

IN THE SUPREME COURT OF BELIZE, A.D. 2022

Claim No. 638 of 2019

IN THE MATTER OF the RICHMAN ROYAL & LABEL DESIGN registered under registration no. 7481.11

AND

IN THE MATTER OF a ruling by the Deputy Registrar of Intellectual Property dated the 11th January, 2019

AND

IN THE MATTER OF the Trade Marks Act, Chapter 257 of the substantive laws of Belize read along with the Patents Act, Chapter 253 of the substantive laws of Belize and the Trade Marks Rules, Chapter 257 of the subsidiary laws of Belize

BETWEEN

BENZER INTERNATIONAL COMPANY LIMITED

CLAIMANT

AND

THE REGISTRAR OF INTELLECTUAL PROPERTY

1st DEFENDANT

THE ATTORNEY GENERAL OF BELIZE

2nd DEFENDANT

GLOBAL TOBACCO FZCO

3rd DEFENDANT

BEFORE The Honourable Madam Justice Geneviève Chabot

Date of Written Submissions: July 15th, 2022

Appearances:

Anthony G. Sylvestre and Wayne A. Piper, Counsel for the Claimant

Samantha Matute and Israel Alpuche, Counsel for the 1st and 2nd Defendants

Gavin Courtenay and Hector D. Guerra, Counsel for the 3rd Defendant

JUDGMENT

Introduction

1. The Claimant seeks this Court’s guidance in interpreting the notification provisions under the *Trade Marks Act*¹ and related statutory instruments. The Claimant was the Registered Proprietor of “Richman Royal”, a design mark, in respect of International Class 34 for cigarettes. The 3rd Respondent filed a Notice of Application for Invalidation of Registration of a Mark in relation to “Richman Royal & Label Design” (the “Application for Invalidation”). A Notice of Invalidation was published in the Journal of Intellectual Property, but was not served on the Claimant at its address for service. The Claimant seeks a declaration that the publication of a Notice of Invalidation in the Journal of Intellectual Property does not constitute service. The Claimant also seeks a declaration that the decision of the Deputy Registrar of Intellectual Property made pursuant to the defective notice be declared a nullity.
2. This Court finds that publication in the Journal of Intellectual Property does not constitute service of a Notice of Invalidation. A Notice of Invalidation under the *Trade Marks Act* and related statutory instruments must be communicated to the Registered Proprietor in writing at the address for service entered into the Register of Trade Marks. The ruling of the Deputy Registrar of Intellectual Property issued on the 11th day of January, 2019 is a nullity.

Facts

3. The facts are not in dispute. On January 27th, 2011, the Claimant submitted an application to register “Richman Royal”, a design mark, in respect of International Class 34 for cigarettes, pursuant to the *Trade Marks Act*.
4. On November 18th, 2011, the First Notice of Application to register “Richman Royal” was published in the Journal of Intellectual Property. There were no objections to the registration of the design mark “Richman Royal” in respect of International Class 34 for cigarettes. Subsequently, on February 20th, 2012, the Claimant was issued with a Trademark Certificate of Registration for the design mark “Richman Royal” in respect of International Class 34 for cigarettes.
5. On November 7th, 2018, the 3rd Defendant filed with the Belize Intellectual Property Office (“BELIPO”) a Notice of Application for Invalidation of Registration of a Mark in relation to “Richman Royal & Label Design”. On November 16th, 2018, BELIPO published a

¹ Cap. 257, Rev. Ed. 2020.

Notice of Invalidation in relation to “Richman Royal & Label Design” in its Journal of Intellectual Property, giving the Registered Proprietor, the Claimant, 30 days to submit to the Registrar a response to the Notice of Application for Invalidation.

