

e-document		T-1567-24-ID 3	
F I L E D	FEDERAL COURT COUR FÉDÉRALE	D É P O S É	
July 31, 2024 31 juillet 2024			
Josephine Chan			
TOR		2	

Court File No.: T-1567-24

FEDERAL COURT

BETWEEN:

JUSTIN STITCHES INC.

Plaintiff /
Defendant by Counterclaim

-and-

MAKERS HOLDINGS INC.

Defendant /
Plaintiff by Counterclaim

STATEMENT OF DEFENCE and COUNTERCLAIM

DEFENCE

1. Except as expressly admitted herein, the defendant/plaintiff by counterclaim (the “Defendant”) denies all allegations in the statement of claim dated June 18, 2024 (the “Claim”) and puts the plaintiff/defendant by counterclaim (the “Plaintiff”) to the strict proof thereof.
2. The Defendant admits the allegations at paragraphs 3, 7, 12, 18, 20, 21, 27, and 28 of the Claim.
3. The Defendant has no knowledge of the allegations at paragraphs 2, 4, 5, and 8 of the Claim and put the Plaintiff to the strict proof thereof.
4. The Defendant specifically denies that the Plaintiff is entitled to any of the relief sought in paragraph 1 of the Claim.
5. With respect to the allegations at paragraph 11 of the Claim, the Defendant admits that it operates a number of retail stores offering for sale goods produced by

Canadian artists and small businesses, 8 of which are in British Columbia. Specifically, the Defendant operates 14 locations in Canada, in British Columbia, Alberta and Ontario. The Defendant opened its first store using MAKERS in or around April 2023.

6. The specific signage the Defendant uses at each of its store locations depends on the store itself, where the signage is to be displayed and the available space. For example, on some store locations the Defendant uses “SHOP MAKERS”, where “SHOP” is displayed in smaller font above the word “MAKERS” and on some store locations the larger text of “MAKERS” is displayed without “SHOP”.
7. With respect to the allegations at paragraph 6, 9 and 10, the Defendant denies the Plaintiff has any rights in the MAKE Trademark or the MAKE Trademark Design, that the Plaintiff has acquired any reputation and goodwill in British Columbia and Canada with the MAKE Trademark or the MAKE Trademark Design, or that MAKE is, or is capable of, being distinctive of the Plaintiff.
8. There are numerous third parties in Canada currently using “MAKE” as or as part of a trademark in association with the same or similar services for which the Plaintiff is using and has filed an application to register MAKE. A non-exhaustive list of these third-party marks include:

Registration Number	Trademark
TMA578960	MAKE
TMA973120	
TMA969926	MAKE MARKET
TMA982260	MAKE MARKET
TMA969933	MAKE MARKET
TMA1044170	MAKE MARKET
TMA973124	MAKE MARKET
TMA902699	MAKE ON
TMA978003	MAKE HAPPY
TMA893673	MAKE MEANING
TMA1029913	MAKE CREATIVITY HAPPEN

TMA1017311	MAKE GREAT TOGETHER
TMA1019065	
TMA812494	MAKE A STATEMENT
TMA832970	MAKE + MODEL
TMA1089561	MAKEOLOGY
TMA783356	MAKE LOVE NOT TRASH
TMA1143685	MAKE IT A LIFESTYLE
TMA853219	MAKE IT MINE!
TMA1095901	MAKE IT REAL
TMA513265	MAKE'N MOLD

9. With respect to the allegations at paragraph 19, the Defendant admits that it declined to make an agreement with the Plaintiff regarding its trademark and trade name and that it indicated it was going to transition to the name “Shop Makers”. The Defendant expressly provided no specific terms with respect to how or when this transition would occur, nor did it ever indicate this transition would include permanently ceasing use of “Makers”.
10. The Defendant disagrees with the Plaintiff’s proposal that this action be tried at Vancouver, British Columbia, and proposes instead that this action, and counterclaim (as discussed below) be tried together at Toronto, Ontario.

COUNTERCLAIM

11. The Defendants seek a declaration that:
 - a. the Plaintiff does not have any rights to the MAKE Trademark and the MAKE Trademark Design in Canada; and
 - b. the Defendant has not violated the Plaintiff’s alleged rights in the MAKE Trademark or the MAKE Trademark Design, including by:

- i. directing public attention to its services and business in such a way as to cause or be likely to cause confusion between its services and business and the services and business of the Plaintiff, or
 - ii. passing off the Defendant's services and business for those of the Plaintiff.
- 12. The Defendant repeats and relies on the allegations in the Statement of Defence.
- 13. Further to paragraph 7 of the Statement of Defence, the MAKE Trademark and the MAKE Trademark Design are not, and cannot be, distinctive of the Plaintiff considering the presence of numerous third parties using and having registered trademarks for or containing MAKE in association with similar goods and services.
- 14. Since the Plaintiff has not, and cannot have, developed reputation and goodwill in the MAKE Trademark and the MAKE Trademark Design, the Defendant has not, and cannot have, directed public attention to its goods, services or business in a manner that contravenes section 7(b) of the *Trademarks Act*, nor could it have passed off its services and business as those of the Plaintiff in a manner that contravenes section 7(c) of the *Trademarks Act*.
- 15. The Defendant proposes that this counterclaim be tried together with the action at Toronto, Ontario.

Dated at Toronto, Ontario this 31st day of July, 2024.



SHIFT LAW P.C.

60 St. Clair Avenue East, Suite 300
Toronto, Ontario
M4T 1N5

John H. Simpson

jsimpson@shiftlaw.ca

Rebecca Kupfer

rkupfer@shiftlaw.ca

Tel: 647-361-7533

**Solicitors for the Defendant /
Plaintiff by Counterclaim**

TO: SEASTONE IP LLP
Suite 520 – 800 West Pender Street
Vancouver, BC V6C 2V6

Mathew Brechtel
mbrechtel@seastoneip.com

Kevin Bushell
kbushell@seastoneip.com

Tel: (604) 416-4148

**Solicitors for the Plaintiff /
Defendant by Counterclaim**