

1959
June 4
July 7

BETWEEN :

THE ASSOCIATION OF PROFESSIONAL ENGINEERS OF THE PROVINCE OF ONTARIO

APPELLANT;

AND

THE REGISTRAR OF TRADE MARKS

RESPONDENT.

Trade Mark—The Trade Marks Act, 1-2 Eliz. II, c. 49, s. 37(2)(d)—Words “Finishing Engineer” not registrable—Words clearly descriptive of wares with which they are used—Appeal from Registrar of Trade Marks allowed.

Held: That the words “Finishing Engineer” used as the title of a periodical by an applicant for registration of the same, are clearly descriptive of the character and quality of the applicant’s wares in association with which they are used or proposed to be used and therefore not registrable under the provisions of the *Trade Marks Act, 1-2 Eliz. II, 1952-53 Statutes of Canada, c. 49, s. 37(2)(d).*

APPEAL from a decision of the Registrar of Trade Marks.

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

D. Sim for appellant.

No one for respondent.

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

FOURNIER J. now (July 7, 1959) delivered the following judgment:

This is an appeal from a decision of the Registrar of Trade Marks rejecting an opposition filed on behalf of The Association of Professional Engineers of the Province of Ontario to the registration of a trade mark consisting of the words "Finishing Engineer" to be used as the title of a periodical publication. The application was filed on September 23, 1955 by Metalwash Machinery Company, having its head office and principal place of business in Elizabeth, New Jersey, United States of America. The opposition was dated May 17, 1957. The Registrar, on September 6, 1958, delivered his decision rejecting the opposition and approving the registration of the trade mark.

Notice of this appeal was filed on October 21, 1958. After it having been served, the President of this Court made an order requiring Metalwash Machinery Company, the applicant, and/or the Registrar of Trade Marks to file and serve a reply to the notice of appeal within 28 days from the date of service of the order on each of them. The file shows that on November 21, 1958 the order was served on Fetherstonhaugh & Co., who, for service purpose, are the Canadian representatives of the applicant company, and on the Registrar of Trade Marks. No reply was filed and served by either of the parties. On May 28, 1959 the President made an order setting down this matter for hearing on June 4, 1959. So this is an *ex parte* proceeding. The opponent did not adduce any new evidence but relied on the facts that were on file before the Registrar.

The opponent bases his appeal on the ground

- a) that the Registrar erred in holding that the trade mark was not clearly descriptive or deceptively mis-descriptive of the character or quality of the wares within the meaning of section 37(2)(d) of the *Trade Marks Act*, chapter 49, 1-2 Elizabeth II (1952-53 Statutes of Canada);

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b) that the adoption and use by the applicant of the trade mark would constitute a breach of the provisions of *The Professional Engineers Act*, Chapter 292, Revised Statutes of Ontario, 1950.

The section of *The Trade Marks Act* hereinabove referred to reads:

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.

(2) Such opposition may be based on any of the following grounds:

(d) that the trade mark is not distinctive.

The applicant filed its application for registration of the trade mark "Finishing Engineer" which had been registered in the United States on December 25, 1954 in association with its wares—periodicals. The trade mark had been in use in the United States and in Canada. At the request of the Registrar, it filed a certified copy of the United States registration No. 600,170. As the registration was made on the Supplemental Register, the applicant filed a revised application. The above proceedings were made between the date of the original application of September 23, 1955 and June 29, 1956, when the revised application was filed in the Registrar's office. On July 30, 1956, the application having been processed and examined, the Registrar sent the following letter to the applicant and to its attorneys:

Your file No. 20161-355

The mark for which registration is sought is considered to be clearly descriptive or deceptively misdescriptive of the character or quality of the wares in association with which it is used.

In view of provisions of Section 12 (1)(b) of *The Trade Marks Act*, this mark does not appear to be registrable.

Any comments you may wish to make will receive consideration.

