

“JAVACAFE” NOT DESCRIPTIVE, FEDERAL COURT RULES

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A recent judgment of Canada's Federal Court confirmed a decision rendered by the Registrar of Trade-marks rejecting an opposition to the application for the trade-mark JAVACAFE in association with a variety of food wares, including coffee products, based on the grounds that the trade-mark was descriptive, non-distinctive and therefore not registrable (*Shell Canada Limited v. P.T. Sari Incofood Corporation*, T-2163-03, July 27th, 2005, MacKay, J.). Under the Court's applicable standard of review, such a decision was found to be reasonable.

The facts

On January 15th, 1998, the Respondent, P.T. Sari Incofood Corporation (“Sari”) filed an application to register the trade-mark JAVACAFE, in association with a wide variety of food products, including the wares in issue raised in the opposition by the Applicant, Shell Canada Limited (“Shell”) namely, “coffee powder, cooked coffee beans, instant coffee, freeze dried coffee, granular coffee”.

On May 8th, 2000, Shell filed a Statement of Opposition to Sari’s application for the trade-mark JAVACAFE, based on the grounds that the trade-mark was not registrable due to its descriptive and non-distinctive nature in respect of the wares in issue.

The opposition was rejected by the Trade-Marks Opposition Board and on November 18th, 2003, Shell filed the present appeal under Section 56 of Canada's *Trade-marks Act*, (R.S.C. 1985, c. T-13). Both parties filed additional

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evidence, Shell in support of its appeal and Sari in support of its position that the appeal be dismissed.

The Registrar's decision

The main question put before the Opposition Board for both of Shell's grounds of opposition was whether or not the trade-mark JAVACAFE was clearly descriptive in English or in French of the character or quality of the wares in issue or of their place of origin.

It was determined that the evidence before the Board did not support a conclusion that the immediate impression of the trade-mark JAVACAFE on a Canadian francophone would be that the wares in issue, namely coffee products, come from Java. It was also held that the evidence failed to demonstrate that the ordinary Canadian Anglophone recognizes JAVA as a place known for its coffee or that the first impression on such a consumer would be one where the mark JAVACAFE would be descriptive of coffee products. Finally, it was also stated that while the word "java" is understood as "coffee" and the word "café" is similarly understood, the combination of these terms resulting in the trade-mark JAVACAFE, was not clearly descriptive of coffee products.

Issues to be determined on appeal

The appeal raised the following issues:

1. What is the appropriate standard of review applicable to Shell's appeal?
2. Did the Registrar err in finding the trade-mark JAVACAFE is not barred from registration by paragraph 12(1)(b) of the *Trade-marks Act* ?
3. Did the Registrar err in failing to find that JAVACAFE is not distinctive pursuant to paragraph 38(2)(d) and section 2 of the *Trade-marks Act* ?

Standard of review

Despite the filing of additional evidence by both parties, the Court concluded that it would not have materially affected the decision. As such, the Court applied the *reasonableness* standard of review.

Descriptiveness

In assessing the additional evidence filed by Shell, the Court decided that the definitions of "café" and "java" provided no new information. Moreover, the Court stated there was no evidence of the applicability of the evidence (filed by both parties) at the material date for assessing the registrability of a mark in terms of its descriptiveness, namely the date of the application.

Shell also attempted to convince the Examiner the descriptiveness of the trade-mark JAVACAFE should be considered as if it were, when sounded, as two words. The Court rejected this argument since there was no evidence that the mark is sounded as two separate words merely because its syllables could be separated to form two words. The Court also opined that the meanings of the two suggested separate words did not provide a particular meaning for the one coined word mark that is clearly descriptive of the character or quality of coffee products or of their place of origin.

Distinctiveness

Shell argued that the trade-mark JAVACAFE was not distinctive because it was clearly descriptive, as outlined above. The Court reiterated that distinctiveness is assessed as of the date of the filing of the statement of opposition, in this case, May 8th, 2000. The Court held the Registrar's decision to reject this ground of opposition because the evidence did not support the conclusion that JAVACAFE was clearly descriptive as of any date, was not brought into question by any of the evidence or arguments raised on appeal. As such, the Court dismissed Shell's appeal citing the reasonableness of the Registrar's decision on the two conclusions on which it was based.

Conclusion

The Court's decision reminds us that the word "clearly" has been introduced in paragraph 12(1)(b) of the *Trade-marks Act* to preserve the registrability of suggestive marks. When faced with the question of descriptiveness, the issue is not whether the trade-mark is descriptive or suggestive but whether it is "clearly" descriptive. This analysis may be particularly favourable in cases where two words are combined to make a coined word. However, when such words are part of composite marks (i.e. marks that contain both word and design elements) care should be given to CIPO's Practice Notice of February 16th, 2005, regarding descriptiveness and the "when sounded" test applicable to cases where the word element is the dominant feature of the composite mark.

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