

BETWEEN:

ROWLAND & O'BRIENPETITIONER;

AND

THE REGISTRAR OF TRADE MARKS } RESPONDENT.

1951
Mar. 16
Apr. 12

Trade Mark—The Unfair Competition Act, 1932, 22-23 Geo. V. c. 38 ss. 2(m), 26(1) (c) (d), 29(1)—Word “Taystee” a corruption or misspelling of word “Taysty”—Word “Tasty” not only descriptive but laudatory when used in reference to foods—Corruption or misspelling of a word cannot change its character—Purely laudatory words or any corruption or misspelling thereof cannot be subject to registrability as a word mark under s. 29 of the Unfair Competition Act—Application for a declaration under s. 29(1) of the Act dismissed.

Petitioner is a partnership carrying on a bakery business in Windsor, Ontario, and distributing its products—bread, doughnuts, cakes, rolls etc.—throughout that city and other municipalities in the County of Essex. On March 28, 1950, suppliant applied to the Registrar of Trade Marks for registration of the single word “Taystee” for use on bakery products manufactured from wheat flour. That application was refused by the Registrar under s. 26(1) (c) (d), and also under s. 2(m) of The Unfair Competition Act, 1932. Thus the present application under s. 29 of the Act.

1951
 ROWLAND
 AND O'BRIEN
 v.
 THE
 REGISTRAR OF
 TRADE
 MARKS
 CAMERON J.

Held: That the corruption or misspelling of a word cannot change its character. *C. Fairall Fisher v. British Columbia Packers Ltd.* (1945) Ex. C.R. 128 followed.

2. That the word "Taystee" is a corruption or misspelling of the descriptive word "Tasty".
3. That the word "Tasty" is not only a descriptive word, but also, when used in reference to foods, it indicates something that is particularly palatable or pleasing to the taste, falling, therefore, within the category of laudatory words.
4. That the purely laudatory word "Tasty", or any corruption or misspelling thereof such as "Taystee" cannot be made the subject of a declaration of registrability as a word mark under section 29, no matter what the extent of its use may be and regardless of the extent to which the evidence may indicate that it has lost its primary meaning and acquired a secondary meaning.
5. That the application for a declaration under s. 29 of the Unfair Competition Act, 1932, must be dismissed as the evidence falls far short of establishing the "general recognition" required by the section.

APPLICATION for a declaration under s. 29 of the Unfair Competition Act.

The application was heard before the Honourable Mr. Justice Cameron at Windsor, Ontario.

W. P. Harvie for suppliant.

No one appeared for respondent.

The facts and questions of law raised are stated in the reasons for judgment.

CAMERON J. now (April 12, 1951) delivered the following judgment:

This is an application under section 29 of The Unfair Competition Act, 1932, for a declaration "that it has been proved to the satisfaction of this Court that the word mark 'Taystee' has been so used by the petitioner, Rowland & O'Brien, as to have become generally recognized by dealers in and/or users of bakery products manufactured from wheat flour as indicating that the said petitioners assume responsibility for the character or quality of the products of wheat flour produced and manufactured by them and for their place of origin." At the hearing of the motion, counsel for the petitioner asked that if such

declaration were made, registration should be limited to the geographical area within the limits of the County of Essex, Province of Ontario.

It was established that notice of filing of the petition for registration had been given in the *Canada Gazette*, that pursuant thereto no statement of objections had been filed or served and that due service had been made upon the Minister under Rule 36. The Registrar of Trade Marks, although duly served with notice of the hearing, was not represented thereat.

The petitioner is a partnership carrying on a bakery business in Windsor, Ontario, and distributing its products—bread, doughnuts, cakes, rolls, etc.—throughout that city and other municipalities in the County of Essex. On the 17th of June, 1940, it registered in Canada the word mark "Rowland & O'Brien's Taystee." A copy of that registration was not available at the hearing but I assume that it was applied to bakery products. On March 28, 1950, the applicant applied to the Registrar of Trade Marks for registration of the single word "Taystee" for use on bakery products manufactured from wheat flour. That application was refused by the Registrar under section 26(1) (c) (d), and also under section 2(m) of the Act. Thereupon the present application was launched.

