

BETWEEN:

STANDARD STOKER COMPANY, INC. PETITIONER,

AND

THE REGISTRAR OF TRADE MARKS, RESPONDENT.

1947

May 22

Aug. 2

*Trade Mark—The Unfair Competition Act, 22-23 Geo. V, c. 38, s. 29—
“Standard”—Mark consisting of word used in laudatory nature and
not meaning the articles made by petitioner is not registrable—Where
part of mark abandoned registration of remaining portion refused.*

Held: That the word “Standard” used in connection with goods is of a
laudatory nature and cannot mean the articles made by the petitioner.

2. That since petitioner had used the words “Standard Stoker” on his goods to bring them to the attention of the public he cannot now abandon one part of his chosen mark and obtain a declaration under s. 29 of The Unfair Competition Act in respect to only one portion of it.

APPLICATION for registration of a trade mark.

The action was tried before the Honourable Mr. Justice Cameron at Ottawa.

E. G. Gowling, K.C. and *J. C. Osborne* for petitioner.

W. P. J. O’Meara, K.C. for respondent.

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

CAMERON J. now (August 2, 1947) delivered the following judgment:

This is an application under section 29 of the Unfair Competition Act, chapter 38, 22-23 George V, for a declaration that it has been proved to the satisfaction of the Court that the word “Standard” has been so used by the petitioner, the Standard Stoker Company Inc., as to have become generally recognized by dealers in and users of the class of wares in association with which it has been used (locomotive stokers), as indicating that the petitioner assumes responsibility for their character and quality, and that the petitioner is entitled to the registration of the word “Standard” as its trade mark. The petitioner had previously filed an application for registration of the word

1947
 {
 STANDARD
 STOKER
 COMPANY
 v.
 REGISTRAR
 OF
 TRADE
 MARKS
 ———
 Cameron J.

“Standard” as a trade mark, but the application was refused by the Registrar of Trade Marks under subsections 26(c) and 2 (m). No appeal was taken from that decision of the Registrar. For the purpose of this petition, it is admitted that the word “Standard” is not registrable under section 26. Counsel for the Registrar opposes this application.

The facts are not in dispute and may be summarized briefly as follows:

The petitioner is a corporation organized under the laws of the State of Delaware, having its head office in New York City, and since 1913 has manufactured mechanical stokers, fuel pushes, conveyors and similar apparatus. It has carried on business in the United States of America, Canada, South Africa, France, Russia, India, Australia, China, Brazil and Chile.

From January 1, 1930, to September 30, 1946, the petitioner sold 917 locomotive stokers in Canada, the sales being made to railways and locomotive companies, all for use in Canada; and in each case the stoker had applied thereto a stamping or nameplate, (Ex. A) bearing in the centre the words, “Standard Stokers”, around which was an oval, outside of which are the words, “The Standard Stoker Company, Inc., New York, U.S.A.”

The petitioner adopted the word “Standard” for the purpose of distinguishing locomotive stokers sold by it in 1913 in the United States of America, and, about 1920, in Canada. The word “Standard” has been continuously used in the manner above described since January 20, 1929, in the United States and since June 10, 1930, in Canada. In its catalogue the petitioner has used the words “Standard Stoker” to identify its locomotive stokers and such catalogue was sent to the Canadian Pacific Railway Company, Canadian National Railway and other railways in Canada.

In addition to affidavits of the officers of the petitioner, the application is supported by affidavits of Canadian officials of two railways and of two locomotive companies, all of which have for many years purchased stokers from the petitioner. In general, each of these affidavits indicates that the stokers manufactured and sold by the petitioner

are expensive articles, the average price being about \$3,000; that they are not bought or used by the ordinary public, but are purchased and used only by railways and large engineering works.

1947
STANDARD
STOKER
COMPANY
v.
REGISTRAR
OF
TRADE
MARKS
Cameron J.

In each case the affiant states:

4. That I am personally aware that the Standard Stoker Company, Inc., uses the word "Standard" to distinguish locomotive stokers and parts thereof, which are manufactured and sold by it, from other wares falling within the same category, and uses the word "Standard" for the purpose of indicating to dealers in and/or users of such wares that they have been manufactured and sold by it.

5. That the use of the word "Standard", as used by the Standard Stoker Company, Inc., has for many years indicated to me that locomotive stokers and parts thereof, bearing the said word, have been made and sold by the Standard Stoker Company, Inc.

6. That I have been associated with..... (name of employer).....and that the word "Standard", as used by the Standard Stoker Company, Inc, has since the year..... indicated to me that the Standard Stoker Company, Inc. assumes responsibility for the character and quality of locomotive stokers, and parts thereof, bearing the said word.

