

Federal Court of Appeal



Cour d'appel fédérale

Date: 20130115

**Docket: A-2-12
A-3-12**

Citation: 2013 FCA 6

**CORAM: DAWSON J.A.
TRUDEL J.A.
STRATAS J.A.**

BETWEEN:

MÖVENPICK HOLDING AG

Appellant

and

EXXON MOBIL CORPORATION

and

**ATTORNEY GENERAL OF CANADA
(REGISTRAR OF TRADE-MARKS)**

Respondents

Heard at Ottawa, Ontario, on January 15, 2013.

Judgment delivered from the Bench at Ottawa, Ontario, on January 15, 2013.

REASONS FOR JUDGMENT OF THE COURT BY:

STRATAS J.A.

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REASONS FOR JUDGMENT OF THE COURT
(Delivered from the Bench at Ottawa, Ontario, on January 15, 2013)

STRATAS J.A.

[1] The appellant appeals from the judgments of the Federal Court dated December 11, 2011

(*per* Harrington J.): 2011 FC 1397.

[2] The Federal Court found that the decisions of the Registrar of Trade-Marks dated August 3, 2010 (2010 TMOB 125 and 2010 TMOB 126) were reasonable. The Registrar dismissed the appellant's opposition to the registration of the "MARCHÉ EXPRESS & DESIGN" trade-mark application no. 1,124,171 and the "MARCHÉ EXPRESS" trade-mark application no. 1,124,172.

[3] Before the Federal Court, the appellant adduced new evidence. The Federal Court found as a finding of mixed law and fact, suffused by fact, that this new evidence was not material as it would not have changed the Registrar's findings and conclusions. In this Court, the appellant has not submitted that the Federal Court's finding of immateriality is vitiated by palpable and overriding error.

[4] Accordingly, in essence, these are appeals from judgments upholding the decisions of the administrative decision-maker, here the Registrar, as reasonable based on the record before the Registrar.

[5] The Federal Court found that the Registrar applied proper legal principles to the facts before her.

[6] The core of the Registrar's holding is in paragraphs 61-63 of her decisions:

[61] When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application and registration that govern [*Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)]

[62] The Opponent submits that the Applicant's services include fast food services and points to evidence establishing that convenience stores and gas stations now offer a wider variety of ready-to-go food items, which it argues falls within the scope of restaurant services, necessarily overlapping with its services [see Brennan affidavit Exhibits C, D and E].

[63] The parties' respective statements of services must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording [see *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1994), 55 C.P.R. (3d) 463 (F.C.T.D.), affd. 68 C.P.R. (3d) 168 (F.C.A.)]. The marks are also to be compared as they are used in business [see *Joseph E. Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1990), 33 C.P.R. (3d) 454 (F.C.T.D.)]. In this regard, the evidence establishes that the Applicant[s] convenience stores at gasoline stations, sell a variety of items such as cigarettes, candy bars and salty snacks and offer fast food items such as sandwiches, doughnuts, coffee and soft drinks. As I understand it, the Applicant's services are not fast food restaurant services, but rather convenience stores at gasoline stations where limited food items are sold. In this regard, based on the evidence of record, I find it unlikely that the parties' trades would overlap. On the other hand, I note that the Opponent's statement of services does not include any limitations regarding its trade channels; thus nothing would prevent the Opponent from operating its restaurants, particularly in the form of fast food restaurants at gasoline stations and in such cases, the Applicant's fast food items could potentially overlap with the Opponent's restaurant services [see Brennan affidavit Exhibit P].

[7] We agree with the Federal Court that this fell within the range of outcomes acceptable and defensible on the facts and the law: *Dunsmuir v. New Brunswick*, 2008 SCC 9, [2008] 1 S.C.R. 190 at paragraph 47.

[8] When asked in oral argument to point to any error in the above passage, the appellant submitted that the Registrar considered the potential overlap between the parties' trades but her consideration was limited by her finding that the respondent's services were not fast food services. However, the Registrar made no such finding.

[9] In its analysis, the Federal Court went further than simply assessing the reasonableness of the Registrar's decisions. To some extent, perhaps mindful of a potential appeal to this Court, it re-did the Registrar's analysis, adding observations of its own. This was unnecessary, and prompted the appellant to attack some of the Federal Court's observations, diverting focus from the real issue, which was the reasonableness of the Registrar's decisions.

[10] We wish to address one of the observations the Federal Court made. At paragraph 77, the Federal Court's words could be taken to say that the admissibility of new evidence offered in reviews of Registrar's decisions is governed by the rules of admissibility adopted by the Registrar. We disagree. Admissibility of new evidence in the Federal Court in such proceedings is governed by the law of evidence in the Federal Court.

[11] We see no reason to depart from the usual principle that costs in appeals follow the event.

[12] A copy of these reasons for judgment shall be placed in both appeal files, A-2-12 and A-3-12.

[13] For the foregoing reasons, we shall dismiss the appeals, with one set of costs.

"David Stratas"

J.A.

FEDERAL COURT OF APPEAL

NAMES OF COUNSEL AND SOLICITORS OF RECORD

DOCKET: A-2-12

**APPEAL FROM A JUDGMENT OF THE HONOURABLE MR. JUSTICE HARRINGTON
DATED DECEMBER 1, 2011, DOCKET NO. T-1640-10**

STYLE OF CAUSE: Mövenpick Holding AG v. Exxon
Mobil Corporation and Attorney
General of Canada (Registrar of
Trade-Marks)

PLACE OF HEARING: Ottawa, Ontario

DATE OF HEARING: January 15, 2013

REASONS FOR JUDGMENT OF THE COURT BY: Dawson, Trudel, Stratas JJ.A.

DELIVERED FROM THE BENCH BY: Stratas J.A.

APPEARANCES:

Bayo Odutola
Hala Tabl

FOR THE APPELLANT

Christopher C. Van Barr
Michael O'Neill

FOR THE RESPONDENT,
EXXON MOBIL CORPORATION

SOLICITORS OF RECORD:

Ollip P.C.
Ottawa, Ontario

FOR THE APPELLANT

Gowling Lafleur Henderson LLP
Ottawa, Ontario

FOR THE RESPONDENT,
EXXON MOBIL CORPORATION

FEDERAL COURT OF APPEAL

NAMES OF COUNSEL AND SOLICITORS OF RECORD

DOCKET: A-3-12

**APPEAL FROM A JUDGMENT OF THE HONOURABLE MR. JUSTICE HARRINGTON
DATED DECEMBER 1, 2011, DOCKET NO. T-1641-10**

STYLE OF CAUSE: Mövenpick Holding AG v. Exxon
Mobil Corporation and Attorney
General of Canada (Registrar of
Trade-Marks)

PLACE OF HEARING: Ottawa, Ontario

DATE OF HEARING: January 15, 2013

REASONS FOR JUDGMENT OF THE COURT BY: Dawson, Trudel, Stratas JJ.A.

DELIVERED FROM THE BENCH BY: Stratas J.A.

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EXXON MOBIL CORPORATION

SOLICITORS OF RECORD:

Ollip P.C.
Ottawa, Ontario

FOR THE APPELLANT

Gowling Lafleur Henderson LLP
Ottawa, Ontario

FOR THE RESPONDENT,
EXXON MOBIL CORPORATION