Mr. Rowland, one of the partners of Rowland & O'Brien, stated that his firm was anxious to secure a word mark that would be attractive and distinctive in the bakery trade, one that would be short and easy to remember; that he or someone in the firm had seen the word "Taystee" in use in the United States, and as it appeared to meet these requirements they had adopted it for use on their products some time prior to June, 1940, when they registered the words "Rowland & O'Brien's Taystee." For two or three years thereafter they did not use the word "Taystee" by itself, but as "Rowland & O'Brien's Taystee." They found it was somewhat cumbersome in that form, and about 1942 or 1943 began the use of the single word "Taystee," using it in various forms on the packaging of their bread, rolls, cakes, etc., as shown in Exhibits E, F, H, I, J, K and L; and also on show cards such as Exhibit D and on their delivery trucks and wagons. On all of the packages and

1951
 ROWLAND
 AND O'BRIEN
 v.
 THE
 REGISTRAR OF
 TRADE
 MARKS
 Cameron J.

1951
 ROWLAND
 AND O'BRIEN
 v.
 THE
 REGISTRAR OF
 TRADE
 MARKS
 Cameron J.

cards the firm name of "Rowland & O'Brien" was also prominently featured. The bakery is a large one, its products being sold at the bakery itself, by delivery trucks and wagons and to retail stores. No other bakery business in the area uses the word or any similar word in connection with its products. Mr. Rowland stresses the point that in originally choosing the word "Taystee" he did not have in mind the idea that it had the usual connotation of the common word "Tasty."

A number of witnesses gave oral evidence on behalf of the petitioner. All were familiar over varying periods with the petitioner's extensive use of the word "Taystee" on its labels and packages. Mr. George Topp for nine years has been the Windsor Manager of Canada Bread Company, a competitor of the petitioner. He stated that throughout the industry "Taystee" was recognized as the word mark of Rowland & O'Brien and was not descriptive of their products as a whole; that to him the word was distinctive of their products. Mr. C. Niskasari is a baker employed by a retail confectioner and bakery in Windsor and which for many years has sold bread manufactured by the petitioner under the name "Taystee." To him "Taystee" meant the product of Rowland & O'Brien and he did not think of it as having the meaning of "Tasty." Mr. R. Vermette operates a confectionery shop in Tecumseh and has purchased and sold the petitioner's products in packages marked "Taystee" for about six months. When customers ask for a loaf of "Taystee" bread he supplies them with the petitioner's products, that being the only bread sold by him under that name. Mr. George Bain, a merchant has used the petitioner's products for about fifteen years, occasionally purchasing them himself; he states that he never asks for them under the name "Taystee." Mr. E. Beaudoin operates a garage and refreshment stand in the County of Essex and uses the petitioner's products in "Taystee" packages in his sandwiches, hamburgers, and the like. On occasions he would sell a few loaves of bread, a cake or doughnuts. I found his evidence somewhat confused for on one occasion he said that customers would ask for "a loaf of 'Taystee' bread"; and later he stated that they would never ask for it as "Taystee" bread but as

“Rowland & O’Brien’s.” Mr. R. MacCallum for many years had carried on a retail grocery business in Windsor but is now retired. He sold the petitioner’s products bearing the mark “Taystee” and stated that when customers asked for a loaf of “Taystee” bread or a “Taystee” cake, he understood them to mean the petitioner’s products.

1951
 ROWLAND
 AND O'BRIEN
 v.
 THE
 REGISTRAR OF
 TRADE
 MARKS

Now, quite obviously “Taystee” is a corruption or misspelling of the common English word “Tasty”—a descriptive word in everyday use. It is defined in the Shorter Oxford English Dictionary as:

Cameron J.