E. A. Turner, President of the petitioner, in his affidavit, states:

I am aware that the word "Standard" is recognized by dealers in and users of locomotive stokers throughout the Dominion of Canada as a symbol identifying products sold by the Standard Stoker Company, Inc.

The word "Standard" appears on locomotive stokers sold by the Standard Stoker Company, Inc., and I verily believe has by long usage become adapted to distinguish such locomotive stokers as wares sold by the said Standard Stoker Company, Inc.

As stated, the application is made under 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.

The petitioner alleges that although the word "Standard" may be an ordinary word descriptive of the product, it has nevertheless acquired a secondary meaning and, through long usage by it, has been recognized by dealers in and users of locomotive stokers as indicating that the petitioner assumes responsibility for its character and quality; that

1947
 STANDARD
 STOKER
 COMPANY
 v.
 REGISTRAR
 OF
 TRADE
 MARKS

“Standard” is a symbol which has become adapted to distinguish the wares of the petitioner from other wares falling within the same category.

The petitioner, pursuant to Rule 35, gave due notice of this application in the Canada Gazette, but no objections were filed with the Registrar of the Court.

Cameron J. Counsel for the Registrar opposes the application on two main grounds:

(1) that the word “Standard” cannot be an apt or appropriate instrument for distinguishing the goods of one trader from those of another, and

(2) that the applicant has never used the word “Standard” by itself in Canada and that, therefore, the requirements of section 29 (1), of the Unfair Competition Act, have not been complied with.

“Standard” is a descriptive word and therefore would come within the implied prohibition in section 26 (1) (c). But some words which are originally descriptive and therefore unregistrable under section 26 may acquire a secondary meaning that is distinctive through their use in association with wares. But in order to obtain the benefit of the special provisions of section 29, its requirements must be met; and to be registrable under that section the proposed mark must be a trade mark as defined by section 2 (m), that is, it must be distinctive. *Lime Cola Co. v. Coca Cola Co.* (1). Section 2 (m) is as follows:

“Trade mark” means a symbol which has become adapted to distinguish particular wares falling within a general category from other wares falling within the same category, and is used by any person in association with wares entering into trade or commerce for the purpose of indicating to dealers in, and/or users of such wares that they have been manufactured, sold, leased or hired by him, or that they are of a defined standard or have been produced under defined working conditions, by a defined class of persons, or in a defined territorial area, and includes any distinguishing guise capable of constituting a trade mark.

The problem to be answered here is whether the proposed mark “Standard” is capable of being distinctive.

The affidavits used by the petitioner in support of his application would indicate quite clearly that to the users of locomotive stokers in Canada the word “Standard” as used in Canada by the petitioner has come to mean the

stokers of the petitioner. That evidence is uncontradicted. But by judicial decisions certain common English words have been held to be incapable of distinctiveness and, therefore, not registrable as trade marks. In this category are purely laudatory words. In the case of *C. Fairall Fisher v. British Columbia Packers Ltd.* (1), the President of this Court held that a laudatory epithet such as "Select" (including any corruptions or misspelling of it such as "Sea-lect") should not be made the subject of registrability as a trade mark under section 29 *no matter what the extent of its user may have been.*

1947
 STANDARD
 STOKER
 COMPANY
 v.
 REGISTRAR
 OF
 TRADE
 MARKS
 Cameron J.

At page 133 he said:

There are some words which, because of their nature, are common property and cannot be made the subject of monopoly. They are incapable of distinctiveness. Laudatory epithets are of such a nature. They are, it is true, descriptive of quality. But, while merely descriptive words may acquire distinctiveness by user of them in association with the goods of a particular person in such a way that they have become adapted to distinguish his goods from those of another person, no amount of user or laudatory epithets can give them the quality of distinctiveness that is essential to a trade mark. If a mark cannot be distinctive it cannot become adapted to distinguish and no amount of user of it can make it a trade mark.

In that case, the President of this Court adopted the principles laid down in *Joseph Crosfield's and Sons Ltd's Application* (2) commonly referred to as the *Perfection Case*. There an application was made to register the word "Perfection" as a trade mark for common soap. The applicant had used it for thirty years. Prior to the Trade Marks Act, 1905, the word was not registrable, but under section 9 (5) of that Act, a wide discretion was given to the Board of Trade and the Court to allow the registration of words not previously registrable. The Court of Appeal held that the word "Perfection" was not a distinctive mark, notwithstanding its long user by the applicants, was not adapted to distinguish their goods from those of other persons and could not, therefore, be registered as a trade mark. Cozens-Hardy M. R. said, at p. 854:

It is apparent that no word can be registered under this paragraph unless it is "distinctive"—that is to say, is "adapted to distinguish" the goods of the proprietor from the goods of other persons. There are some words which are incapable of being so "adapted" such as "good", "best", and "superfine". *They cannot have a secondary meaning as indicating only the goods of the applicant.* There are other words which

(1) (1945) Ex. C.R. 128.