6. On January 11th, 2019, BELIPO published a Notice of Ruling (the “January Decision”) in its Journal of Intellectual Property stating that the Registrar has ruled against the Registered Proprietor (the Claimant) for failure of the Registered Proprietor to answer to the Notice of Invalidation filed by the Applicant.
7. The Claimant had 21 days to file an appeal of the decision to the Court pursuant to the *Trade Marks Act*. The Claimant did not appeal the decision of the Registrar.
8. In light of the January Decision, on January 25th, 2019, the 3rd Defendant applied to be registered as the proprietor of the “Richman Royal” mark in Belize.
9. By letter dated June 7th, 2019, the Claimant wrote to the Registrar to ask that the matter be reheard. Consequently, on June 13th, 2019, BELIPO published a Notice in the Journal of Intellectual Property voiding the January Decision on the ground that the Deputy Registrar lacked jurisdiction (the “June Decision”). The Notice required the Claimant, as Registered Proprietor, to answer to the Notice of Invalidation published on November 8th, 2018, no later than 30 days from the date of the Notice.
10. On July 4th, 2019, the 3rd Defendant filed an Urgent Notice of Appeal (the “Appeal”) to the Supreme Court to have the June Decision set aside on the basis that the 1st Defendant was *functus officio*.
11. On October 31st, 2019, the Claimant filed this Claim seeking a declaration that the January Decision be declared a nullity.
12. On December 4th, 2019, the Court determined that the Appeal should be allowed and the June Decision was set aside.

The Claim

13. The Claimant seeks the following relief:
 - a. A declaration that the ruling of the Deputy Registrar of Intellectual Property issued on the 11th day of January, 2019 and published in Volume 19, No. 1 of the Journal of Intellectual Property is a nullity;
 - b. A declaration that the publication of a Notice of Invalidation in the Journal of Intellectual Property does not constitute service in accordance with the *Trade Marks Rules* and the *Companies Act*;

- c. Costs; and
 - d. Such further and other relief as the Court sees fit.
14. The parties agreed to proceed with this Claim on the basis of the record and of written submissions. The parties filed their submissions on July 15th, 2022 and judgment was reserved.

Issues for Determination

15. In their Joint Pre-Trial Memorandum, the parties identified the following issues for determination by this Court:
- a. Whether the Deputy Registrar was seized with jurisdiction to entertain the Notice of Application for Invalidation;
 - b. Whether the ruling of the Deputy Registrar of Intellectual Property issued on the 11th day of January 2019 and published in volume No. 1 of the Journal of Intellectual Property is a nullity;
 - c. Whether the publication of a Notice of Invalidation in the Journal of Intellectual Property constitutes service in accordance with the *Trade Marks Rules* and the *Companies Act*;
 - d. Whether there is a duty placed on the Registrar to serve the Notice of Application for Invalidation on the Claimant;
 - e. Whether there is a duty placed on the Registrar to give notice to the parties of the hearing on an application to invalidate a trademark;
 - f. Whether there is a duty placed on the Registrar to convene and hold a hearing in respect of the invalidation application.
16. As noted by the Defendants, a reading of the Claimant’s submissions suggests that the Claimant has abandoned some of the issues for determination identified in the Joint Pre-Trial Memorandum. The Claimant’s submissions address the issue of service and, briefly, whether the January Decision is a nullity (issues b., c., and d.). The Claimant made no submissions on issues a., e. and f. The Defendants’ submissions are responsive to the Claimant’s submissions and do not address issues a., e., and f. In the absence of submissions, this Court declines to deal with issues a., e. and f.

Analysis

Claimant's Submissions

17. The Claimant submits that the Registrar of Intellectual Property was aware of the Claimant's address for service at all material times. The Claimant provided its address for service as "Corozal Free Zone, Belize" in its Application for Registration. The 3rd Applicant's Notice as filed with BELIPO also stated the Claimant's name and address as "BENZER INTERNATIONAL COMPANY LIMITED of Corozal Free Zone, Corozal District, Belize". In addition, in the course of its Application, the Claimant exchanged written correspondence with BELIPO in which the Claimant stated its address as:

No. 2 D.L.P. Plaza Freedom Avenue
Santa Elena Freezone Corozal
Belize

18. Phone numbers and email addresses were also contained in those written correspondence but are not reproduced in this judgment for privacy reasons.
19. The Claimant contends that under the *Trade Marks Rules*, once provided, the address for service can properly be used by the Registrar for communications. There is no legal provision for a Notice of Invalidation to be served or communicated by publication in the Journal of Intellectual Property. Under section 11 of the *Trade Marks Act*, the scope and function of the Journal of Intellectual Property is restricted to notices of registration of any trademarks and the particulars relating to such registration.
20. The procedure for an Application for Invalidation is guided by the *Trade Marks (General Procedures) Administrative Instructions, 2005* (the "*Administrative Instructions*"). The *Administrative Instructions*, in relevant parts, provide as follows:

14.(1) Any person who wishes to have a mark invalidated under section 47 of the Act, may so inform the Registrar by submitting a notice of invalidation in Form No. 17C, together with the prescribed fee. Required invalidation form.

