

Federal Court Reports

Canadian Jewish Congress v. Chosen People Ministries, Inc. (T.D.) [2003] 1 F.C. 29

Date: 20020528

Docket: T-3-00

Neutral Citation: 2002 FCT 613

Ottawa, Ontario, May 28, 2002

Present: The Honourable Mr. Justice Blais

BETWEEN:

CANADIAN JEWISH CONGRESS

Applicant

and

CHOSEN PEOPLE MINISTRIES, INC.

and THE REGISTRAR OF TRADE-MARKS

Respondents

REASONS FOR ORDER AND ORDER

The applicant, Canadian Jewish Congress [hereinafter referred to as the "CJC"], makes this application for judicial review pursuant to subsection 18.1(1) of the *Federal Court Act* and an appeal pursuant to section 56 of the *Trade-marks Act* [hereinafter referred to as the *Act*] from the decision of the respondent, the Registrar of Trade-marks [hereinafter referred to as the "Registrar"], dated November 3rd, 1999 giving public notice pursuant to subparagraph 9(1)(n)(iii) of the *Act* of the adoption and use by the respondent Chosen People Ministries Inc. [hereinafter referred to as the "CPM"] of the "Menorah Design", a representation of a menorah which is a seven-branched candelabrum.

THE PARTIES

[2] CJC is a non-profit, human rights organization comprised of representatives of Jewish congregations, societies, and other organizations in Canada. According to CJC's Aims and Objectives, it exists "to develop the highest standards of participation in the democratic process by the Canadian Jewish community by encouraging, carrying on and participating in activities of a national, cultural and humanitarian nature; to act in matters affecting the status,

rights and welfare of the Canadian Jewish community [...] ; to investigate anti-Semitism [...] ; to study problems affecting the foregoing objects, to conduct research and encourage studies thereon [...] ; to carry on and assist in efforts for the improvement of the social and economic and cultural conditions of Jewry [...] ; to raise funds, to collect and receive monies and property, by contribution, subscriptions, gifts, legacies and grants for the object of Canadian Jewish Congress.

[3] CPM is a non-profit Christian organization resident in the United States of America (City of New York) known originally as "American Board of Missions to the Jews". According to CPM, it is a "Messianic Jewish" religious organization whose members and adherents believe that Yeshua (Jesus Christ) is the Messiah prophesized in traditional Jewish teachings and scripture. CPM's sole objective, as stated in its certificate of incorporation, is: "the spread of the Gospel of the Lord Jesus Christ among the Jews in the United States of America and in all parts of the world."

FACTS

[4] On November 12, 1997, CPM applied to the Registrar for a registration of a trademark of the "Menorah Design".

[5] CJC has opposed that application, that is still pending.

[6] On December 31, 1997, CPM applied to the Registrar to give public notice under subparagraph 9(1)(n)(iii) of the *Act* of its adoption and use of the "Menorah Design" as an Official Mark of CPM.

[7] On February 24, 1998, the Registrar denied the Official Mark application.

[8] On April 22, 1998, CPM requested reconsideration of the Registrar's refusal to grant the Official Mark. This request was rejected on October 30, 1998.

[9] On June 29, 1999, CPM delivered a further request to the Registrar for reconsideration of its Official Mark application.

[10] On November 3, 1999, the respondent gave public notice that the "Menorah Design" is an Official Mark of the CPM.

[11] The Registrar did not provide an explanation for the reversal of its position.

ADDITIONAL FACTS

[12] Since there is no requirement that public notice be given of a request to the Registrar for the publication of notice of the adoption and use of an official mark, CJC was in no way informed of the Official Mark application and had it have, it would have taken whatever steps were available to it to oppose and prevent the decision had it known of the Official Mark application sooner. It did however take steps to challenge the decision of the Registrar since learning of it.

THE IMPUGNED DECISION

909, 670. The Registrar hereby gives public 909, 670. La Registraire donne par les présentes avis notice under Section 9(1)(n)(iii) of the public en vertu de l'Article 9(1)(n)(iii) de la Loi sur Trade-marks Act, of the adoption and use les marques de commerce de l'adoption et by CHOSEN PEOPLE MINISTRIES, INC. l'utilisation par CHOSEN PEOPLE MINISTRIES, of the mark shown above as an official INC. de la marque reproduite ci-dessus, comme mark for wares and services. marque officielle pour des marchandises et des services.

