



NO TRADE-MARK INFRINGEMENT IN USE OF WORDS “WOOD CONSERVATOR” RULES FEDERAL COURT IN DECADE-LONG LITIGATION INVOLVING MAKER OF WOOD PRIMER-SEALER

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A recent decision by Canada’s Federal Court has dismissed a trade-mark infringement action commenced in 2002 by a plaintiff who had registered a design trade-mark that included the word “conservator” and who alleged that a defendant was creating confusion because of its use of the expression “WOOD CONSERVATOR” in the sale of its product (*Osmoste-Pentox Inc. v. Société Laurentide Inc.*, 2013 FC 626 (F.C.), Martineau J., June 11, 2013).

On October 21, 1994, Osmoste-Pentox Inc. (hereafter the “Plaintiff” or “Osmoste-Pentox”), a small family run Montreal-based business that has developed over the years a particular expertise in wood preservatives and various coatings, applied to register a trade-mark composed of the word “conservator”, with the last “o” of the word being replaced by the representation of a hard hat or construction helmet (hereafter the “*conservator* design-mark”). Registration of the *conservator* design-mark was granted to the Plaintiff on March 29, 1996 in association with “Surface coatings, namely coatings for the protection of wood”.

During 1996, Plaintiff started selling a primer-sealer product in association with the *conservator* design-mark. An important characteristic of the Plaintiff’s product is that it provides a transparent coating; furthermore, it does not contain any pesticide.

For its part, Société Laurentide Inc. (hereafter the “Defendant” or “Laurentide”) is the manufacturer of a range of products including paints, wood coatings, varnishes, enamels and diluents, lacquer solvents and varnishes. Among the Defendant’s product lines are wares sold under the trade-mark PERMATEC. In the marketing of its PERMATEC products, Defendant sold containers of clear and brown primer-sealers for exterior wood on which appeared, just under the name PERMATEC, the words “CONSERVATEUR POUR BOIS” (appearing in French) and “WOOD CONSERVATOR” (in English).

In 2002, the Plaintiff objected to such use by the Defendant by formal notice dated March 6, 2002. It filed a statement of claim against the Defendant on April 30, 2002

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and based its legal claim on its 1996 registration, alleging that the Defendant was creating confusion in the marketplace. In January 2003, the Federal Court issued an interlocutory injunction prohibiting the sale of the Defendant's primer-sealers bearing the words "CONSERVATOR" and/or "CONSERVATEUR" and/or "WOOD CONSERVATOR" and/or "CONSERVATEUR POUR BOIS", until a final judgment on the merit of the case.

A decade later, in 2013, during the trial on its claim for a permanent injunction, the Plaintiff's position was straightforward. It submitted that its competitors (including the Defendant) cannot use the words "CONSERVATOR" and "CONSERVATEUR" in respect to surface coatings, namely coatings for the protection of wood because of the exclusive protection granted by the registration in 1996 of the *conservator* design-mark.

The Defendant argued that it did not use the words "CONSERVATEUR" and "CONSERVATOR" as a trade-mark up to 2003 and that, in any event, the use of the words "CONSERVATOR FOR WOOD" and "CONSERVATEUR POUR BOIS" did not cause any confusion with the Plaintiff's registered trade-mark. Finally, the Defendant pointed out that it did not use the *conservator* design-mark registered in the Plaintiff's name.

Essentially, the Defendant argued that its use of the words "CONSERVATOR" and "CONSERVATEUR" on its labels was permitted by law. As noted by the Court, under Canada's *Trade-marks Act*, R.S.C. 1985, c. T-13, at subparagraph 20(1)(b)(ii), no registration of a trade-mark prevents a person from making the *bona fide* use, other than as a trade-mark, of an accurate description of the character or quality of the wares in issue. In the Defendant's view, this is what it had done. To make its point, Defendant relied on the judgement by the Federal Court in *Pepper King Ltd. v. Sunfresh Ltd.*, [2000] FCJ No 1455. In that case, Pepper King owned a registration for the trade-mark VOLCANO that it used on its pepper sauce; while Sunfresh and others used the word "volcano" on the labels of their salsas, such use was to identify the degree of spiciness of their product rather than its source. Defendant submitted that its use of the words "CONSERVATOR" and "CONSERVATEUR" was similar to the use by Sunfresh and others of the word "volcano" in the *Pepper King* case. They were used as descriptives, not as identifiers of source.

The Court agreed with the Defendant and concluded that the expressions used by the Defendant provided a mere description of the Defendant's product. Under the circumstances, the Defendant's use came within the ambit of the exception provided in subparagraph 20(1)(b)(ii) of the *Trade-marks Act*.

In any event, even if the Defendant had been using the contested words as trade-marks, the Court concluded that there was no likelihood of confusion in this case based in part on the very low degree of protection that should be attributed to the *conservator* design-mark. In fact, the Court concluded that what makes the *conservator* design-mark really distinctive is the construction helmet used to replace

the last “o” in the mark. Such distinctive element was not found in the expressions used by the Defendant to describe its products.

This case highlights the fact that registration of a very weak mark can only go so far in protecting its owner in the promotion of its goods or services. If others are using the mark to describe the characteristics of their own products, such mark might not be the ideal vehicle to identify a specific source. As we have seen here, a Court will therefore be reluctant to permanently enjoin a defendant from using descriptive words to promote its products. Such are the risks associated with choosing a trade-mark that has a descriptive component.

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