(2) The applicant's answer to a notice of invalidation under sub-paragraph (1) must be submitted in Form No. 17D, together with the prescribed fee, and the answer must indicate the grounds on which the application relies and any facts alleged in the notice of invalidation that the applicant admits.

(3) Part III shall apply, with the necessary modifications, to this Part.

21. Part III of the *Administrative Instructions* deals with Oppositions. Part III does not list publication in the Journal of Intellectual Property as a method of complying with the

service requirement. There is nothing in Part III to contradict *Trade Marks Rule 14*, which provides that where communication is addressed to the address given to the Registrar as that party's address for service, it is deemed served.

22. In addition, the Claimant notes that there is nothing in the *Trade Marks Act*, *Trade Marks Rules*, or the *Administrative Instructions* that repeals or overrides the provision in the *Companies Act*² for service of documents on companies. Section 117 of the *Companies Act* states as follows:

117. A document may be served on a company by leaving it at or sending it by post to the registered office of the company

23. According to the Claimant, by failing to serve the Notice of Invalidation on the Claimant, the Registrar denied the Claimant its right to natural justice. The Claimant was denied its right to be aware of the Application for Invalidation made against its intellectual property, and to be given an opportunity to respond to, defend itself, or attend a hearing that had the effect of taking away its registered property.

24. The Claimant submits that even if this Court finds no statutory requirement for service of the Notice of Invalidation, Byles J.'s reasoning in *Cooper v Wandsworth Board of Works*³ finds application:

[...] although there are no positive words in a statute requiring that the party shall be heard, yet the justice of the common law will supply the omission of the legislature.

25. Relying on *British Caribbean Bank Limited v The Attorney General*,⁴ the Claimant maintains that a right to be heard exists where property, including intellectual property, is being compulsorily acquired. Because it was made in violation of the statutory requirements and the requirements of fairness and natural justice, the January decision is a nullity.

1st and 2nd Defendants' Submissions

26. The 1st and 2nd Defendants submit that, on a true construction of the *Trade Marks Act* and the *Administrative Instructions*, the process to be applied where there is an Application for Invalidation made to the Registrar is the following:

² Cap. 250, Rev. Ed. 2020.

³ 1863 14CB 180.

⁴ Civil Appeal No. 30 of 2010.

- i. An Application for Invalidation must be submitted to the Registrar using Form 17C;
 - ii. The answer to the Application for Invalidation by the Registered Proprietor is submitted in duplicate to the Registrar using Form 17D;
 - iii. The answer in Form 17D is then sent by the Registrar to the Applicant;
 - iv. The Applicant, after one month, is then to provide evidence, by way of affidavit, in support of the Application, to the Registrar and to the Registered Proprietor;
 - v. Upon receipt of the affidavit, and within one month, the Registered Proprietor is required to provide evidence to support ownership of the trademark, by way of affidavit, to the Registrar and to the Applicant;
 - vi. Within one month of receiving the evidence of the Registered Proprietor, the Applicant is to provide evidence in reply;
 - vii. After receiving all the evidence, the Registrar will then give notice to the parties of a date to hear the arguments in the Application for Invalidation.
27. Both the *Trade Marks Act* and the *Administrative Instructions* are silent in relation to the service of an Application for Invalidation lodged with the Registrar. The duty placed on the Registrar to serve any document only arises in two cases, where:
- i. There is opposition to the registration of a mark, or
 - ii. An answer to the Application for Invalidation has been lodged by the Registered Proprietor.
28. There was therefore no duty placed on the Registrar of Intellectual Property to serve the Notice of Application for Invalidation on the Claimant. While there is no duty, it has been the practice to do so, but in this case the Notice of Application was not served.
29. Even if there is any consideration that the Registrar has some duty to provide notice, the extent of that duty would have been met with the publication of the 3rd Defendant's Notice of Application in the Journal of Intellectual Property. According to the 1st and 2nd Defendants, the Journal of Intellectual Property may be used by the Registrar to publish information relative to the trademark, including an Application for Invalidation. This was done in this case and amounts to notice to the world.