PERTINENT LEGISLATION

[13] Subparagraph 9(1)(n)(iii) of the *Act* prohibits persons from adopting trade-marks that resemble those previously adopted by public authorities.

9. (1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for, [...]

(n) any badge, crest, emblem or mark [...]

(iii) adopted and used **by any public authority, in Canada** as an official mark for wares or services,[...]

(my underlining)

9.(1) Nul ne peut adoper à l'éard d'une entreprise, comme marque de commerce ou aurment, une marque composée de ce qui suit, ou don't la ressemblance est telle qu'on pourrait vraisemblablement la confondre avec ce qui suit: [...]

(n) tout insigne, écusson, marque ou emblème [...]

(iii) adopté et employé par **une autorité publique au Canada** comme marque officielle pour des marchandises ou services, [...]

(mon soulignement)

CJC'S POSITION

[14] CJC submits that CPM is not entitled to an Official Mark for the "Menorah Design" since CPM is not a "public authority" within the meaning of subparagraph 9(1)(n)(iii) of the *Act* and is therefore not entitled to adopt an Official Mark.

[15] CJC claims that the adoption and use of the "Menorah Design" as an Official Mark is scandalous, offensive to Canadians and deceptive.

[16] CJC asserts that it has standing in the present application as it is directly affected as per the terms found in subsection 18.1(1) of the *Federal Court Act* or in the alternative, ought to be granted public interest standing.

CPM'S POSITION

[17] CPM submits that the Registrar rightfully exercised his or her mandate on November 3, 1999 by giving public notice that the "Menorah Design" is an Official Mark of CPM pursuant to subparagraph 9(1)(n)(iii) of the *Act*.

[18] CPM claims that the "Menorah Design" is highly distinctive and is in no way confusing with other menorah designs in use by other organizations.

[19] CPM asserts that it is a "public authority" as per the term used in subparagraph 9(1)(n)(iii) of the *Act*.

[20] CPM also contends that the CJC has no standing to bring this application, either by appeal or by judicial review, and has failed to establish that a reviewable error has occurred to justify the relief sought.

ISSUES

1. What is the appropriate method by which to review the publication of an Official Mark?
2. Does the CJC have standing in the present matter to bring this application by way of judicial review under subsection 18.1(1) of the *Federal Court Act*?
3. Is CPM a "public authority"?
4. Did the Registrar err in publishing the notice of the adoption and use of the "Menorah Design" as an Official Mark of CPM?

ANALYSIS

Standard of review

[21] In *Molson Breweries v. John Labatt Ltd.*, [2000] F.C.J. No. 159 (F.C.A.), the Federal Court of Appeal stated that the appropriate standard applicable to the Registrar's decisions where there is new evidence is that of correctness. *Molson, supra* establishes that where additional

evidence would have materially affected the Registrar's findings of fact or exercise of discretion, the trial judge must come to their own conclusion as to the correctness of the Registrar's decision, at which point a trial *de novo* is appropriate.

OFFICIAL MARK VERSUS TRADE-MARK

[22] An Official Mark is a prohibited mark that grants extraordinary protection, broader than the rights granted in respect of trade-marks. The owner of an Official Mark obtains exclusivity, not as in the case of trade-marks, exclusivity that is tied to specific wares and services. Unlike an application for a trade-mark, there is no requirement that public notice be given of a request to the Registrar for the publication of notice of the adoption and use of an official mark.

[23] Section 9 of the *Act* prohibits all others from adopting a mark that resembles an Official Mark.

[24] Strangely, an Official Mark can be obtained much more easily than a trade-mark. An applicant need not demonstrate the distinctiveness of the proposed Official Mark or establish any secondary meaning. The principal requirement for publication of an Official Mark is that the party seeking it qualify as a "public authority."

[25] The ability to challenge the holder of an Official Mark is confirmed by the *Act* and the jurisprudence. The recourse through the *Act* is called Opposition proceedings, which allow a party to prove that an Official Mark holder is not a "public authority." This is exactly what CJC is attempting to demonstrate to this Court in this application.

