



STATEMENT OF CLAIM

ANTI-COUNTERFEITING ACTION

May Cheng, Osler, Hoskin & Harcourt LLP and
Georgina Starkman Danzig, Kestenberg Siegal Lipkus LLP



Statement of Claim (Anti-Counterfeiting Action)

[May Cheng](#), Osler, Hoskin & Harcourt LLP and [Georgina Starkman Danzig](#), Kestenberg Siegal Lipkus LLP

Court File No.: [Specify]

FEDERAL COURT

BETWEEN:

[NAME OF PLAINTIFF(S)]

("Plaintiffs")

-and-

JANE DOE and JOHN DOE and OTHER PERSONS, NAMES UNKNOWN, WHO DEAL IN UN-AUTHORIZED OR COUNTERFEIT [TRADE-MARK/[BRAND]] MERCHANDISE, AND THOSE PERSONS LISTED IN SCHEDULE "A" TO THE STATEMENT OF CLAIM

("Defendants")

STATEMENT OF CLAIM

TO THE DEFENDANTS:

A LEGAL PROCEEDING HAS BEEN COMMENCED AGAINST YOU by the Plaintiffs. The claim made against you is set out in the following pages.

IF YOU WISH TO DEFEND THIS PROCEEDING, you or a solicitor acting for you are required to prepare a Statement of Defence in [Form 171B](#) prescribed by the Federal Courts Rules, serve it on the Plaintiffs solicitor or, where the Plaintiffs do not have a solicitor, serve it on the Plaintiffs, and file it, with proof of service, at a local office of this Court, WITHIN 30 DAYS after this Statement of Claim is served on you, if you are served within Canada.

If you are served in the United States of America, the period for serving and filing your Statement of Defence is 40 days. If you are served outside Canada and the United States of America, the period for serving and filing your Statement of Defence is 60 days.

Copies of the Federal Courts Rules, SOR/98-106, information concerning the local offices of the Court and other necessary information may be obtained on request to the Administrator of this Court at Ottawa (telephone 613-992-4238) or at any local office.

IF YOU FAIL TO DEFEND THIS PROCEEDING, judgment may be given against you in your absence and without further notice to you.

DATED this [day] day of [month], [year].

Issued by: [Specify issuer]

Address of local office: [Address]

TO: JANE DOE AND OTHERS

CLAIM

1 The Plaintiffs' claim:

- (a) A declaration that the Defendants' importing, exporting, offering for sale, displaying, selling, producing, printing, manufacturing, distributing, advertising, warehousing, shipping, transferring or otherwise dealing in (hereinafter collectively "dealing in") any merchandise bearing the [BRAND] INTELLECTUAL PROPERTIES (as defined in para. 7 herein) and/or a substantial reproduction of same or confusingly similar thereto constitutes:
- i an infringement or is deemed to constitute an infringement, of the Plaintiffs exclusive rights to the use and benefit of the [BRAND] INTELLECTUAL PROPERTIES;
 - ii passing-off of the Defendants' goods, services and/or business as and for those of the Plaintiffs;
 - iii directing public attention to the Defendants' goods, services and/or businesses in such a way as to cause or be likely to cause confusion between the Defendants goods, services and/or business and those of the Plaintiffs;
 - iv unfair competition on the part of the Defendants; and
 - v depreciation of the value of the goodwill attaching to the [BRAND] marks.
- (b) An interim, interlocutory and permanent injunction restraining each Defendant (including by its officers, directors, servants, employees or agents) from infringing, passing-off, directing public attention or dealing in goods of any nature bearing any of the [BRAND] INTELLECTUAL PROPERTIES, including the Plaintiffs' names, marks, artistic designs and logos protected by trade-mark and copyright shown in Schedules "B" and "C" hereto or bearing any name, mark, artistic design or logo confusing therewith or a substantial copy thereof (hereinafter "unauthorized or counterfeit [BRAND] merchandise" or "unauthorized merchandise");
- (c) An interim, interlocutory and permanent injunction restraining each Defendant (including its officers, directors, servants, employees or agents) from using the [BRAND] INTELLECTUAL PROPERTIES or any other trade names, trade-marks and/or copyright confusingly similar to the trade names, trade-marks and/or copyright(s) including as referred to in Schedule "B" and "C" herein, in association with goods of any kind which are not manufactured by or for the Plaintiffs or in advertising, promoting or displaying unauthorized merchandise in association with such trade names, trade-marks and/or copyright;
- (d) An order in the nature of an Anton Piller Order;
- (e) An order directing each or any of the Defendants to pay to the Plaintiffs, or as the Plaintiffs shall direct, the costs associated with the cartage, storage and ultimate destruction of all merchandise bearing the [BRAND] INTELLECTUAL PROPERTIES delivered up in accordance with para. 11.4 above;
- (f) Damages sustained by the Plaintiffs or an accounting of the profits of each of the Defendants in respect of the Defendants' infringement or other violation of the [BRAND] INTELLECTUAL PROPERTIES, which the Plaintiffs may elect after an examination of each of the Defendants on the issues of the extent of their infringement or other violation and the quantum of their profits is conducted and judgment for that amount. Said damages to be multiplied on a per infringement basis for each instance of offering for sale and sale of infringing merchandise;
- (g) Statutory damages, at the Plaintiffs' sole election, for all instances of copyright infringement involved in the proceedings with respect to any work or other subject-matter, for which any Defendant infringer, individually or jointly and severally, is liable for, pursuant to ss. [38.1](#) of the *Copyright Act*, R.S.C. 1985, c. C-42, as amended;
- (h) Punitive and exemplary damages as against the Defendants, and each of them individually, commensurate with higher awards granted in counterfeiting cases;
- (i) Pre-judgment and post-judgment interest pursuant to ss. [36\(2\)](#) and [37\(2\)](#) of the *Federal Courts Act*, R.S.C. 1985, c. F-7, as amended;
- (j) Costs of this action on a solicitor/client basis together with any applicable HST; and
- (k) Such further and other relief as this Honourable Court may deem just.