1. Pleasing to the taste; appetizing, savoury.
2. Tasteful, elegant. (Now rare).

In my opinion, “Tasty” is not only a descriptive word, but also, when used in reference to foods, it indicates something that is particularly palatable or pleasing to the taste. It falls, therefore, within the category of laudatory words and it is well settled that such a word in Canada cannot be brought within the requirements of section 29(1) of The Unfair Competition Act, which is as follows:

29. (1) Notwithstanding that a trade mark is not registrable under any other provision of this Act it may be registered if, in any action or proceeding in the Exchequer Court of Canada, the court by its judgment declares that it has been proved to its satisfaction that the mark has been so used by any person as to have become generally recognized by dealers in and/or users of the class of wares in association with which it has been used, as indicating that such person assumes responsibility for their character or quality, for the conditions under which or the class of person by whom they have been produced or for their place of origin.

And what I have said in reference to the word “Tasty” applies also to the word “Taystee,” for the corruption or misspelling of a word cannot change its character. In this connection, reference may be made to the case of *C. Fairall Fisher v. British Columbia Packers Ltd.* (1). In that case the President of this Court held that the word mark “Sea-lect” used in connection with the sale of canned fish was merely a corruption or misspelling of the laudatory epithet “Select” and as such was incapable of distinctiveness and should not have been registered as a trade mark. He held, also, that a laudatory epithet such as “Select,” including any corruption or misspelling of it such as “Sea-lect,” should not be made the subject of a declaration of registrability as a word mark under section 29, no matter

1951
 ROWLAND
 AND O'BRIEN
 v.
 THE
 REGISTRAR OF
 TRADE
 MARKS

 Cameron J.

what the extent of its use may be. Further, he held that the corruption or misspelling of a descriptive word cannot change its character (*Kirstein Sons & Co. v. Cohen Brothers* (1); and *The "Orlwoola" Trade Mark Application* (2) followed).

In the "Sea-lect" case, the President said at p. 140:

In my judgment, however, this case falls outside section 29 altogether. If a word were merely descriptive of quality and nothing more, or a corruption or misspelling of such a word, the Court would have to decide whether it should, having regard to the evidence of user placed before it, exercise the discretion vested in it. The section provides for the registration of a trade mark and it is implied that the mark has acquired, although it may have lacked it originally, the quality of distinctiveness and has become "adapted to distinguish." The *Perfection* case, (1909) 26 R.P.C. 837, decided that laudatory epithets are incapable of distinctiveness and cannot be adapted to distinguish no matter how much evidence of user has been adduced. Farwell, L.J. put the matter in a striking way when he said, at page 862:

"My own opinion is that no amount of user could possibly withdraw the word "Perfection" from its primary and ordinary meaning and make it mean 'Crossfield's' instead of 'Perfect'"

The authority of that case should be followed and it should be held that a laudatory epithet such as "Select" including any corruption or misspelling of it such as "Sea-lect," should not be made the subject of a declaration of registrability as a word mark under section 29, no matter what the extent of its user may be. Such an epithet is incapable of being or becoming a word mark. The petitioner's application under section 29 must, therefore, be dismissed.

In the case of *Registrar of Trade Marks v. G. A. Hardie & Co. Ltd.* (3), it was held:

That the compound word "Super-weave" is a laudatory epithet of such common and ordinary usage that it can never become adapted to distinguish within the meaning of s. 2(m) of The Unfair Competition Act, 1932. It being impossible to bring the word within the meaning of "trade mark" as defined by s. 2(m), an application under s. 29 cannot succeed.

In that case, Kerwin, J. said at p. 488:

The result is that the compound word "Super-weave" clearly indicates and describes textiles that have a superior or superfine weave, an attribute that is unquestionably much desired by purchasers and users of such wares and, therefore, an attribute which a trader in textiles would naturally wish to emphasize in offering his wares for sale. Such a word may not be commandeered by one manufacturer and registered under The Unfair Competition Act so as to prevent others from claiming the same quality in their merchandise and using the same or a similar expression to describe it . . .