30. The principle of providing notice in the Journal of Intellectual Property is aligned with the principle applicable to registries, like the Company's Registry, the Land's Registry, and the General Registry, that in the absence of a statutory requirement to serve actual notice on a particular person or company, constructive notice constitutes sufficient legal service.
31. With respect to the issue of the hearing, the 1st and 2nd Defendants submit that under the *Administrative Instructions*, the Registrar is to hold a hearing after the Registrar has received all of the evidence. In this case, the Registrar only received evidence from the 3rd Defendant. Therefore, there was no need to have a hearing of the arguments for the Application for Invalidation.
32. As a result, the 1st and 2nd Defendants submit that the January Decision is not a nullity. As stated in Young J.'s decision in Civil Appeal No. 3 of 2019 (the Appeal of the June Decision), "an existing decision which is invalid cannot simply be ignored, it must be revoked before a re-hearing". The Claimant did not appeal the January decision. This Court should not entertain the relief sought to declare the January Decision a nullity. This Court is not being asked to confirm any legal rights of the Claimant, but instead to essentially overturn a decision made by the Registrar of Intellectual Property.

3rd Defendant's Submissions

33. Despite signing off on the Pre-Trial Memorandum, the 3rd Defendant chose to focus its written submissions on issues that were not identified by the parties as issues for determination by this Court. The 3rd Defendant submits that the Claim should not succeed because:
 - a. While the Claim is framed as one for administrative orders, Benzer is clearly seeking to circumvent the requirements for seeking permission for Judicial Review;
 - b. The declarations sought would serve no useful purpose, given the absence of any coercive order to enforce it and that Benzer's initial registration of the trade mark has expired. The Court is obliged to refuse to grant a declaration were it would serve no useful purpose;
 - c. Benzer failed to exhaust its alternative and prescribed remedy of appealing the Ruling to the Supreme Court's appellate jurisdiction within the prescribed time;
 - d. Notification of Invalidation in the Journal of Intellectual Property constitutes service and notice to the world including the Claimant who, as a registered proprietor of a mark, is required to remain vigilant of its rights.
34. Issues a. to c. as defined by the 3rd Defendant have already been determined. On March 25th, 2021, the Judge previously assigned to this matter, James J., delivered an oral ruling

dismissing an Application to Strike Out the Claim filed by the Defendants in this Claim. In its submissions on the Application to Strike Out, the 3rd Defendant raised the very same issues it now wants this Court to determine. In its ruling, James J. noted that the Claimant had sought no prerogative order to quash the Deputy Registrar's decision. The declarations that the Claimant seeks relate to the legalities of past actions. The Claimant is concerned not with making a parallel or collateral attack on the January Decision, but rather with seeking guidance for the future. That is not sufficient to make it a judicial review claim. An Appeal under the *Trade Marks Act* would challenge the merits of the decision, which is not what the Claimant seeks. The declaration would not be meaningless as it would impact notice in any matter before the Registrar in the future.

35. Why counsel for the 3rd Defendant thought proper to raise those very same issues again before me is unclear. It would be inappropriate for me to reconsider these issues. As a result, I have given no consideration to the 3rd Defendant's submissions on the Claim, except for those pertaining to issue d.
36. On issue d., the 3rd Defendant argues that notice in the Journal of Intellectual Property constitutes service and notice to the world, including the Claimant. Citing the Privy Council's decision in *Wiseman v Borneman*,⁵ the 3rd Defendant adds that notwithstanding the absence of specific provisions regarding service, the Court ought only to step in to supplement an act's provisions where it is clear that the statutory procedure is insufficient to achieve justice. This is not a case where the Court ought to step in, as the *Trade Marks Act* provides an adequate means of redress of which the Claimant failed to avail itself.