(2) (1909) 26 R.P.C. 837.

1947
 STANDARD
 STOKER
 COMPANY
 v.
 REGISTRAR
 OF
 TRADE
 MARKS
 Cameron J.

are capable of being so "adapted", and as to such words the tribunal may be guided by evidence as to the extent to which use has rendered the word distinctive. It is easy to apply this paragraph to geographical words, and it is possible to suggest words having direct reference to character or quality which might be brought within it. But an ordinary laudatory epithet ought to be open to all the world, and is not, in my opinion, capable of being registered.

At page 858, Fletcher Moulton L.J. said:

The extent to which the Court will require the proof of this acquired distinctiveness to go will depend on the nature of the case. If the objections to the word itself are not very strong it will act on less proof of acquired distinctiveness than it would require in the case of a word which in itself was open to grave objection. I do not think, for instance, that any amount of evidence of user would induce a Court to permit the registration of ordinary laudatory epithets, such as "best", "perfect", etc. On the other hand, in the case of a peculiar collocation of words it might be satisfied with reasonable proof of acquired distinctiveness even though the words taken separately might be descriptive words in common use.

And at page 862, Farwell L.J. stated:

I cannot myself see how words which are simply a direct statement of quality, for example "good" or "best" can ever lose their primary meaning and come to mean not good or best but the articles made by A.B.

In my view, the word "Standard" falls within the category of laudatory epithets. There are a large number of definitions of the word "Standard", some of which are as follows:

Murrays New English Dictionary, Vol. IX:

"An authoritative or recognized exemplar of correctness or some definite degree of any quality."

"A definite level of excellence, attainment—wealth or the like, or a definite degree of any quality viewed as a prescribed object of endeavour or as the measure of what is adequate for some purpose."

Words and Phrases (American), Permanent Edition, Vol. 39, page 855:

"'Standard' is a type or model of a combination of elements accepted as correct or perfect."

Websters:

"That which is set up and established by authority as a rule for the measure of quantity, weight, extent, value or quality."

The Concise Oxford Dictionary:

“Weight or measure to which others conform, or by which the accuracy of others is judged.”

Its meaning was considered judicially in the case of *Standard Ideal Company v. Standard Sanitary Manufacturing Company* (1) where MacNaghten J., giving the judgment of the Judicial Committee of the Privy Council, said, at page 795:

The word “Standard” is a common English word. It seems to be used not unfrequently by manufacturers and merchants in connection with the goods they put upon the market. So used it has no very precise or definite meaning; but obviously it is intended to convey the notion that the goods in connection with which it is used are of high class, or superior quality, or acknowledged merit.

These definitions all indicate that when the word “Standard” is used in connection with goods, it conveys the meaning that the goods are of a high or approved degree of excellence or perfection—that they are of good quality—and the word, in my view, is therefore of a laudatory nature. It is a direct statement of quality and could never, to adapt the words of Farrell, L.J., cited above, lose its primary meaning and come to mean, not “Standard”, but the articles made by the petitioner.

Counsel for the petitioner referred to *Canadian Shredded Wheat Company, Limited v. Kellogg Company of Canada* (2) and suggested that the judgment of Lord Russell of Killowen recognized that words like “Standard” could acquire a secondary meaning. I do not so interpret that judgment. At page 142, after referring to certain sections of the Trade Marks and Designs Act, he stated:

The effect of this provision is that a word is not registrable under the Act as a trade mark which is merely descriptive of the character and quality of the goods in connection with which it is used (*Standard Ideal Co. v. Standard Sanitary Manufacturing Co.*, L.R. (1911) A.C. 78 and *Channell v. Rombough*, (1924) Canadian Supreme Court Reports, 600). It is, however, clear that such a descriptive word may possibly have acquired a secondary meaning, and have come to mean or indicate that the goods in connection with which it is used are the goods of a particular manufacturer; in other words that the word in question has in its secondary meaning become indicative of origin. (*Crosfield's Application*, L.R. (1910) 1 Ch. 130, 26 R.P.C. 837). But the onus on the person who attempts to establish this secondary meaning is a heavy one.

I think it is clear that when he used the words “such a descriptive mark”, he was not referring to the word

(1) (1910) R.P.C. 789.

