BETWEEN:

THE DEPUTY ATTORNEY GENERAL OF CANADA ..... APPELLANT;

1964
Sept. 10, 11
Sept. 11

AND

JANTZEN OF CANADA LIMITED .....RESPONDENT.

Trade Marks—Registration—Opposition to application for registration of word trade mark—Whether trade mark descriptive or misdescriptive —Connotation of trade mark one of impression and not to be based on research into meaning of words—Trade Marks Act, c. 49, S. of C. 1953, ss. 2(t), 7(d), 12(1)(b), 55 and 58(3).

This is an appeal by the Deputy Attorney General of Canada from a decision of the Registrar of Trade Marks rejecting the appellant's opposition to an application by the respondent for registration of the word "Waterwool" as a trade mark intended by the respondent to be used in association with ladies' and men's sweaters, ladies' and men's shorts, ladies' skirts, ladies' slacks and ladies' knitted suits and dresses, limited to such garments made of wool or in which the majority of the fibres or textiles are composed of wool

Held That the word "Waterwool" when used in relation to garments does not connote that the garment has a certain appearance, i.e., a wavy lustrous finish or an undulating sheen.

2 That the word "Waterwool" may mystify the person who is confronted with it in association with a garment and it may even vaguely suggest some association with wool, but it does not describe the garment as being made of the wool of any animal.

3. That the decision as to the connotation of a trade mark must be one of impression and must not be based on research into the meaning of words.

4. That the proposed mark, having no specific descriptive connotation, is capable of distinguishing the wares of the respondent from the wares of others.

5 That on the facts of this case at least, if the trade mark does not fall within s. 12(1)(*b*) of the *Trade Marks Act* and meets the requirements of s. 2(*t*), its use will not necessarily contravene s. 7(*d*).

6 That the appeal is dismissed.

APPEAL from a decision of the Registrar of Trade Marks.

The appeal was heard by the Honourable Mr. Justice Jackett, President of the Court at Ottawa.

G. W. Ainslie for appellant.

J. A. Devenny for respondent.

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

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JACKETT P. at the conclusion of the argument (September 11, 1964) delivered the following judgment:

Having regard to the nature of this case, I do not see any reason for reserving my judgment, and I propose therefore to deliver my reasons at once.

This is an appeal by the Deputy Attorney General of Canada under section 55 of the *Trade Marks Act,* chapter 49 of the Statutes of Canada, 1953, from a decision of the Registrar of Trade Marks dated August 26, 1963, rejecting the appellant's opposition to an application by the respondent for the registration of a word spelled "W-a-t-e-r-w-o-o-l" as a trade mark.

In March 1962, the respondent applied under the *Trade Marks Act* for registration of the word "Waterwool". The applicant stated that it intended to use the mark in Canada in association with ladies' and men's sweaters, ladies' and men's shorts, ladies' skirts, ladies' slacks, and ladies' knitted suits and dresses, and it requested registration in respect of such wares.

In September 1962, there was filed a revised application identical in all respects with the first except that the classes of wares to which the proposed mark would apply were further restricted by inserting the words "limited to such garments made of wool or in which the majority of the fibres or textiles are composed of wool" to modify all the classes of wares as originally described.

An opposition to the respondent's application, dated September 26, 1962, was filed by the International Wool Secretariat. As, however, it appears that each opposition is regarded as a separate proceeding under the Act in respect of which the Registrar gives a separate decision, there is no need for me to refer further to such opposition.

In October 1962, the appellant filed a Statement of Opposition. This statement put forward the following grounds of opposition:

> (a) the application as amended discloses that the applicant intends to use the mark in Canada in association with a class of clothes or articles of wearing apparel such as ladies' and men's sweaters; ladies' and men's shorts; ladies' skirts; ladies' slacks; and ladies' knitted suits and dresses; limited to such garments made of wool or in which the majority of the fibres or textiles are composed of wool, but the application does not limit the use of the mark to fabrics having a material content of 100% wool;

(b) the applicant is a manufacturer of ladies' and men's sportswear which in the course of its manufacture uses fabrics, but the applicant is not a manufacturer of any fabric, cloth or material;

(c) the use of the word "wool" alone or in combination with any other word as a trade mark in association with any fabric having a material content of a combination of wool and some other material, and not of 100% wool, is a description which is false in a material respect and which is likely to mislead the public as to the character, quality or composition of the fabric and use of which is prohibited by virtue of para. (d) of section 7 of the Trade Marks Act, Ch. 49, S. of C, 1952-53;

