

World Trademark Review Daily

Mark needs not describe good or service completely to be descriptive
Canada - Fasken Martineau DuMoulin LLP

Examination/opposition
National procedures

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In *Ontario Teachers' Pension Plan Board v The Attorney General of Canada* (2011 FC 58, January 18 2011), the applicant, the [Ontario Teachers' Pension Plan Board](#), has learnt a lesson on descriptive marks when its application for the registration of the mark TEACHERS' was refused.

The applicant administers pension plans for the teachers of Ontario. When it applied to register the trademark TEACHERS' in association with its services, the registrar of trademarks refused its application pursuant to Subsection 12(1)(b) of the [Trademarks Act](#) (RSC 1985, c T-13), finding that:

"TEACHERS', being the phonetic equivalent of TEACHERS, is an apt trade term for describing the intrinsic character of the administration, management and investment of a plan/fund for teachers and, as such, should be left available for others to use since descriptive words are the property of all and cannot be appropriated by one person for their exclusive use."

In Canada, a trademark is registrable, pursuant to Subsection 12(1) of the act, if it is not:

"(b) 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 or proposed to be used, or of the conditions of or the persons employed in their production, or of their place of origin."

As established in *General Motors Corp v Bellows* ([1949] SCR 678, 10 CPR 101), the fundamental objective of Subsection 12(1)(b) is to prevent a monopoly on the use of a word common to others providing a similar service.

The applicant appealed this decision, contending that the registrar had erred in its finding, and confused the intended consumer of the pension plan as a characteristic of the services. To support its appeal, the applicant submitted three volumes of new evidence setting out various instances where trademarks that are descriptive of the target group, but not the services offered, had been registered. The applicant further submitted that, as there was no relationship between teachers and financial planning, a registration of the subject mark would not put competitors at an undue advantage.

While the new evidence may not be determinative of the issue before it, the court found that the standard of review was to be one of *de novo*. In its review of the applicant's evidence and submissions, the court noted that the applicant regularly returned to the issue that the application covers "services", submitting that TEACHERS' describes the targeted consumers and is not descriptive of the financial services. The applicant asserted its position by arguing that, in order to be refused registration for being clearly descriptive, the mark TEACHERS' must clearly describe the "services", and not the intended end consumer.

The court found that the pension fund plan could be viewed as a good or service. In doing so, it held that the average consumer of the applicant's services - namely, Ontario teachers - when viewing the mark in context, would likely see it as describing a pension fund for teachers rather than the administrator of the pension fund services. With this finding, the court determined that, on first impression, the mark TEACHERS', when viewed in context, was clearly descriptive of a prominent characteristic of a pension fund plan exclusive to teachers.

With its finding that the trademark TEACHERS' was unregistrable, the court prohibited the applicant from holding a monopoly on the use of this term, securing its availability for others offering pension plan funds to teachers in other provinces and territories.

This decision reminds us that, in order for a trademark to be descriptive of a characteristic, it does not have to completely describe the good or service: it simply need be a distinctive or prominent feature of the good or service. The test remains, for determining descriptiveness, one of first impression.

Jennifer Powell, Fasken Martineau DuMoulin LLP, Vancouver

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