

Règle générale

27 (1) Constitue une violation du droit d'auteur l'accomplissement, sans le consentement du titulaire de ce droit, d'un

Act only the owner of the copyright has the right to do.

[...]

acte qu'en vertu de la présente loi seul ce titulaire a la faculté d'accomplir.

[...]

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-969-21

STYLE OF CAUSE: TECHNO-PIEUX INC. v TECHNO PILES INC.,
TECHNO METAL POST MEDECINE HAT INC.,
MATHIEU BERGEVIN, AND RONDA BERTRAM

PLACE OF HEARING: HEARD BY VIDEOCONFERENCE

DATE OF HEARING: AUGUST 31, 2022

ORDER AND REASONS: CRAMPTON C.J.

DATED: APRIL 24 2023

APPEARANCES:

R. Nelson Godfrey
Sarah Li

FOR THE PLAINTIFF/
DEFENDANT BY COUNTERCLAIM

Kyle H. T. Smith

FOR THE DEFENDANTS/
PLAINTIFFS BY COUNTERCLAIM

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Parlee McLaws LLP
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PLAINTIFFS BY COUNTERCLAIM