

GRILL GEAR MARK NOT DESCRIPTIVE, FEDERAL COURT RULES

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What is the relevant date to decide whether a trade-mark is registrable in opposition proceedings under Canada's *Trade-marks Act*, R.S.C. 1985, c. T-13 (the "Act")? Many would have answered that this question was definitely settled by Canada's Federal Court of Appeal in *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 403 where the Court decided that registrability of a trade-mark is to be assessed at the date of the Registrar's decision disposing of the opposition and in *Lubrication Engineers, Inc. v. Canadian Council of Professional Engineers* (1992), 41 C.P.R. (3d) 243 where the Court decided that registrability as it concerns more particularly descriptiveness is also to be assessed at the date of the Registrar's decision (in light of the Court's previous *Park Avenue* decision). This decade old principle has now been questioned in the recent case of *Fiesta Barbeques Limited v. General Housewares Corporation*, 2003 FC 1021, (September 4, 2003, Russell J.). It is worth noting that registrability of a trade-mark in Canada is assessed at section 12 of the Act which provides, for example, that a trade-mark is registrable if it is not clearly descriptive or deceptively misdescriptive or, under another heading, if it is not confusing with a previously registered mark.

On June 24, 1996, Fiesta Barbeques Limited ("Fiesta") filed an application to register the design mark GRILL GEAR in association with "barbeque accessories, namely barbeque cooking utensils, barbeque rotisseries and barbeque replacement parts". This trade-mark was published for opposition purposes and was opposed by General Housewares Corporation ("General"). In its opposition, General alleged that the GRILL GEAR trade-mark was not registrable in that, when sounded, it is clearly descriptive of the wares covered in the application, the whole contrary to the provisions of subsection 12(1)(b) of the Act. The Registrar agreed with General and rejected Fiesta's application even though its trade-mark included the design of a flame in the place of the letter A; this did not change the fact, in the Registrar's view, that when the average consumer sounded out the mark, it still contravened the provisions of subsection 12(1)(b) which states, in part, that a trade-mark is registrable if it is not, whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the

English or French language of the character or quality of the wares or services in association with which it is used.

In its decision dismissing the GRILL GEAR application, the Registrar referred to Fiesta's own catalogues which used the words "GRILL" and "GEAR" in a descriptive fashion. Additionally, a double disclaimer for the words "GRILL" and "GEAR" in Fiesta's application was seen as an admission that the words as a whole were "clearly descriptive". On the issue of the design component of Fiesta's GRILL GEAR mark, the Registrar concluded that "the average consumer of the applicant's wares would not sound the applicant's mark by reference to all the elements forming the mark"; in other words, the design elements would not be referred to when the mark would be sounded. Most importantly, the Registrar considered the material date for deciding the registrability of Fiesta's trade-mark as the date of his decision (in line with what was decided back in 1992 in the aforementioned *Lubrication Engineers* case).

Fiesta appealed the Registrar's decision before the Trial Division of Canada's Federal Court: it also filed fresh evidence that was not before the Registrar, as allowed under section 56 of the Act.

After considering the fresh evidence filed before it, the Court allowed Fiesta's appeal for several reasons: On the issue of the disclaimers, the Court pointed out that the Registrar should not have placed reliance upon Fiesta's disclaimers of the words "GRILL" and "GEAR" in that section 35 of the Act (which provides for disclaimers) specifies that these do not prejudice or affect the applicant's right then existing or thereafter arising in the disclaimed matter.

The Court then considered that the issue of the "relevant date" to assess the registrability of Fiesta's mark was highly important in that all the material pointing to the descriptive nature of the GRILL GEAR trade-mark postdated the filing of Fiesta's application. Thus, it is only if the "relevant date" is considered to be the date of the Registrar's decision that such material becomes relevant.

On the other hand, as Fiesta argued, if the "relevant date" is considered the filing date, the material regarding the so-called descriptive nature of the GRILL GEAR trade-mark which did not exist as of Fiesta's filing date must then not be considered. The Court considered the issue of the "relevant date" regarding the registrability of a trade-mark as it relates to descriptiveness in opposition proceedings: In the Court's view, this issue had already been previously decided in *Association of Professional Engineers v. Registrar of Trade-Marks* (1959), 31 C.P.R. 79 (Ex. Ct.), at pages 87-88. In that case, the Court decided that the applicable date for considering a ground of opposition based on descriptiveness was the date of the application: "There is a rule which is followed in granting or denying registration of a word or a combination of two words:

Lightning Fastener Co. v. Can. Goodrich Co., (1932), 1 D.L.R. 297 at pp. 301-2, S.C.R. 189 at p. 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." Thus, the Court apparently accepted Fiesta's argument that *Park Avenue* discussed the material date regarding registrability in *obiter*, which was then referred to in *Lubrication Engineers*, but again in *obiter*.

Finally, the Registrar considered the fresh evidence filed before it by way of an affidavit of Fiesta's President who testified that none of Fiesta's competitors had ever employed the words GRILL GEAR, "whether as a trade-mark... or as a term to merely identify or describe the inherent character or quality of... wares, in Canada, prior to the filing of the subject application... or at all".

It is worth noting that Fiesta's appeal went unopposed by General before the Court. It remains to be seen however if this decision will be approved by the Federal Court of Appeal when another case involving the issue of descriptiveness of a trade-mark comes before it. The final word has therefore yet to be written regarding the determination of the date of registrability of a trade-mark, as it concerns descriptiveness, in opposition proceedings.

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