THE PARTIES

- 2 The Plaintiff, [*name of trade-mark/copyright owner and place of incorporation*], having a principal office and place of business in [*location*] (hereinafter "Plaintiff A").
- 3 The Plaintiff, [*name of exclusive licensee and place of incorporation*], having a principal office and place of business in [*location*] (hereinafter "Plaintiff B").
- 4 Plaintiffs A and B are related companies as defined by s. 2 of the *Trade-marks Act*, R.S.C. 1985, c. T-13, as amended (hereinafter collectively referred to as "Plaintiffs" or "[*Specify*]").
- 5 The Defendants, Jane Doe and John Doe, are persons or entities, whose names and identities are presently unknown to the Plaintiffs, who deal in unauthorized or counterfeit merchandise bearing the intellectual property, including the trade-marks, trade names or copyright of Plaintiffs as described herein.

BUSINESS OF PLAINTIFFS

- 6 Plaintiff A is the owner, and Plaintiff B is licensee, of [*specify*] trade-marks worldwide, and of which the Canadian trade-mark registrations and applications are set out and particularized in Schedule "B" attached hereto (hereinafter the "[*BRAND*] Marks").
- 7 Plaintiff A is the owner of copyright in the original artistic work entitled "[*WORK name*]", in Canada and elsewhere. Plaintiff A owns a copyright registration in this work in Canada, which is attached as Schedule "C" hereto. The particulars of authorship and publication are shown in Schedule "C". The [*WORK Name*] copyright registration and the [*BRAND*] Marks are hereinafter referred to collectively as the "[*BRAND*] INTELLECTUAL PROPERTIES".
- 8 Plaintiff A owns all right, title and interest in and to the [*BRAND*] INTELLECTUAL PROPERTIES, including without limitation, the trade-marks, trade names, artistic designs, logos, trade dress and other distinctive elements associated with [*BRAND*] goods.

9

The [*BRAND*] Marks have been extensively and continuously used, promoted and advertised in Canada by the Plaintiffs in association with merchandise of the highest quality and design and other articles, including but not limited to, (list articles) and other articles more fully set out in Canadian Trade-mark registrations and applications particularized in Schedule "B" (hereinafter "[*BRAND*] goods"). The [*BRAND*] Marks also appear on the packaging, labels and hang tags affixed to or forming part of the [*BRAND*] goods, as well as in the advertising and promotional materials of the Plaintiffs.

- 10 Plaintiff A has extensively used, advertised and promoted the famous name and high reputation of the [*BRAND*] Marks throughout Canada in association with [*BRAND*] goods.
- 11 Goods bearing the [*BRAND*] Marks are recognized and well known in Canada and elsewhere around the world as being of the highest quality and design.
- 12 By virtue of its registrations and extensive use in Canada and elsewhere, Plaintiff A is the holder of the exclusive right to reproduce, distribute, manufacture and/or license the reproduction, distribution and manufacture of goods bearing or associated with the [*BRAND*] INTELLECTUAL PROPERTIES.
- 13 From a marketing and promotional standpoint, the [*BRAND*] Marks are highly successful, distinctive and create instant recognition and association with the public in Canada.
- 14 Plaintiff A has expended considerable sums of money in promoting the [*BRAND*] Marks in connection with high quality merchandise. As a result of such promotional activities, both the trade and public at large have come to identify [*BRAND*] Marks with Plaintiff A and its business and the same have developed a secondary meaning associating it with the [*BRAND*] Marks.
- 15 The marketing in Canada of the [*BRAND*] Marks and the goods bearing same, coupled with the spill-over of advertising and promotional material originating in other parts of the world contributes to the popularity of the [*BRAND*] goods in Canada and its penetration into the Canadian and global consumer market.

THE DEFENDANTS' WRONGFUL CONDUCT

- 16 The Defendants, without the consent, authorization or licence of the Plaintiffs, have dealt in or have caused others to deal in unauthorized or counterfeit [*BRAND*] merchandise and/or services and related merchandise, as well as plates, transfers, silk screens and other manufacturing materials used in the printing, production or manufacture in any manner of unauthorized or counterfeit [*BRAND*] merchandise.