It was not contended that if the Court came to the conclusion that 'Super-weave' was an ordinary laudatory expression the application should

(1) (1907) 39 S.C.R. 286.

(2) (1909) 26 R.P.C. 850.

(3) (1949) S.C.R. 483.

succeed, but, in view of the argument addressed to us, it is advisable to state what appears to be the proper construction of section 29 of the Act. The opening words of subsection 1 'notwithstanding that a trade mark is not registrable under any other provision of this Act' require one to examine the definition of trade mark in section 2(m). That definition states that 'trade mark' means a symbol 'which has become adapted to distinguish.' While this wording differs from section 9 of the English Act in question in the Perfection Case, since in section 9 'distinctive' is stated to mean 'adapted to distinguish,' no distinction should be drawn between the uses of the different tenses. Turning again to section 29, while the Court is empowered to grant the declaration mentioned, notwithstanding that a trade mark is not registrable under any other provision of the Act, the original idea underlying such legislation, as it has been developed in England, should be followed here, with the result that, if a word is held to be purely laudatory, no amount of use or recognition by dealers or users of words as indicating that a certain person assumes responsibility for the character or quality of the merchandise would be sufficient to take such an expression out of the common domain and enable the user thereof to become registered as the owner of a trade mark under The Unfair Competition Act.

1951
 ROWLAND
 AND O'BRIEN
 v.
 THE
 REGISTRAR OF
 TRADE
 MARKS
 Cameron J.
 ———

And at p. 509, Estey J. said:

The compound word "super-weave" contains the well-known, commonly used laudatory epithet "super" and the equally well-known word "weave" commonly used to describe the texture or method of manufacture. It is a well-founded principle recognized in both the authorities and statute law that such words (subject to a descriptive word becoming "generally recognized" as in s. 29) should remain the common property of dealers and users and the public generally and no person or corporation should be granted the exclusive right to or a monopoly in the use of such words such as registration of a trade mark bestows upon the applicant.

When these words are joined to form the compound word "super-weave" it means, as stated by the learned trial Judge, "a better quality of weaving," and, with respect, I think would be so understood and commonly used by dealers and users, and as such properly classified as a laudatory epithet.

Applying the principles above laid down to the facts in this case, I have reached the conclusion that the purely laudatory word "Tasty," or any corruption or misspelling thereof such as "Taystee," should not be made the subject of a declaration of registrability as a word mark under section 29, no matter what the extent of its use may be and regardless of the extent to which the evidence may indicate that it has lost its primary meaning and acquired a secondary meaning. "Tasty" when applied to foods is an attribute much desired by users of food and therefore an attribute which any dealer in bakery products would wish to use in offering his goods for sale. Such a word should remain available for the use of all desiring to use it in describing their products and no one should be given

the exclusive right to its use, as would be the case if the declaration of registrability here sought were granted. For these reasons the application must be dismissed, but without costs.

In disposing of the matter on the ground that the word mark applied for is a mere misspelling of a laudatory word, it has not been necessary to consider the evidence adduced in support of the application. Even had I been of the opinion that the word was not laudatory but merely descriptive, I would not have found the evidence sufficient to meet the strict requirements of section 29. Exclusive of Mr. Rowland, six witnesses gave evidence for the petitioner. Four of these were dealers in bakery products who purchased them from the petitioner, and to them and to Mr. Topp (the manager of a competing firm) the word would necessarily be associated with the origin of the goods. The evidence of the remaining witness, Mr. Bain, was not in any way helpful to the petitioner. Inasmuch as there were a great many grocers selling the petitioner's products and many thousands who used them, the evidence falls far short of establishing the "general recognition" required by section 29. In this connection reference may be made to the judgment of Rand, J. in the *Hardie* case (*supra*) at p. 493.

Judgment accordingly.