



## FEDERAL COURT OF APPEAL CONFIRMS DESCRIPTIVE CHARACTER OF TRADE-MARK ASSOCIATED WITH GOLF SIMULATORS

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A recent decision by the Federal Court of Appeal has confirmed earlier decisions rendered by the Registrar of Trade-marks and the Federal Court rejecting an application to register the trade-mark HIGH DEFINITION GOLF in association with golf simulators because of the trade-mark's descriptive character (*Interactive Sports Technologies Inc. v. Attorney General of Canada*, 2011 FCA 261 (F.C.A.), Sharlow, Layden-Stevenson and Stratas JJ.A., September 20, 2011).

On October 18, 2005, Interactive Sports Technologies Inc. (hereafter the "applicant"), a manufacturer and vendor of golf simulators based in Concord, Ontario, filed a proposed use application for the trade-mark HIGH DEFINITION GOLF in association with golf simulators. The applicant began using its HIGH DEFINITION GOLF trade-mark in association with golf simulators around December 2005.

During the prosecution of the applicant's trade-mark application, the Examiner issued successive reports objecting to the registration of the trade-mark HIGH DEFINITION GOLF. In a first report dated April 11, 2006, the Examiner wrote that the trade-mark HIGH DEFINITION GOLF was either "clearly descriptive or deceptively misdescriptive of the character" of the applicant's golf simulators since the trade-mark clearly indicates that the applicant's wares "are high definition golf simulators".

A second report was issued by the Examiner on February 12, 2008. In a more detailed communication to the applicant, the Examiner stated that the trade-mark HIGH DEFINITION GOLF "clearly describes, in a way that is easy to understand, that the golf simulators are devices using high definition technology to play virtual golf".

Finally, a decision refusing the applicant's application was handed down on May 15, 2009. In her reasons, the Registrar wrote that the issue of descriptiveness should be considered from the point of view of the average consumer of the golf simulators, as a matter of first impression. She also considered the definition of the expression "HIGH

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DEFINITION” found in the Merriam-Webster Online Dictionary which reads “...being or relating to an often digital television system that has twice as many scan lines per frame as a conventional system, a proportionally sharper image, and a wide-screen format”. The Registrar concluded that the trade-mark HIGH DEFINITION GOLF described to ordinary Canadian consumers that the applicant’s golf simulators used high definition technology. Moreover, other traders should be able to highlight the fact that they also use similar technology. In other words, these words should not be appropriated by a single entity.

The applicant appealed the Registrar’s decision before the Federal Court and filed evidence in order to try to convince the Court to allow its appeal. For example, the applicant filed evidence of various particulars of trade-mark applications and registrations in the Canadian Trade-marks Database that belong to third parties; these documents incorporate the words “high definition” and relate to the following wares and services: optometry, laser eye surgery; eyeglasses; cosmetics; roofing shingles; fabrics and hard surfaces containing camouflage patterns; laminates, laminate flooring and furniture; hearing aids; lighting fixtures and light bulbs and stainless steel flatware.

Despite this evidence, Simpson J. was not persuaded that the expression HIGH DEFINITION has multiple meanings. In her view, it was reasonable for the Registrar to conclude that the trade-mark HIGH DEFINITION GOLF referred to a golf simulator that incorporated high definition technology in its video screen. In the Court’s view, the applicant’s own marketing material lent support to the proposition that the applicant’s simulator used high definition technology. For example, the applicant’s material stated: “Our revolutionary image processing software combines high resolution digital images and satellite data into a 3D model of a golf course to produce a totally realistic indoor golf experience...” “High Definition Golf™ - It looks like the real thing! ...HDTV compatible display delivers...”

Simpson J. therefore concluded that the Registrar’s decision was reasonable and that the applicant’s appeal should be dismissed (*Interactive Sports Technologies Inc. v. Attorney General of Canada*, 2010 FC 1296 (F.C.), Simpson J., December 16, 2010).

The applicant filed a further appeal against the Federal Court decision before the Federal Court of Appeal.

In the Federal Court of Appeal’s view, the Federal Court judge was right to reject the applicant’s contention that the immediate impression conveyed by the HIGH DEFINITION GOLF trade-mark was a precision learning tool that analyzed a user’s swing. Rather, it was reasonable for the Federal Court judge to conclude that the applicant’s mark referred to a golf simulator that incorporated high definition technology. Because of this, the clearly descriptive character or quality of the mark HIGH DEFINITION GOLF precluded its registration. The applicant’s appeal was accordingly dismissed.

This case illustrates the difficulties associated with obtaining monopolistic rights to protect descriptive trade-marks. While certainly useful from a marketing point of view, marks that describe the character of the wares associated therewith will usually not be registered since they should be available for other traders to use as well. This should be kept in mind when choosing a trade-mark. A less descriptive trade-mark is usually a stronger mark.



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