- 17 The Defendants are aware of the reputation and goodwill associated with merchandise sold bearing any of the [BRAND] Marks and have attempted to attract the custom and benefit of same to themselves through their conduct.
- 18 The Defendants, as a result of their manufacturing and/or distributing of unauthorized or counterfeit [BRAND] merchandise, have misled the public into believing that said merchandise is connected with Plaintiff A and its merchandise. The sale of unauthorized or counterfeit [BRAND] merchandise by the Defendants constitutes an attempt to pass-off their merchandise as the goods, services or business of the Plaintiffs contrary to s. 7(c) of the *Trade-marks Act*.
- 19 The use of any [BRAND] INTELLECTUAL PROPERTIES or any other material owned by or licensed by the Plaintiffs and referred to herein, on the Defendants' unauthorized merchandise constitutes a false representation to ultimate consumers that Plaintiff A is connected, affiliated or otherwise associated with the dealing of such goods or has endorsed, approved or sponsored same. These misrepresentations are calculated to injure the business or goodwill of Plaintiff A.
- 20 This conduct of the Defendants is calculated to deceive the public into believing that the unauthorized or counterfeit [BRAND] merchandise dealt in by or for Plaintiff A and such deception or confusion is a reasonably foreseeable consequence of the conduct referred to herein.
- 21 The activities of the Defendants direct public attention to their goods, services and/or business in such a way as to likely cause confusion in Canada with the goods, services or business of Plaintiffs, contrary to s. 7 of the *Trade-marks Act*. Further, such activity amounts to unfair competition.
- 22 The dealing in by the Defendants in unauthorized or counterfeit [BRAND] merchandise and by using the [BRAND] INTELLECTUAL PROPERTIES or marks or logos confusingly similar thereto, to identify the unauthorized merchandise to the public at the time of the transfer of the property in the normal course of trade, is deliberately done in a manner so as to associate with such unauthorized merchandise the [BRAND] INTELLECTUAL PROPERTIES, such that notice of the association is given to the person to whom the property or possession is transferred.
- 23 By reason of the activities of the Defendants as set out hereinabove, the Defendants have infringed and are deemed to infringe the [BRAND] Marks, contrary to ss. 19 and 20 of the *Trade-marks Act*.
- 24 The aforesaid illegal activities of the Defendants seriously depreciate the value of the goodwill attached to [BRAND] Marks, contrary to s. 22(1) of the *Trade-marks Act*.
- 25 The Defendants' activities cause serious irreparable harm to Plaintiffs in Canada and to the valuable reputation of the [BRAND] Marks.
- 26 The Defendants will continue their wrongful acts unless restrained by order of this Honourable Court.
- 27 The Defendants' aforesaid illegal activities infringe the copyright in the [WORK Name] artistic work in Canada or are deemed to infringe such copyright, contrary to the *Copyright Act*.
- 28 Each of the Defendants was aware and had reasonable grounds to believe that copyright has been infringed, and have thus acted in bad faith, justifying the award of statutory damages pursuant to s. 38.1 of the *Copyright Act*.
- 29 There is a need for this Honourable Court to deter other infringements of the copyright in question.
- 30 Full particulars of the Defendants' infringing activities are not known to the Plaintiffs, but the Plaintiffs seek relief in relation to all wrongful acts of the Defendants.
- 31 By reason of the aforesaid acts of the Defendants, the Plaintiffs have suffered and continue to suffer damages and the Defendants have made a profit.
- 32 The Plaintiffs propose that this action be tried at [City].

DATED: this [day] of [month], [year].

[Name of Firm]

Barristers and Solicitors

[Address of Firm]

[Name of Solicitor of Record]

Telephone: [Telephone number]

Facsimile: [Fax number]

Solicitors for the Plaintiffs

SCHEDULE "A"

TO: JANE DOE and JOHN DOE *et al.*

[List of named defendants.]

SCHEDULE "B"

Trade-mark	Registration No. (Application No.) [Specify]	Goods/Services
[BRAND]		
[BRAND]		
[BRAND]		
[BRAND]		
[BRAND]		
[BRAND]		

SCHEDULE "C"

BRAND Copyright Registration

Court File No.: [Specify]

FEDERAL COURT

BETWEEN:

[NAME OF PLAINTIFF(S)]

("Plaintiffs")

--and--

JANE DOE and JOHN DOE and OTHER PERSONS, NAMES UNKNOWN, WHO DEAL IN UNAUTHORIZED OR COUNTERFEIT [TRADE-MARK/[BRAND]] MERCHANDISE, AND THOSE PERSONS LISTED IN SCHEDULE "A" TO THE STATEMENT OF CLAIM

("Defendants")

STATEMENT OF CLAIM

[Name of Firm]

Barristers and Solicitors

[Address of Firm]

[Name of Counsel of Record]

Telephone: [Telephone number]

Facsimile: [Fax number]

Solicitors for the Plaintiffs

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