The section referred to in the letter reads as follows:

12. (1) Subject to section 13, a trade mark is registrable if it is not

(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;

On October 5, 1956 the attorneys for the applicant sent several issues of its periodical to the Registrar and a letter which in substance states that the periodical deals with its

products with the result that it refers to many featured articles not restricted to a discussion of finishing but of general interest in the field of multistage conveyors and washing machines. It concludes with the submission that the words "Finishing Engineer" while suggestive are not clearly descriptive or deceptively misdescriptive.

After finding that the applicant had complied with the provisions of section 16 of the Act, the Registrar advertised the application in the *Trade Marks Journal*. Then the opponent filed its opposition to the registration of the trade mark on the grounds stated *supra*. In a counter-statement, the applicant denied that these grounds were applicable in the present instance. As evidence, both parties submitted affidavits and then filed written argument pursuant to Rule 48(3). No further hearing before the Registrar was requested. Later the Registrar delivered his decision.

The decision repeats the grounds of opposition to the registration of the trade mark as set out by the opponent and concludes with the words,

I have considered the evidence on file and have arrived at the decision that the grounds of opposition as filed by the opponent are not well founded. Accordingly the opposition is rejected pursuant to section 37 of *The Trade Marks Act*.

The evidence to which the Registrar refers consists of affidavits, several issues of the periodical, a copy of the registration of the trade mark "Finishing Engineer" in the United States Patent Office No. 644,046, filed January 14, 1954, the application itself and the opponent's opposition.

The applicant filed with the Registrar the affidavits of Robert K. Nolte, Andrew B. K. Anderson, John William McCarthy and Donald E. Moody, and the opponent supported his opposition with the affidavit of T. M. Medland of the city of Toronto.

The president of Metalwash Machinery Company states that the magazine "Finishing Engineer" was never intended to suggest that any one connected with its publication was practising professional engineering in Ontario or anywhere else; it was merely intended to indicate that the publication contains material of interest to people in the finishing business, for example, finishing engineers. It contains, in

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many instances, information provided by professional engineers qualified in their local jurisdiction and obtained from other sources.

Mr. Andrew B. K. Anderson declares that he has been familiar for approximately two years with the publication "Finishing Engineer". He knows that the publication gives a general description of some of the most recent developments in the cleaning of metal parts and the phosphate coating of metal parts. The title of the magazine correctly indicates the nature of the publication. It never occurred to him that the title of the magazine indicated that those connected with it were entitled to practise professional engineering in Canada or elsewhere.

As to Mr. McCarthy he knows that the periodical "Finishing Engineer" is a publication purporting to inform professional engineers and their associates of developments being made in the finishing business. The title indicates the nature of the contents of the publication but does not indicate that those connected with the magazine are practising or are entitled to practise as professional engineers in Ontario or elsewhere.

Mr. Moody, president and general manager of Canefco Limited, Toronto, states that his company has a licence and technical service agreement with Metalwash Machinery Corporation for the manufacture of its equipment in Canada. The name of the publication "Finishing Engineer" indicates to him that it is directed to the heads of departments of companies responsible for the finishing of fabricated or manufactured parts within their company. To his knowledge, no one in the employ of the publisher of the magazine practises professional engineering in Ontario. He does not believe that the title indicates that those connected with it are professional engineers.

On behalf of the opponent, Mr. T. M. Medland, executive director of The Association of Professional Engineers of the Province of Ontario, made a statutory declaration. He says that one of the duties of the Association is to protect the profession and the public from unauthorized practices in the field of engineering and from the unauthorized use of the words "Professional Engineer" or any abbreviation thereof which would be likely to deceive or mislead the

public. The Association has prosecuted several individuals and companies who have made use of the above words. The actions were taken under the provisions of Section 30 of *The Professional Engineers Act*, R.S.O. 1950, Chapter 292.

As to the issues of the periodical filed with the Registrar and which I have perused, they deal with the applicant's products and the products of other firms to which they have made contributions. They contain technical information, articles and engineering data of interest to those who are engaged in finishing materials and in the finishing business. It is stated in the affidavits that the title correctly indicates the nature of the publication and its contents and is directed to the heads of departments of companies responsible for the finishing of fabricated parts.