(2) (1938) 55 R.P.C. 125.

1947
 STANDARD
 STOKER
 COMPANY
 v.
 REGISTRAR
 OF
 TRADE
 MARKS
 Cameron J.

“Standard” but generally to a trade mark which is merely descriptive of the character and quality of the goods in connection with which it is used.

It is interesting to observe that at the end of the same paragraph he added these words:

Where the words are purely descriptive and in common use it is even more difficult to conceive a case in which they could acquire a secondary meaning.

I have already referred to the case of *Standard Ideal Company v. Standard Sanitary Manufacturing Company Limited (supra)* and, while that was an action for infringement and passing off under the Trade Marks and Designs Act (1879), consideration was given to the question as to whether the word “Standard” was appropriate to distinguish the goods of one person from another.

I do not propose to set out all the facts in that case. The plaintiff had registered its trade mark “Standard” and claimed an injunction restraining the defendant company from using the word “Standard” in connection with their goods, which were of the same nature. The plaintiff there was an American company and “Standard” formed part of its name. The same conditions apply to the petitioner in the instant case. There, as here, the trade mark in question was the one word, “Standard”. In that case, after referring to the meaning of the word “Standard”, Lord MacNaghten stated at page 795:

Without attempting to define “the essentials necessary to constitute a Trade Mark ‘properly speaking’” it seems to their Lordships perfectly clear that a common English word having reference to the character and quality of the goods in connection with which it is used, and having no reference to anything else, cannot be an apt, or appropriate instrument for distinguishing the goods of one trader from those of another. Distinctiveness is the very essence of a Trade Mark. The Plaintiff Company was therefore not entitled to register the word “Standard” as a Trade Mark. The result is, in accordance with the decision of the Supreme Court in *Partlo v. Todd* (17 S.C.C. 196), that the word, though registered, is not a valid Trade Mark. The action, so far as it is based on alleged infringement of Trade Mark, must fail.

Counsel for the petitioner laid great emphasis upon the words, “and having no reference to anything else”, as suggesting that if there were any reference to anything else, the judgment could have been otherwise. I cannot find “any other reference” in the word “Standard” as now applied for than existed in the above case.

Petitioner's counsel, while recognizing the difficulty of overcoming the judgment in the case of *Standard Ideal Company v. Standard Sanitary Manufacturing Company* (*supra*), referred me to the concluding paragraph of that judgment, part of which is as follows:

There remains the charge of passing off. On that question also their Lordships are compelled to differ from the Court of King's Bench. The evidence falls far short of establishing the proposition that the word "Standard" has acquired a secondary signification, and so means, as applied to articles of toilet use, goods manufactured by the Plaintiff Company.

It is argued that from this part of the judgment it should be inferred that the word "Standard" could acquire a secondary meaning. It is to be remembered, however, that in that case the first part of the judgment has to do with infringement of the trade mark. The portion of the paragraph now last quoted has to do solely with the second part of the claim,—passing off. In view of the very definite finding that the word "Standard" cannot be an apt or appropriate instrument for distinguishing the goods of one trader from those of another, it should not, I think, be inferred that because the plaintiff in that case had failed to establish the proposition that the word had acquired a secondary signification, that such secondary meaning could have been established by additional evidence.

I feel also that effect must be given to the second objection raised by a counsel for the Secretary of State; namely that the proposed mark "Standard" has not been used as such in Canada. The petitioner has used the words "Standard Stokers" on a stamping or name plate, around the edge of which appears the name and address of the manufacturer. There is no evidence whatever that the single word "Standard" has at any time been used in Canada in association with the wares of the petitioner and it can scarcely be found under section 29 that proof has been given that the mark "Standard" has been so used by the petitioner as to have become generally recognized by dealers in and/or users of stokers as indicating that the petitioner assumes responsibility for their character or quality, or their place of origin.

1947
 STANDARD
 STOKER
 COMPANY
 v.
 REGISTRAR
 OF
 TRADE
 MARKS
 Cameron J.

1947
STANDARD
STOKER
COMPANY
v.
REGISTRAR
OF
TRADE
MARKS
—
Cameron J.
—

I was not referred to any case in which a declaration had been made under section 29, authorizing the registration of a word mark which is only one part of words which had long been used together by the petitioner. It is the words "Standard Stoker" that the petitioner has used on his goods to bring the attention of the public to his wares, and not the one word "Standard". I am quite unable to see how the petitioner can now abandon one part of his chosen mark and ask for a declaration under section 29 in respect of only one portion of it. The application must be dismissed on that ground also.

For the reasons stated the application is therefore dismissed. There will be no order as to costs.

Judgment accordingly.