

BETWEEN:

BERBACK QUILTING LIMITED APPELLANT.

1958
Jun. 23
Jul. 7

AND

THE REGISTRAR OF TRADE MARKS RESPONDENT.

Trade Mark—Trade Marks Act 1-2 Elizabeth II, s. 46(1)—Extension of time in which to file opposition granted one person does not permit others to file oppositions within the extended time.

Held: That an extension of time granted to one person to file an opposition under s. 46(1) of *The Trade Marks Act, 1-2 Elizabeth II, c. 49* does not have the effect of permitting others to file oppositions within the extended time.

APPEAL from a decision of the Registrar of Trade Marks.

The appeal was heard before the Honourable Mr. Justice Fournier at Ottawa.

Gordon F. Henderson, Q.C. for appellant.

S. F. M. Wotherspoon, Q.C. for Sanitized Process (Canada) Limited.

The facts and questions of law raised are stated in the reasons for judgment.

FOURNIER J. now (July 7, 1958) delivered the following judgment:

This is an appeal from the decision of the Registrar of Trade Marks, dated March 27, 1958, in the matter of an application by Berback Quilting Limited for an extension of time for the filing by the appellant of a statement of opposition against application serial No. 243,576 filed on December 23, 1957, by Sanitized Process (Canada) Limited for registration of a certification trade mark consisting of the word "SANITIZED" and advertised in the issue of the Trade Marks Journal of January 22, 1958.

On February 12, 1958, G. H. Wood & Co. Limited requested by letter an extension of time until March 22, 1958, for filing a statement of opposition to the said application. The reason given was that it was desirous of consulting other manufacturers and of considering the situation in the trade before making a decision with regard to filing an opposition. The request was granted upon certain terms. But having been unable to complete its

1958
 BERBACK
 QUILTING
 LTD.
 v.
 REGISTRAR OF
 TRADE
 MARKS
 Fournier J.

investigation, it requested further extensions on March 21 and April 18, 1958. The applicant having consented to same, the extensions were allowed. On May 20, 1958, the solicitor for G. H. Wood & Co. Limited advised by telegram the Registrar that the Company had no objection to the registration of a certification trade mark in the terms of the application on file and waived any right it had to file a statement of opposition. The Registrar, on May 22, 1958, allowed the application for registration of a certification trade mark consisting of the word "SANITIZED".

On February 28, 1958, the applicant, Sanitized Process (Canada) Limited, filed a statement of claim in the Court, claiming an injunction to restrain the appellant from infringing the alleged rights it had in the word "SANITIZED" as a certification mark.

On March 22, 1958, the appellant filed a statement of opposition to the application in the Trade Marks Office. On March 24, 1958, the appellant made an application requesting an extension of time within which the statement of opposition could be admitted. On March 27, 1958, the Registrar refused to extend the time and returned the statement of opposition on the grounds

- a) that an extension of time granted to one person to file an opposition under s. 46(1) of the act does not have the effect of permitting others to file oppositions within the extended time; and
- b) that he was not satisfied that the appellant was entitled to an extension of time pursuant to the provisions of s. 46(2) of the act.

On the day the application for registration was allowed, to wit, on May 22, 1958, the appellant made an *ex parte* application before the presiding judge in chambers for an order that no registration shall be granted by the Registrar pursuant to application serial No. 243,576 until this court has had an opportunity of hearing and deciding the appeal. Cameron J. ordered that the Registrar take no further step in disposition of the application until June 5, 1958; that the appellant, on notice to the respondent and Sanitized Process (Canada) Limited, may apply to this court for continuation of the order until the appeal had been heard and

decided; that the respondent and/or Sanitized Process (Canada) Limited, on notice to the appellant, may apply to this court to set aside the order.

In the appeal, it is submitted that the Registrar erred in refusing to extend the time under s. 46(2) and that he erred in holding that an extension of time granted under s. 46(1) of the *Trade Marks Act* to one person to file a statement of opposition does not have the effect of permitting others to file statements of opposition within the extended time.

Sanitized Process (Canada) Limited applied for registration of a certification mark under s. 23(1) of the *Trade Marks Act* 1-2 Elizabeth II., c. 49 which reads as follows:

23. (1) A certification mark may be adopted and registered only by a person who is not engaged in the manufacture, sale, leasing or hiring of wares or the performance of services such as those in association with which the certification mark is used.

This appeal is only concerned with an order for extension of time for the filing of a statement of opposition to the application of Sanitized Process (Canada) Limited.

The section to be considered and construed as to requests for extensions of time is s. 46 of the act.

46. (1) If, in any case, the Registrar is satisfied that the circumstances justify an extension of the time fixed by this Act or prescribed by the regulations for the doing of any act, he may, except as in this Act otherwise provided, extend the time after such notice to other persons and upon such terms as he may direct.

(2) An extension applied for after the expiry of such time or the time extended by the Registrar under subsection (1) shall not be granted unless the prescribed fee is paid and the Registrar is satisfied that the failure to do the act or apply for the extension within such time or such extended time was not reasonably avoidable.