Discussion

37. This Court is being asked not to supplement, but to interpret the statutory regime applicable to notifications in the context of invalidation applications submitted to the Registrar of Intellectual Property. Under Rule 56.1 of the *Supreme Court (Civil Procedure) Rules, 2005* (the "*Rules*"), this Court is empowered to consider applications for a declaration in which a party is the Crown, a court, a tribunal, or any public body. Rule 56.1 imposes no limitation on the power of this Court to issue declaratory judgments, including declaratory judgments for the purpose of clarifying and guiding the conduct of a public body in the future. This is confirmed in the judgment of Morrison J.A. in *The Belize Bank Limited v Association of Concerned Belizeans et al.*⁶ This Claim is therefore quite appropriately before this Court for a declaratory judgment.
38. This Court is of the view that publication in the Journal of Intellectual Property does not constitute service of a Notice of Application for Invalidation.

⁵ [1917] AC 297 at 308.

⁶ Civil Appeal No. 18 of 2007 at para. 38.

39. Section 47 of the *Trade Marks Act* provides for the circumstances under which the registration of a trade mark may be declared invalid. Section 47 is silent as to the procedure that must be complied with for the invalidation of a registration, apart from providing whether the application should be made to the Court or to the Registrar of Intellectual Property. In this case, the Application for Invalidation was made to the Registrar.
40. The *Trade Marks Act* is supplemented by the *Trade Marks Rules*. The *Trade Marks Rules* mandate the provision of an address for service upon registration of a trademark. Under *Trade Mark Rule 11*, a registered or prospective owner or licensee of a mark can provide an address for service to be entered into the Register of Trade Marks. Under *Trade Mark Rule 13*, where no address for service is entered into the Register of Trade Marks, “the Registrar may treat the trade or business address of the registered owner or licensee as recorded in the register as the address for service of that owner or licensee for all purposes connected with the registration of the mark”. The address for service provided to the Registrar must be kept up to date. Under *Trade Mark Rule 23*, a change in an applicant’s address for service must be notified to the Registrar. It appears, therefore, that whether or not an address for service is specifically provided by the registered or prospective owner or licensee of a mark, the *Trade Marks Rules* mandate that an up-to-date address be used for service “for all purposes connected with the registration of the mark”.
41. The Court notes that the *Trade Marks Rules* do not use the terms “serve” or “service” as applying to any communications between the Registrar and the registered or prospective owner or licensee of a mark. Under the *Trade Mark Rules*, information is communicated “in writing”. For example, under *Trade Mark Rule 27*, “when the Registrar objects to the registration of an application, the Registrar shall in writing inform the applicant of his objection to the registration”. Under *Trade Mark Rule 28*, “when the Registrar is willing to accept an application for registration if it is subjected to any condition, amendment, disclaimer, modification or limitation, the Registrar may in writing communicate this circumstance to the applicant”. Other provisions of the *Trade Mark Rules* contain similar language, for example *Trade Mark Rules 42 to 45* (licence-contract), 48 (change in name in Register), 50 (surrender of a mark), and 51 (transfer of mark).
42. Thus, the *Trade Marks Rules* provide that an address for service is used “for all purposes connected with the registration of the mark”, and use the expression “in writing” to convey that information connected to a mark is communicated to the registered or prospective owner or licensee of a mark. The logical conclusion is that communication in writing must be sent to the address for service recorded in the Register of Trade Marks. Interpreting the *Trade Marks Rules* otherwise would remove any purpose for the provision of an address for service.