(d) the use of the word "wool" alone or in combination with any other word as a trade mark in association with any fabric having a material content of a combination of wool and some other material and not of 100% wool, is prohibited by virtue of section 10 of the said Trade Marks Act since it is a mark which has by ordinary and bona fide commercial usage become recognized in Canada as designating the kind or quality of the fabric with which it is associated;

(e) the proposed use by the applicant of the word "Waterwool" in association with any fabric is not a trade mark within the meaning of para (t) of section 2 of the said Trade Marks Act because the applicant does not intend to use the mark for the purpose of distinguishing the ladies' and men's sportswear which are the applicant's wares from those manufactured by others;

(f) the use of the word "wool" alone or in combination with any other word as a trade mark in association with any fabric having a material content of a combination of wool and some other material and not of 100% wool is a trade mark which is not registrable under the said Trade Marks Act by virtue of para (b) of ss 1 of section 12 since it is a trade mark which is deceptively misdescriptive;

(g) the use of the word "wool" alone or in combination with any other word as a trade mark in association with any fabric having a material content of 100% wool, is a trade mark which is not registrable under the said Trade Marks Act by virtue of para (b) of ss 1 of section 12 since it is a trade mark which is clearly descriptive,

(h) the proposed use by the applicant of the word "Waterwooll" in association with any fabric is not a distinctive mark and not registrable by virtue of para (d) of ss 2 of section 37 of the said Trade Marks Act

In November 1962, the respondent filed a Counter-Statement, taking the position *inter alia* that "Waterwool" is a coined word that has no meaning and that it is quite distinctive and quite capable of distinguishing the respondent's wares from the wares of others. It also alleged there are a large number of registrations on the records of the Trade Marks Office covering trade marks including the word "wool" or a phonetic spelling thereof as applied to fabrics, clothing, blankets, piece goods and the like.

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In January 1963, the respondent filed in the Trade Marks Office evidence of a number of such registrations.

On August 26, 1963, the Registrar delivered reasons for dismissing the opposition.

The appellant appealed under section 55 of the *Trade Marks Act* by Notice of Appeal dated October 11, 1963, on the following grounds:

1. That the learned Registrar erred in holding that he only had jurisdiction to deal with objections to an application within the terms of section 37 of the Trade Marks Act.

2. That the learned Registrar erred in holding that the proposed trade mark "Waterwool" is registrable.

3. That the learned Registrar erred in holding that the proposed trade mark "Waterwool" is distinctive.

4. That the learned Registrar erred in rejecting the Opposition.

The respondent filed a Reply dated November 21, 1963, taking the contrary position to that taken by the appellant on each of his grounds and alleging that the onus is on the appellant to satisfy the Court that the Registrar erred.

On March 26, 1964, an order was made permitting the parties to file affidavit evidence. Affidavits have been filed by the respondent as follows:

1. The affidavit of Aaron E. Kline who says that he is an officer of the respondent company; that he has been associated with the textile business for the past forty-five years; that during the course of his association with the textile business he has never heard of or seen the words "Water-Silk" used to describe any textile; that during the course of his association with the textile business he has never seen or heard of a woollen fabric having a wavy lustrous pattern, and has never seen the word "water" used, in the textile trade, in association with the name of any fabric to denote that the fabric has a wavy lustrous pattern; and that in so far as his knowledge of the textile industry is concerned he knows of no method which has been devised to develop and retain a wavy lustrous pattern on a woollen fabric; and in his opinion any attempt to form a wavy lustrous pattern in a woollen fabric would not be successful as wool has a non-static quality.

2. The affidavit of Joseph H. R. Tourigny who says that he has been associated with the textile business for the past eighteen years, during which time he has been

engaged in the selling and handling of cotton, woollen and synthetic fabrics; that during the course of his association with the textile business he has never heard of a fabric called "Water-Silk", and that during the course of his association with the textile business he has never seen or heard of a woollen fabric having a wavy lustrous pattern.

3. The affidavit of Albert N. Fox who says that he is the owner of a company dealing in men's furnishings in Vancouver; that he has been associated with the textile business for the past thirty years, and that the word "Waterwool" as applied to garments does not connote to him that the garments would have a wavy lustrous pattern.