DEFINITION OF THE MENORAH

[26] The menorah is distinctively a Jewish symbol. According to the Jewish Bible, the menorah, a seven branched candelabrum, candlestick or lampstand, was given to the Jewish people by God himself. Since being received, the menorah has been an important symbol to the Jewish people. The CJC, in its *Application Record, Memorandum of Fact and Law of the Applicant*, defines the menorah as follows at paragraph 2:

The menorah is an ancient and hallowed symbol of the Jewish faith. Like the crucifix in the Christian religion, the menorah is not the exclusive property of any one organization, but is rather the shared symbol of Jewish persons and organizations around the world.

[27] In addition, Exhibit "W" of the *Application Record (Volume 1 of 3)* contains an excerpt from *The New Jewish Encyclopedia* which provides the following definition:

MENORAH

Hebrew name of the seven-branched candlestick originally made by the Biblical artisan *Bezalel* and placed in the sanctuary of the Tabernacle. [...] The Menorah has since become a universal symbol of Judaism.

1. What is the appropriate method by which to review the publication of an Official Mark?

[28] The appropriate method by which to review the publication of an Official Mark is by way of judicial review pursuant to subsection 18.1(1) of the *Federal Court Act*.

[29] A challenge to the Registrar's decision to publish an Official Mark at the request of a "public authority" may be brought before a Court. However, there is some confusion as to which procedure is the most appropriate for challenging a decision of the Registrar to publish an alleged official mark as this challenge can be brought by way of action, appeal pursuant to section 56 of the *Act* or judicial review pursuant to subsection 18.1(1) of the *Federal Court Act*.

[30] On the one hand, CJC claims that because there is no evidentiary record before the Registrar when making the decision to publish an Official Mark, this hearing is brought on separate evidence and the Court must therefore determine the issue *de novo*. On the other hand, CPM submits that the appropriate method for this challenge is by judicial review pursuant to subsection 18.1(1) of the *Federal Court Act*.

[31] Subsection 56(1) of the *Act* allows for an appeal to the Federal Court.

56. (1) An appeal lies to the Federal Court from any decision of the Registrar under this Act within two months from the date on which notice of the decision was dispatched by the Registrar or within such further time as the Court may allow, either before or after the expiration of the two months.

56. (1) Appel de toute décision rendue par le registraire, sous le régime de la présente loi, peut être interjeté à la Cour fédérale dans les deux mois qui suivent la date où le registraire a expédié l'avis de la décision ou dans tel délai supplémentaire accordé par le tribunal, soit avant, soit après l'expiration des deux mois.

[32] Whereas the remedy for judicial review is set out in the *Federal Court Act* at subsection 18.1(1) and where jurisdiction is provided for at subsection 18(1) of the *Federal Court Act*.

18. (1) Subject to section 28, the Trial Division has exclusive original jurisdiction(a) to issue an injunction, writ of certiorari, writ of prohibition, writ of mandamus or

18.1 (1) Une demande de contrôle judiciaire peut être présentée par le procureur général du Canada ou par

writ of quo warranto, or grant declaratory relief, against any federal board, commission or other tribunal; [...]

18.1 (1) An application for judicial review may be made by the Attorney General of Canada or by anyone directly affected by the matter in respect of which relief is sought.

quiconque est directement touché par l'objet de la demande.

18. (1) Sous réserve de l'article 28, la Section de première instance a compétence exclusive, en première instance, pour :

(a) décerner une injonction, un bref de certiorari, de mandamus, de prohibition ou de quo warranto, ou pour rendre un jugement déclaratoire contre tout office fédéral; [...]

[33] In *Magnotta Winery Corp v. Vintners Quality Alliance of Canada*, [1999] F.C.J. No. 326 (F.C.T.D.), Reed J. was faced with a similar situation to that of the present matter.