Copies of the periodical being part of the evidence on file, I shall cite how the applicant describes its magazine in its issue of January 1953 (reverse side of the front cover):

The Finishing Engineer is a medium for the exchange of ideas and information of interest to men who are concerned with the cleaning, pickling and drying of metal parts.

The Finishing Engineer has been received enthusiastically by executives and engineers to whom new methods and new materials for finishing are subjects of daily concern or discussion.

We invite your comments and suggestions. If there is any specific subject you would like to see discussed in a future issue of Finishing Engineer we shall be delighted to hear from you.

For convenience, I repeat, the opponent contends that the trade mark is clearly descriptive or deceptively mis-descriptive of the character or quality of the wares and that its adoption would constitute a breach of the *Professional Engineers Act of Ontario*. The applicant denies the last-stated ground to be in accordance with the provisions of the Act and alleges that his wares are distinctive.

The wares, in this instance, are a periodical publication bearing the title "Finishing Engineer". The question to be determined here is whether the words "Finishing Engineer" are capable of being distinctive of the applicant's ware.

The purpose of a trade mark is to distinguish the goods of a trader. It has been recognized and held by the courts that descriptive words are the property of all and cannot

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be appropriated by one person for his exclusive use; so descriptive words are not proper subjects for the granting of a trade mark monopoly. In order to obtain the benefit of the provisions of the *Trade Marks Act* its requirements have to be met. To be registrable the trade mark must be distinctive. It is not registrable under the Act if it is either clearly descriptive or deceptively misdescriptive of the character of the wares or services of the applicant. Distinctiveness is the essence of a trade mark. The trade mark is a symbol not to describe but to distinguish particular wares within a general category from other wares in the same category.

The title of the applicant's publication is composed of two common English words. In ordinary language and used as the title of a periodical, in my opinion they would mean that the publication deals with information, data and details of interest to engineers trained in the finishing arts, to wit, those who are charged to complete or finish works of things or undertakings, such as finishing engineers. It appears to me that those who are familiar with the publication and who have signed the affidavits on file agree that the title indicates or describes the contents and the nature of the publication. To complete the picture, the publication, as said above, was well received by executives and engineers to whom new methods and new materials for finishing are subjects of daily concern or discussion.

There is no doubt that the title "Finishing Engineer" is clearly descriptive of the character or quality of the wares in connection with which it is proposed to be used.

In the *Standard Ideal Company v. Standard Sanitary Manufacturing Company* case¹ Lord Macnaghten dealt with the essentials necessary to constitute a trade mark in the following words:

. . . Without attempting to define "the essentials necessary to constitute a trade mark properly speaking" it seems to their Lordships perfectly clear that a common English word having reference to the character and quality of the goods in connection with which it is used and having no reference to anything else cannot be an apt or appropriate instrument for distinguishing the goods of one trader from those of another. Distinctiveness is the very essence of a trade mark. The plaintiff company was therefore not entitled to register the word "standard" as

¹[1911] A.C. 78, 85.

a trade mark. The result is, in accordance with the decision of the Supreme Court in *Parilo v. Todd*, 17 S.C.R. 196, that the word though registered is not a valid trade mark. . . .

Before the coming into force of the present *Trade Marks Act*, 1953, titles of publications were not registrable as such but there were a number of judicial decisions in which the owners of publications having certain titles brought action against others for passing off. In those cases the court maintained the action for passing off if the trade mark was distinctive but refused it if the title was descriptive. Now the law relating to registrability of trade marks is the same as the law relating to infringement or passing off. So the following decisions are relevant to this dispute.

In the case of *International Press Limited v. Tunnell*¹ the title "Who's Who" in Canada was held to be a descriptive title and did not entitle the publisher to restrain publication of a rival work of the same type given a most similar title.