By the above provisions of the act, the Registrar is vested with discretionary power to grant or refuse an extension of the time fixed by the Act or prescribed by the regulations for doing any act. But his discretion must be exercised within the framework of the act and under circumstances justifying the extension.

As was stated, the application was made pursuant to the provisions of s. 23(1) of the act. After receiving the application, the Registrar satisfied himself that it complied with the requirements of s. 29; that the certification mark was registrable and that the applicant was a person entitled

1958

BERBACK
QUILTING
LTD.

v.

REGISTRAR OF
TRADE
MARKS

FOURNIER J.

1958
 BERBACK
 QUILTING
 LTD.
 v.
 REGISTRAR OF
 TRADE
 MARKS
 Fournier J.

to registration of the mark because it was not confusing with another mark for the registration of which an application was pending; and he arrived at the conclusion that he could not refuse the application pursuant to the provisions of s. 36(1) of the act. Then he caused the application to be advertised in the manner prescribed by the Trade Marks Rules.

The rule applicable is rule 17. It reads as follows:

17. The Registrar shall cause to be published weekly a Trade Marks Journal containing

(a) every advertisement made pursuant to subsection (1) of section 36 of the Act;

The time within which a statement of opposition to an application may be filed is one month from the date of the advertisement.

37. (1) Within one month from the advertisement of an application, any person may, upon payment of the prescribed fee, file a statement of opposition with the Registrar.

No statement of opposition to the application was filed during the time specified, but during that period G. H. Wood & Co. Limited, by letter dated February 12, 1958, requested an extension of time until March 22, 1958. This extension of time was granted to the above Company on February 18, 1958. Other extensions, up to May 22, 1958, were granted to the same party with the consent of the applicant. On May 20, 1958, the solicitors for G. H. Wood & Co. Limited advised the Registrar by telegram that the Company had no objection to the registration of the certification mark in the terms of the application on file and waived any right it had to file a statement of opposition. This would seem to have terminated the extension of time. Following this, the Registrar, on May 22, 1958, allowed the registration.

The appellant submits that during the extension of time granted to G. H. Wood & Co. Limited any person was entitled to file an opposition to the application.

I cannot agree with this submission. It is true that, according to s. 37(1) of the act, any person may file a statement of opposition within one month from the advertisement of the application. But if no statement of opposition is filed or no request for an extension of time to file such a statement is made during the period of one month from the advertisement, the Registrar is in duty bound to follow the directions contained in s. 38(1) of the act.

38. (1) When an application either has not been opposed and the time for the filing of a statement of opposition has expired or it has been opposed and the opposition has been decided finally in favour of the applicant, the Registrar thereupon shall allow it.

1958
 BERBACK
 QUILTING
 LTD.

v.
 REGISTRAR OF
 TRADE
 MARKS
 Fournier J.

The last words of this section—"the Registrar thereupon shall allow it" are mandatory. The Registrar has no choice. When the application has not been opposed and the time for the filing of a statement of opposition has expired, he must allow the registration.

This being so, the extension of time provided for by s. 46(1) must be applied for prior to the expiration of the time fixed by the act. In my opinion, the wording of the section cannot be construed otherwise, because the moment the time for the filing of the statement of opposition has expired the applicant is entitled to the registration and the Registrar shall allow the registration.

Any person, before the time fixed for filing a statement of opposition, may apply for an extension of time. After the expiration of the time fixed and up to the date on which a registration is allowed, the Registrar, in his discretion, may grant an extension of time, if he is satisfied that the circumstances justify such an extension. The Registrar, in this case, was not satisfied that the circumstances justified an extension of time to the appellant.

After perusing every document on the Registrar's file and the notice of appeal and hearing arguments pro and con by counsel for the appellant and for Sanitized Process (Canada) Limited, I have come to the conclusion that the reasons given by the Registrar were, in my opinion, valid reasons for refusing the application for an extension of time for the filing of a statement of opposition to the application.

Though there is doubt as to the exact hour at which the registration was allowed on May 22, 1958, I am convinced that, when the appellant appeared before Cameron J. with an *ex parte* notice for an order that no registration should be granted by the Registrar until this court had heard and decided the appeal, the registration had been allowed. This having been the case, the granting of the appellant's appeal could have no effect. The certification having been registered, it would remain on the register though the appellant

1958
BERBACK
QUILTING
LTD.
v.
REGISTRAR OF
TRADE
MARKS
Fournier J.

succeeded in obtaining an extension of time to file an opposition. The statute provides for procedure to have the registration expunged.

Furthermore, I do not believe that the Registrar's decision has the effect of prejudicing the appellant's position. There is now a dispute before this court between the appellant and the intervenant and every question of fact or of law which is alleged in the statement of opposition can be alleged as part of the appellant's pleadings in the above procedure.

For these reasons, the appeal is dismissed, but, following the practice in such cases, there will be no order as to costs.

Judgment accordingly.