[34] Magnotta Winery Corp. had a direct interest in the decision that had been made by the Registrar and, apparently, had no mechanism for challenging the decision apart from either an appeal under section 56 of the *Act*, or a judicial review application under subsection 18.1(1) of the *Federal Court Act*. In her final analysis, Reed J. held:

[para 27] [...] Certainly, a judicial review application is well suited to a situation in which no notice has been given to an interested party and I note that courts have implied such requirements into legislative procedures when they have not been statutorily required. Counsel for the applicants is of the view that a section 18.1 judicial review application is the more legally correct way to proceed. I have no doubt that what is correct will not be decided by this Court. It will be for the Court of Appeal to decide. There may, therefore, be merit in having applications instituted pursuant to both routes proceeding simultaneously. Insofar as the need for a legal interest to commence a judicial review application is concerned, I am not persuaded that only those who have participated in the proceeding leading to the decision that it is sought to be reviewed have such an interest. This is so at least in the situation in which the interested person has not been given notice of, nor an opportunity to participate in, that process.

[35] More recently, in *FileNet Corp. v. Canada (Registrar of Trade-marks)*, [2001] F.C.J. No. 1239 (F.C.T.D.), I was faced with a similar situation in which the applicant had brought two applications, an appeal under the *Act* and a judicial review application of the Registrar's decision. In *FileNet, supra*, I held:

[para 19] [...] It appears from the jurisprudence that the proper way for the applicant to bring the present proceeding was by way of judicial review.

[36] It would therefore seem, based upon *Magnotta, supra*, and *FileNet, supra* that judicial review is the appropriate and preferable method by which to seek the revocation of an Official Mark. The reason being that an appeal implicitly involves a proceeding from which the parties to the proceeding can seek review by a Court. In relation to section 9 of the *Act*, there is no previous proceeding involved and consequently, no possibility of an appeal. In addition to this, the only parties involved in the original application are the "public authority" seeking the Official Mark and the Registrar.

[37] I find that based on the decision rendered in *Magnotta, supra* and *FileNet, supra* that judicial review pursuant to subsection 18.1(1) of the *Federal Court Act* is the appropriate method to review the publication of the Official Mark.

2. Does the CJC have standing in the present matter to bring this application by way of judicial review under subsection 18.1(1) of the *Federal Court Act*?

[38] Yes, the CJC has standing in the present matter to bring this application by way of judicial review under subsection 18.1(1) of the *Federal Court Act*.

[39] CJC asserts that it has standing under subsection 18.1(1) of the *Federal Court Act*, or in the alternative, ought to be granted public interest standing.

Standing under the *Federal Court Act*

[40] Subsection 18.1(1) of the *Federal Court Act* states that:

An application for judicial review may be made by the Attorney General of Canada or **by anyone directly affected** by the matter in respect of which relief is sought.

(my underlining)

[41] Subsection 18.1(1) of the *Federal Court Act* allows the Court to grant standing when it is convinced that the circumstances and the type of interest which an applicant holds justify status being granted. This was confirmed in *Sierra Club of Canada v. Canada (Minister of Finance)*, [1999] 2 F.C. 211 (F.C.T.D.), where the Sierra Club of Canada, which is a non-profit organization concerned with the protection and restoration of the environment, sought standing in an appeal from the dismissal of a motion to strike the Sierra Club's application for judicial review. Evans J. held :

[para 33] In the alternative, counsel argued, Reed J.'s references in *Friends of the Island Inc. v. Canada (Minister of Public Works)*, [1993] 2 F.C. 229 (T.D.), at page 283, to "the particular circumstances of the case" and "the type of interest which the applicant holds" as factors relevant to the grant of status or standing indicate that a broader range of considerations may be taken

into account under subsection 18.1(1) than those relevant to determining public interest standing at common law.

"By anyone directly affected"

[42] According to CJC, the decision rendered in *Sierra Club of Canada, supra*, allows for the possibility that the terms "by anyone directly affected" would include the rights of an organization or its members, or inflict special damage on an organization or its members, above that sustained by the public at large.

