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Donald F. Sim

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Commentary

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Home Juice Co. v. Orange Maison Ltée

TRADE MARKS — ADMINISTRATIVE PRACTICE AND JUDICIAL DETERMINATION
— “DESCRIPTIVE”

The gulf between administrative and quasi-judicial practice on the one hand, and judicial determination respecting that practice on the other hand has existed as an enigma to practitioners and will undoubtedly continue to exist in future creating in effect a “two-tier” practice.

A recent decision of the Supreme Court of Canada illustrates a good case in point. In *Home Juice Co. v. Orange Maison Ltée*,¹ an appeal from a decision of Mr. Justice Noel of the Exchequer Court of Canada,² Mr. Justice Pigeon expressed the unanimous view of the Court in allowing the appeal.

¹ (1971), 16 D. L.R. (3d) 740.

² [1968] 1 Ex. C.R. 313.

An issue for determination was whether or not the words *Orange Maison*, registered in the Canadian Trade Marks Office for use in Canada in association with the sale of orange juice, were or were not validly under the provisions of the *Trade Marks Act*,³ particularly section 12(1)(b) of that Act which permits of registration of a word 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;

This definition admits of a subjective test. The “strength” or “registrability” of a trade mark is clearly inverse ratio to its descriptiveness. It is well settled law that only descriptive words and not merely suggestive words are to be denied registration. There exist many trade marks which bear an allusion or reference to desirable characteristics of the product to which they are applied. Examples are *Talon* for slide fasteners, *Halo* for shampoo and *Xerex* for anti-freeze. The problem is, of course, to predict whether any given or proposed trade mark is or will be considered to be merely suggestive or clearly descriptive.

The Registrar of Trade Marks, who is the person responsible for administration of the *Trade Marks Act* and the person in the first instance required to consider the registrability of trade marks under the Act, appears to set a low standard in assessing this question. The Registrar seemingly allows to be registered many marks which, could clearly under a more severe view of section 12(1)(b) be considered to be descriptive of the character or quality of the wares or services. The Registrar has allowed for registration for example, the following:

- Litter Green* for animal litter,
- Acne-Biotic* for acne treatment preparations,
- The Country Cheese*, for cheese,
- Grape Plus* for a fruit drink,
- Slimmers Glove* for a massage glove,
- Datekeeper* for calendars, diaries and appointment records,
- Stik Strip* for adhesive,
- A La Cat* for cat food,
- Trash Masher* for a garbage compactor, and
- Ground Pounder* for earth compactors.

What test then is applied by the Courts as to “descriptiveness”? It would appear from the *Home Juice* case, that a much different and a much more severe test is imposed.

The words *Orange Maison* were registered by the Registrar of Trade Marks, for use in Canada in association with the sale of orange juice. That registration was attacked by the appellant in the Supreme Court as being “descriptive” contrary to section 12(1)(b). Mr. Justice Pigeon found that

³ 1952-53 S.C., c. 49, now 1970 R.S.C. c. T-10.

Orange Maison was descriptive of orange juice and expunged the registration, except in the province of Quebec where it had acquired a "secondary meaning".

It was argued by the trade mark owner that *Orange Maison* was distinctive, that orange did not mean orange *juice*, and maison was, in this context, merely fanciful.

As to the meaning of "orange", Mr. Justice Pigeon found that the words "jus de" could be read in by implication, hence making *Orange* read in effect, orange juice. He said:

Here, the trade mark is composed of two French words and this is not at all a case of a covert allusion but that of an explicit description indeed. The omission of the words "jus de" (juice) in no way prevents the word "Orange" from being descriptive of the character of the wares, because those words are clearly understood through the association with a liquid product. It must also be noted that respondent took care, in his application for registration, to disclaim any right to the exclusive use of the word "orange" by itself. It must therefore be said that the distinctive character of the trade mark is claimed exclusively for the combination "Orange Maison". But, as we have seen, the word "maison" thus placed clearly becomes an adjective descriptive of quality.

With respect to "maison" the appellants asserted that it meant, in France, "home-made" or "of good quality". The Court summarized:

In this Court, as in the Exchequer Court, the appellants in support of their contention as to the meaning of "Orange Maison" relied especially on two dictionaries published in France in 1959: the Petit Larousse and the Robert. In both the definition of the word "maison" used as an adjective is given as (translation): "that which has been made at home" and also (translation): "of good quality."

The Court rejected an argument that these meanings of "maison" were found only in France and not Quebec. He held that section 12(1)(b) precluded use of words of the French language having meaning only in France, even if no such meaning existed in Quebec.

Respondent has contended that the current meaning in France is not to be considered, that regard must be had only to the meaning current in Canada and that, in the absence of any evidence, whether by dictionaries or otherwise, that the meaning in question was current in Canada at the date of registration, no account should be taken of a recent meaning found in France only. This contention would have serious consequences if it was accepted. One result would be that a shrewd trader could monopolize a new French expression by registering it as a trade mark as soon as it started being used in France or in another French-speaking country and before it could be shown to have begun being used in Canada.