In *McIndoo v. Musson Book Company*², "Canadian Bird Book" was considered a descriptive title and not entitled to protection. In 1897, a similar decision was rendered in *Rose v. McLean Publishing Company*³ concerning the title "The Canadian Bookseller". In the *Fawcett v. Valentine* case⁴, Cameron J. of this Court held that "True Confessions" was a descriptive title and not entitled to protection; the claim for an injunction and passing off was not successful.

Counsel for the opponent referred the Court to a number of English decisions in which owners of publications brought action against others for passing off by using the same title or one having similarity with their own. I shall mention the *Ridgway v. Hutchinson* case⁵, in which it was held that the title "Adventure" for a periodical was descriptive of the contents of the publication and—that the plaintiffs were seeking to establish to an unreasonable extent a monopoly in a common English word.

¹[1938] 1 D.L.R. 393.

²(1916) 35 O.L.R. 342.

³(1897) 27 O.R. 325.

⁴(1949-50) 10 Fox's Patent Cases, 203.

⁵(1923) 40 R.P.C. 335.

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There is a rule which is followed in granting or denying registration of a word or a combination of two words: *Lightning Fastener Co. Ltd. v. Canadian Goodrich Co. Ltd.*¹; at page 197 it is stated:

But, in order to deny registration of a word on the ground that it is descriptive, it must be shown that, at the date of the application (which is the date to be taken into consideration), the word was a descriptive name in current use, descriptive of the article itself as distinguished from a name exclusively distinctive of the merchandise of a particular dealer or manufacturer.

In the present instance the trade mark "Finishing Engineer", at the date of the application for registration, comprised two English words used to describe persons who were trained and engaged in the engineering field and specialized in the finishing arts. The use of these two words as the title of a publication is sufficient to impart the knowledge that it will contain ideas, data, information to executives and engineers to whom new methods and new materials for finishing are of interest. In other words, "Finishing Engineer" describes clearly one who deals with the science of engineering and the finishing arts. That is exactly what the publication does. It is not distinctive of the applicant's publication but a clear description of its contents. Grammatically and in ordinary language, the use of these two words as the title of a periodical call immediately to my mind (and, I believe, to the mind of those who read them) the quality or character of the publication. I do not see any other purpose for which the words could be used or any other significance which could be attached to them.

In deciding whether or not words ought to be registered I believe the right approach to the problem is that expressed by Evershed J. in *La Marquise Footwear, Inc.*² in the following words:

I think that, in approaching a problem of this kind, one has to bear in mind that the Court must consider, as the Legislature considered, whether the use of particular marks in reference to particular goods would embarrass or harass other traders, and it seems to me that, where you take an ordinary word in common use properly applicable in its ordinary meaning to the class of goods to which it is sought to be applied by the applicant, the Court must be slow to give to the applicant in effect a monopoly of that epithet.

¹[1932] S.C.R. 189.

²(1947) 64 R.P.C. 27, 32.

In my view, the registration of the trade mark "Finishing Engineer" would give the applicant a monopoly on these words to be used as the title of its periodical. This would certainly embarrass and harass any one who would endeavour to publish writings, books or publications under a title, the first word of which would be "Finishing", followed by another word related to engineering, such as "Finishing Engineering", "Finishing Engineers' Handbook" or "Finishing Engineers' Information". All these publications would deal with the finishing arts and would indicate the nature of their contents. The word "nature" being defined in English dictionaries as "character", the above publications would be characterized by their titles.

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For the reasons given *supra*, I find that the words "Finishing Engineer" used as the title of the applicant's periodical are clearly descriptive of the character and quality of the applicant's wares in association with which they are used or proposed to be used and therefore not registrable under the provisions of the *Trade Marks Act*. Having arrived at that decision, I shall not deal nor express an opinion on the second ground invoked in the notice of appeal.

The judgment of the Court is that the appeal be allowed and the decision of the Registrar of Trade Marks set aside. The trade mark is not registrable; and if it has been registered, it should be expunged from the Registry of Trade Marks.

Under the circumstances, there will be no costs.

Judgment accordingly.