[43] Evans J. devoted much of the Court's analysis to the relevant jurisprudence in regards to standing under subsection 18.1(1) of the *Federal Court Act*. In conclusion, the Court held:

[para 32] In contrast, Sunshine Village, *supra*, clearly holds that a person who satisfies the requirements for discretionary public interest standing may seek relief under subsection 18.1(1), even though not "directly affected". In my opinion, this is the preferable view, even though the language of subsection 18.1(1) suggests that only those who meet the pre-Finlay test may seek judicial review. In the absence of an explicit statutory provision excluding public interest applicants from the Federal Court, it would be so incongruous to subject the Court's ability to entertain applications for judicial review to a limitation not imposed on other courts, that I am unwilling to adopt the narrower interpretation of subsection 18.1(1) for which the intervener in this case has contended.

[44] CJC is an organization that, among other things, participates in a number of activities of a national, cultural and humanitarian nature in furtherance of the interests of the Jewish community. The publication of the Official Mark forbids the CJC, a Jewish organization, from adopting the menorah in any of its activities. It is obvious therefore that the CJC is directly affected by the Registrar's decision and is prejudiced thereby. It is true however that the CJC was not a party to the publication by the Registrar, but this is part and parcel of the process of an Official Mark application. CJC claims that it would have taken the necessary steps to avert the Registrar's decision, but was not informed of the Official Mark application as mentioned earlier.

[45] CJC is a multi-faceted organization that touches upon so many aspects of the Jewish culture and faith that it is clearly directly affected by the Registrar's decision. It would be unfair to deny standing to the CJC because the Official Mark application process limits the parties to the CPM and the Registrar.

Public interest standing

[46] Alternatively, public interest standing is a discretionary remedy which is normally granted when the validity of legislation is being challenged. It involves three (3) considerations to be assessed on the balance of probabilities: (i) serious or justiciable issue; (ii)genuine interest

in the outcome; and (iii) no other reasonable and effective way to bring the issue before the Court.

[47] There is, in my opinion, no need to consider the criteria for public interest standing in depth at this time, as I am convinced that the CJC has the requisite standing to bring this application for judicial review pursuant to subsection 18.1(1) of the *Federal Court Act* by virtue of the fact that it is directly affected by the Registrar's decision.

3. Is CPM a "public authority"?

[48] According to CJC, to properly claim to be a "public authority", the applicant for an Official Mark must be (1) a Canadian entity; (2) be subject to a significant degree of governmental control; (3) perform functions for the benefit of the public (or hold a duty to the public). Unfortunately, the *Act* does not provide a definition of "public authority" and so, in statutory interpretation, a plain and ordinary interpretation is to be construed.

"Public authority, in Canada"

[49] The wording used in subparagraph 9(1)(n)(iii) of the *Act* reads as follows: "any public authority, in Canada" or in the french language version « une autorité publique au Canada » .

[50] CPM claims that it qualifies as a "public authority" because it is a charitable organization and because it complies with regulations in the United States and in Ontario that apply generally to charities.

[51] In addition, CPM claims that since there is no definition of "public authority" in the *Act*, the Registrar is to apply his or her discretion as to what constitutes "any public authority, in Canada".

Government control and duty to the public

[52] A "public authority" must also be subject to government control and display a duty to the public (see *Canadian Olympic Assn. v. Konica Canada Inc. (T.D.)*, [1990] F.C.J. No. 256 (F.C.T.D.)).

[53] This Court in *Big Sisters Association of Ontario, supra*, held that the charitable status of Big Sisters did not demonstrate that it was subject to a significant degree of governmental control nor a duty to the public so as to constitute it as a "public authority":

In Canada (Registrar of Trade Marks) v. Canadian Olympic Assn., [29] Mr. Justice Urie, speaking for a three-member panel of the Federal Court of Appeal, impliedly adopted the

argument that, to be regarded as a public authority, a body must be under a duty to the public, must be subject to a significant degree of governmental control and must be required to dedicate any profit earned for the benefit of the public and not for private benefit. On the facts before me, the parties to this litigation were clearly dedicated to the public good, but I am not sure that they were under a "duty" to the public. Nor does the evidence disclose that they were subject to a significant degree of governmental control.

[54] Counsel for the CPM suggests that the Registrar was convinced that CPM was a public authority, that the CPM meets the burden and has demonstrated its character.