In my opinion, the wording of s.12 does not authorize such a distinction. It refers to a description "in the English or French languages". Each of these two languages is international. When they are spoken of in common parlance they are considered in their entirety and not as including only the vocabulary that is extremely difficult to define especially in these days when communication media are not longer confined within national boundaries.

He found therefore that *Orange Maison* meant, even if only in rare instances in the French language as used in France, "home-made orange juice" or "orange juice of good quality", hence was unregistrable as descriptive or deceptively misdescriptive of the character or quality of the product.

Therefore, when the meaning of the trade mark is analyzed in respect of the goods to which it is affixed, the only possible conclusion is that the first word is an elliptical description of their character and the second an explicit description of their quality.

It appears from this decision that the Supreme Court is prepared to go to some lengths to hold that a trade mark is merely descriptive.

This should not be surprising for it can be seen that Canadian jurisprudence on the subject has to set a consistently high standard as to whether or not a trade mark was descriptive or distinctive. In *Fine Foods of Canada Limited v. Metcalfe Foods Limited*⁴ Maclean J. was commenting on trade marks used in association with the sale of canned vegetables. He said at page 25:

I may be permitted to say respectfully that I doubt if such marks as "Garden Patch" or "Summer Pride", or "Garden Price" should be registered at all, on the ground that they seem to suggest the place or time of production.

The Exchequer Court over the years has found "Finishing Engineer" to be descriptive of periodical publications,⁵ "Thor-o-Mix" descriptive of ready made concrete,⁶ "Sea-lect" descriptive of quality of canned fish and lobster,⁷ "Superset" descriptive of drilling tools,⁸ "True Confessions" descriptive of magazines,⁹ and "Once a Week" descriptive of floor polishes.¹⁰

The Supreme Court of Canada moreover held "frigidaire" to be descriptive of refrigerators (with two dissents).¹¹

And finally in *Silhouette Products Ltd. v. Prodon Industries Ltd.*¹² we find Noel J. holding that a silhouette of a woman's head is *prima facie* non-distinctive of hair care products, at page 138.

Moreover, I am of the opinion that a reproduction of a human head, closely related such as here to wares used for the care of the hair, is *prima facie* non-distinctive.

The judgment of Mr. Justice Pigeon therefore, appears only to be carrying on a well established tradition apparently not coinciding with the practice at the administrative or quasi-judicial level in the Trade Marks Office. It is interesting to note that all the trade marks I have cited as having been allowed for registration by the Registrar, were allowed well after the *Orange Maison* decision of the Supreme Court had been reported and presumably considered by the Trade Marks Office.

What course should be adopted in face of this dichotomy? Should one continue to advise clients based on the practice of the Trade Marks Office

⁴ [1942] Ex. C.R. 22.

⁵ *The Association of Professional Engineers of the Province of Ontario v. The Registrar of Trade Marks* (1960), 19 Fox Pat. C. 69 (Ex. Ct.).

⁶ *Thorold Concrete Products Ltd. v. The Registrar of Trade Marks* (1962), 21 Fox Pat. C. 206 (Ex. Ct.).

⁷ *C. Fairall Fisher v. B. C. Packers Limited* (1945), 5 Fox Pat. C. 50 (Ex. Ct.).

⁸ *J. K. Smit & Sons of Canada Ltd. v. The Registrar of Trade Marks* (1946), 5 Fox Pat. C. 167 (Ex. Ct.).

⁹ *Fawcett Publications Inc. v. Alexander Valentine* (1950), 10 Fox Pat. C. 203.

¹⁰ *The Drackett Co. of Canada Ltd. v. American Home Products* (1968), 38 Fox P.C. 1 (Ex. Ct.).

¹¹ *General Motors Corporation v. Bellows* (1948), 7 Fox Pat. C. 130 (Ex. Ct.); 9 Fox Pat. C. 78 (S.C.C.).

¹² (1965), 35 Fox Pat. C. 129 (Ex. Ct.).

and continue to seek registration of arguably or even obviously descriptive words; or should one take a more cautious approach and advise the adoption and registration only of trade marks which appear to meet the stricter tests imposed by the courts?

The problem is by no means a new one. Francis Bacon in his Essay "Of Judicature" in 1625 reminded "Therefore it is a happy thing in a state when kings (Registrars ?) and states do often consult with judges . . . when there is matter of law intervenant in business of state. For many times the things deducted to judgment may be meum and tuum when the reason and consequence thereof may trench to point of estate". To this many practitioners in the trade marks field would say Amen.

Donald F. Sim, Q.C.*

* Member of the Ontario Bar, Special Lecturer, Osgoode Hall Law School of York University.