43. This conclusion is supported by *Trade Mark Rule* 14, which provides that “a written communication to a person or party mentioned in the Act or these Rules and addressed to an address given by him to the Registrar or treated by the Registrar as that person’s or party’s address for service shall be deemed to be properly addressed to that person or party”.
44. The *Trade Mark Rules* are silent as to the procedure that must be complied with for the invalidation of a registration. That procedure is provided for in the *Administrative Instructions*. The procedure established under the *Administrative Instructions* lacks specificity. Section 14 of the *Administrative Instructions* provides as follows:
- 14.(1) Any person who wishes to have a mark invalidated under section 47 of the Act, may so inform the Registrar by submitting a notice of invalidation in Form No. 17C, together with the prescribed fee.
- (2) The applicant’s answer to a notice of invalidation under sub-paragraph (1) must be submitted in Form No. 17D, together with the prescribed fee, and the answer must indicate the grounds on which the application relies and any facts alleged in the notice of invalidation that the applicant admits.
- (3) Part III shall apply, with the necessary modifications, to this Part.
45. Section 14 of the *Administrative Instructions* refers back to Part III of the same instrument, which applies to applications for opposition. Part III does not address the service of an application for opposition on the registered or prospective owner or licensee of a mark. The provisions of Part III begin half-way through an opposition process, at the point where an answer to an opposition has been received. Part III is therefore of limited utility in this Court’s search for answers to the issue raised in this Claim.
46. The only section in Part III that is of some relevance to this Court’s analysis is section 9. Section 9 is relevant for the interpretation of the term “notice”. In the context of section 9, “notice” of the date of a hearing of an application for opposition must be given “to the parties”. A notice published in the Journal of Intellectual Property would not comply with the requirement in section 9 because the notice would not be communicated “to the parties”.
47. From the above, this Court concludes that the *Trade Marks Act*, the *Trade Marks Rules*, and the *Administrative Instructions* create a scheme under which once an address for service is entered into the Register of Trade Marks under *Trade Mark Rules* 11 or 13, any communications between the Registrar and the registered or prospective owner or licensee of a mark is to be made in writing to the address for service. This includes any notice that must be issued by the Registrar under the *Trade Marks Act*, the *Trade Marks Rules*, and

the *Administrative Instructions*. This scheme's clear reliance on written communications creates an expectation in the registered or prospective owner or licensee of a mark that any information related to a mark in which they have a specific interest will be communicated to them in writing at their address for service.

48. The only exception to this rule arises in the context of the registration of a trade mark. Under section 11 of the *Trade Marks Act*, notice of a registration of any trade mark is to be published in the Journal of Intellectual Property:

11.-(1) The Registrar shall publish in the Journal of Intellectual Property a notice of the registration of any trade mark.

(2) The Journal shall contain all such particulars of any application for the registration of a trade mark as may be prescribed (including a representation of the mark) and such other information relating to the trade mark as the Registrar thinks fit.

49. This exception makes sense. At the registration stage, there is no known registered or prospective owner or licensee of a mark. Publication in the Journal of Intellectual Property provides notification of the registration to the world and gives an opportunity to any interested party to be informed. The Court disagrees with the 1st and 2nd Defendants that the closing words of subsection 11(2), "other information relating to the trade mark", can be interpreted to include a Notice of Invalidation. A purposeful reading of section 11, in light of the statutory scheme as a whole, leads to the conclusion that the "other information" referred to in subsection 11(2) relates to the *registration* of the mark.
50. Procedural fairness requires that where a specific and ascertainable person's rights are at risk of being affected by a decision of the State, specific notice must be provided to that person. Requiring any less would render that person's right to be heard meaningless. A person can only exercise their right to be heard if they know their rights are being threatened. This case is a good example. The Claimant, unaware of the Application for Invalidation, was unable to exercise its right to be heard under section 9 of the *Administrative Instructions*. As a result, the Claimant's property rights with regard to its mark were affected.
51. Given the absence of notification of the Application for Invalidation to the Claimant, and the resulting inability of the Claimant to be heard, the January Decision cannot stand. The Claimant is asking this Court to declare the January Decision a nullity. A declaration that an administrative decision is a nullity is a remedy which, although less common than an order to quash, is available to the Claimant. In *Anisminic Ltd v Foreign Compensation*

Commission,⁷ Lord Reid described the circumstances that may result in a decision to be declared a nullity in the following terms:

But there are many cases where, although the tribunal had jurisdiction to enter on the inquiry, it has done or failed to do something in the course of the inquiry which is of such a nature that its decision is a nullity. It may have given its decision in bad faith. It may have made a decision which it had no power to make. It may have failed in the course of the inquiry to comply with the requirements of natural justice. It may in perfect good faith have misconstrued the provisions giving it power to act so that it failed to deal with the question remitted to it and decided some question which was not remitted to it. It may have refused to take into account something which it was required to take into account. Or it may have based its decision on some matter which, under the provisions setting it up, it had no right to take into account. I do not intend this list to be exhaustive [emphasis added].⁸