There was a fourth affidavit filed by the respondent, setting out information obtained by the deponent Hilda Nezan by a search at the Canadian Trade Marks Office concerning registrations in respect of which the words "wool" or "water" might be considered to have a descriptive or misdescriptive connotation. During the course of the hearing, pursuant to a direction given under subsection (3) of section 58 of the *Trade Marks Act*, the respondent filed certified copies of certain trade marks as more specific evidence of the same character. These have been filed as Exhibits R-1 to R-9 inclusive. The appellant made a motion during trial to strike out or reject both the Nezan affidavit and Exhibits R-1 to R-9 inclusive on the ground that the past practice of the Registrar is not relevant to the determination of the issues in this appeal. I regarded the question raised by this motion as being of considerable importance and some difficulty. I therefore reserved my decision on the motion and indicated that I would allow counsel time to file written argument on the point.

As I have now decided to dismiss the appeal without taking the evidence concerning prior registrations into account, I do not propose to render any decision on the appellant's motion. I should also say that I have not taken into account in any way, in reaching my conclusion, the similar evidence that is to be found on the official file of the Registrar of Trade Marks.

I come now to the merits of the appeal. It is common ground, I believe, that if the proposed mark falls within

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paragraph (*b*) of section 12(1) of the *Trade Marks Act*, it is not "registrable" and the appeal should be allowed. It is also clear that to be a trade mark under the Act, section 2(*t*) requires a mark to be a mark that is used by a person for the purpose of distinguishing or so as to distinguish the wares manufactured, sold, etc., by him, from the wares manufactured, sold, etc., by others.

The main attack made on the proposed mark in this case is that the proposed mark falls within the ban of section 12(1)(*b*), which reads as follows:

> 12. (1) Subject to section 13, a trade mark is registrable if it is not
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> * * *
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> (*b*) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French languages of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;

Allied to the attack under section 12(1)(*b*) was the contention that, when used, the proposed mark would not distinguish the goods of the respondent from the goods of others.

The appellant's first endeavour to bring the word "Waterwool" within the words "descriptive" or "misdescriptive", depending on the wares in respect of which it might be used, was an argument that the word "water" in relation to fabrics connotes "a wavy lustrous finish" or "an undulating sheen", and that "Waterwool" used in relation to garments, means, therefore, that the garment has a certain appearance, that is, a wavy lustrous pattern.

While the dictionary definitions of "water" put before me by counsel for the appellant may establish that when the word "water" is used in relation to fabrics such as silk, it connotes that they have an undulating sheen or a wavy lustrous pattern, it is a matter on which I need make no finding, because I am unable to appreciate any such application of the word "water" in relation to woollen fabrics having regard to the very nature of such fabrics. In this view I am supported by the affidavit evidence the admissibility of which has not been objected to by the appellant. I therefore reject the submission that "Waterwool" when used in relation to garments connotes that the garment has a certain appearance, that is, a wavy lustrous finish or an undulating sheen.

The appellant's second endeavour to bring the word "Waterwool" within section 12(1)(*b*) as being either "descriptive" or "misdescriptive" was his submission that this word, when used in relation to a garment, connotes that the garment is made of wool.

Clearly the word "wool" or "woollen" would, if used in relation to garments, indicate that they were made of wool. The question is whether the presence of the four letters "w-o-o-l" in the word "Waterwool" conveys the same idea. In other words, does the appearance and the sound of the word "wool" in the coined word "Waterwool" so dominate that coined word that it conveys the clear cut idea of being made of wool, notwithstanding the presence of the letters "w-a-t-e-r" which are completely meaningless in the context? Put another way, does the combination of the word "water" with the word "wool"—a combination which in my view is either meaningless or nonsensical—neutralize the word "wool" so that it no longer conveys the idea that a garment is made of wool?

My first impression, and my present impression, is that "Waterwool" may mystify the person who is confronted with it in association with a garment; it may even vaguely suggest some association with wool; but it does not describe the garment as being made of the wool of any animal.

I accept the appellant's submission that the decision must be one of impression and must not be based on research into the meaning of words, and I find that the second attempt to bring the proposed trade mark under section 12(1)(*b*) also fails.

I also find that the proposed mark, having no specific descriptive connotation, is capable of distinguishing the wares of the respondent from the wares of others.

I do not find it necessary to deal with the argument that the Registrar erred in holding that he only had jurisdiction to deal with objections to the application that fall within the terms of section 37 of the *Trade Marks Act,* as, even if the objections made by the appellant under section 7(*d*) and section 10 of the Act were open to him, I would reject them. On the facts of this case at least, if the trade mark does not fall within section 12(1)(*b*) and meets the requirements of section 2(*t*), its use will not necessarily contravene

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section 7(*d*). No submission was made to me by the appellant in support of the contention that section 10 prohibits the grant of registration, and I cannot appreciate its application to the facts of this case.

The appeal is dismissed with costs.

Judgment accordingly.