[55] The fact that CPM was incorporated as a non profit corporation with charitable objects, has obtained tax exempt status, the ability to issue charitable receipts to donors, and also the fact that as a foreign charity operating in Ontario, CPM could be asked to provide its accounts, financial and corporate information to the Public Guardian and Trustee of Ontario is not sufficient to determine whether CPM is a public authority. All charitable organizations have to comply with regulations in the United States and Ontario and, as soon as they comply with the regulations in place, the charitable organizations are not subject to "significant" government control.

[56] CPM tried to compare the present situation with the case *Canadian Olympic Association v. Registrar of Trade-marks*. I agree with CJC that the decision does not assist CPM. In *Canadian Olympic Association*, the Court found that the Canadian Olympic Association was subject to government control because in the event that the Canadian Olympic Association surrendered its charter, its assets were to be disposed of by the Government of Canada in co-operation with the International Olympic Committee. Also, a substantial portion of the Canadian Olympic Association's funding came from the federal government with the disposition of that funding being monitored by the government, the federal government had been able to prevail upon the Canadian Olympic Association to not participate in the 1980 Olympic Games and lastly there was a close relationship between the Canadian Olympic Association, the Directorate of Fitness and Amateur Sport and Sport Canada.

[57] CPM is not subject to any similar or analogous government control. CPM's property is not to be disposed of at the direction of the government. The CPM is not funded by the Government of Canada or the United States and is in no way subject to monitoring by the government in any shape or form.

[58] To the contrary, as suggested by the CJC counsel, the Government of Canada cannot intervene in any way with how churches or charitable organizations like CPM conduct their affairs.

[59] CPM, put simply, is a United States charity with operations in Canada. This Court has stated that such a status is insufficient to constitute CPM as a "public authority" (see *Big*

Sisters Association of Ontario v. Big Brothers of Canada (1997), 75 C.P.R. (3d) 177). As such, it would seem that the Registrar erred in the exercise of his or her discretion as CPM is not under government control nor does it owe a duty to the public and so, has no entitlement to an Official Mark.

4. Did the Registrar err in publishing the notice of the adoption and use of the Menorah Design"as an Official Mark of CPM?

[60] Yes, the Registrar erred in publishing the notice of the adoption and use of the "Menorah Design"as an Official Mark of CPM.

[61] CJC has shown that it has the requisite standing to bring this application and that the CPM is not a "public authority" pursuant to subparagraph 9(1)(n)(iii) of the *Act* since it is not under government control nor does it owe a duty to the public. Consequently, I am of the opinion that the Registrar erred by giving public notice under subparagraph 9(1)(n)(iii) of the *Act* of the adoption and use of the "Menorah Design" as an Official Mark of CPM on November 3, 1999.

Historical and Religious Evidence proving that the Menorah is a "Jewish" symbol

[62] In the Exhibits attached to Mr. Prutschi's affidavit, several documents define the symbolism of the menorah to the Jewish people. In particular, Exhibit "S" to Mr. Prutschi's affidavit contains samples of letterhead from many Jewish organizations and associations, such as the Jewish Community Council of Ottawa, B'nai Brith Canada and Jewish Family Services where the menorah is displayed. However, I find this to be considered as purely circumstantial evidence. It is the historical and religious evidence provided at Exhibit "U" that illustrates the menorah as being the official emblem of the Jewish faith and its people since antiquity. Exhibit "U" depicts two (2) ancient menorahs with captions that read as follows:

The menorah or seven-branched lampstand is one of the commonest Jewish symbols in late antiquity, both in Israel and in the Diaspora [...]

[63] And further below at page 172:

Another menorah, this time on a fourth-century C.E. sarcophagus discovered in the Jewish catacomb of the Vigna Randanini in Rome. [...]

[64] It would be counterproductive to prohibit Jewish organizations and associations from using and adopting a mark such as the menorah, since it has always been historically associated with the Jewish culture.

O R D E R

[65] Therefore, I find that the Registrar erred in the exercise of his or her discretion and this application for judicial review is allowed with costs.

[66] The decision of the Registrar is quashed and the public notice of the Official Mark "Menorah Design" is ineffective to give rise to any rights or prohibitions under sections 9 and 11 of the *Act*.

[67] The appeal pursuant to section 56 is dismissed without costs.

Pierre Blais

Judge