52. A decision that is a nullity can be reconsidered by the decision-maker. In *Chandler v. Alberta Association of Architects*,⁹ the Supreme Court of Canada held that where a denial of natural justice vitiated the whole proceeding, the tribunal that rendered the decision is bound to “start afresh”:

In this appeal we are concerned with the failure of the Board to dispose of the matter before it in a manner permitted by the *Architects Act*. The Board intended to make a final disposition but that disposition is a nullity. It amounts to no disposition at all in law. Traditionally, a tribunal, which makes a determination which is a nullity, has been permitted to reconsider the matter afresh and render a valid decision.

[...]

If the error which renders the decision a nullity is one that taints the whole proceeding, then the tribunal must start afresh. Cases such as *Ridge v. Baldwin*, [1964] A.C. 40 (H.L.); *Lange v. Board of School Trustees of School District No. 42 (Maple Ridge)* (1978), 1978 CanLII 343 (BC SC), 9 B.C.L.R. 232 (S.C.B.C.) and *Posluns v. Toronto Stock Exchange*, 1968 CanLII 6 (SCC), [1968] S.C.R. 330, referred to above, are in this category. They involve a denial of natural

⁷ [1968] UKHL 6.

⁸ *Ibid*, per Lord Reid.

⁹ [1989] 2 SCR 848.

justice which vitiated the whole proceeding. The tribunal was bound to start afresh in order to cure the defect.¹⁰

53. The Claimant could therefore ask the Registrar of Intellectual Property to start afresh and hear the Application for Invalidation *de novo*. This Claim was filed in 2019 and, after several procedural detours, only made its way for determination on the merits three years later. It might be that hearing the Application for Invalidation now would make no logical sense. The Court has not been updated on the current status of the mark at issue. However, should the Claimant still seek a hearing of the Application for Invalidation, it can make that request to the Registrar. The Court will not make that order, but will allow the Claimant to do so if it sees fit.

54. In summary, this Court's responses to the issues raised in the Pre-Trial Memorandum and which have not been abandoned are as follows:

b. Whether the ruling of the Deputy Registrar of Intellectual Property issued on the 11th day of January 2019 and published in volume No. 1 of the Journal of Intellectual Property is a nullity.

YES

c. Whether the publication of a Notice of Invalidation in the Journal of Intellectual Property constitutes service in accordance with the *Trade Marks Rules* and the *Companies Act*.

NO

d. Whether there is a duty placed on the Registrar to serve the Notice of Application for Invalidation on the Claimant.

YES

Costs

55. The Claimant, being successful in the Claim, is entitled to the Prescribed Costs in Rule 64, Annex B, applicable to claims of a value not exceeding \$50,000.

56. Prior to the hearing on paper of this Claim, the 3rd Defendant succeeded in an Application to Set Aside a Consent Order and the Claimant succeeded in resisting an Application to Strike Out the Claim. Both Applications were heard by James J., who ordered in both cases that costs of these Applications be costs in the cause. As it is customary where applications

¹⁰ *Chandler v. Alberta Association of Architects*, [1989] 2 SCR 848 at 862-863.

are concerned, the parties are directed to agree on costs with regard to the Applications. Should they be unable to agree, they can apply to this Court for a ruling on costs.

THIS COURT THEREFORE DECLARES AND ORDERS:

- (1) The ruling of the Deputy Registrar of Intellectual Property issued on the 11th day of January, 2019 and published in Volume 19, No. 1 of the Journal of Intellectual Property is a nullity;
- (2) The publication of a Notice of Invalidation in the Journal of Intellectual Property does not constitute service in accordance with the *Trade Marks Rules* and the *Companies Act*;
- (3) Costs of the Claim are awarded to the Claimant;
- (4) Costs with respect to the Application to Set Aside a Consent Order and the Application to Strike Out the Claim shall be agreed upon by the parties. Should the parties be unable to agree, they may apply to this Court for a ruling on costs.

Dated October 17th, 2022

Geneviève Chabot
Justice of the Supreme Court