

BETWEEN:

DOWER BROTHERS LIMITED.....APPELLANT;

AND

THE REGISTRAR OF TRADE }
 MARKS } RESPONDENT.

1939
 Dec. 11.
 —
 1940
 Mar. 14.
 —

Trade Mark—Appeal from decision of Registrar of Trade Marks dismissed—Words “French Room” “descriptive or misdescriptive of the character or quality of the wares in association with which they are used, or of their place of origin”—Unfair Competition Act, 22-23 Geo. V, c. 38, s. 26 (1) (c).

Appellant's application for registration of the words “French Room” as a word mark in association with wares ordinarily and commercially described as women's and misses' shoes, was refused by the Registrar of Trade Marks, from whose decision an appeal was taken to this Court. Evidence was adduced to show that the proposed word mark was a term extensively used in other stores to indicate a department devoted to the merchandizing of footwear and wearing apparel

Held: That the words “French Room” were “descriptive or misdescriptive of the character or quality of the wares in association with which they are used, or of their place of origin,” and therefore not registrable under the provisions of the Unfair Competition Act, 22-23 Geo. V, c. 38, s. 26 (1) (c).

APPEAL from the refusal of the Registrar of Trade Marks to register the words “French Room” as a word mark.

The appeal was heard before the Honourable Mr. Justice Maclean, President of the Court, at Ottawa.

R. S. Smart, K.C. for appellant.

W. L. Scott, K.C. for respondent.

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

1939
 DOWER BROS. LTD. v. REGISTRAR OF TRADE MARKS. Maclean J.
 THE PRESIDENT, now (March 14, 1940) delivered the following judgment:

This is an appeal asserted on behalf of Dower Bros. Ltd., of Edmonton, Alberta, from the refusal of the Registrar of Trade Marks to register the word mark "French Room," in association with wares ordinarily and commercially described as women's and misses' shoes. In the application for registration it is stated that "in addition to the wares of the kind described, the appellant is commercially concerned with wares ordinarily and commercially described as other types of footwear and ready-to-wear garments." I do not construe the words just quoted from the application to be intended to mean that the applicant uses, or proposes to use, the word mark "French Room" in association with "other types of footwear and ready-to-wear garments." I assume that the appellant is engaged in the sale of footwear other than women's and misses' shoes, and also ready-to-wear garments whatever that comprehends, and that it proposes to distinguish its women's and misses' shoes by the word mark "French Room" from other footwear with which it is commercially concerned.

The Registrar refused to register the word mark "French Room" on the ground that the same was "a term extensively used in stores throughout the country to indicate a certain department devoted to the merchandizing of so-called exclusively styled footwear and wearing apparel of various kinds, either imported from France or sold at higher prices than goods obtainable in regular departments by reason of their superior craftsmanship, tailoring or quality," and that the words "French Room" were "descriptive or misdescriptive of the character or quality of the wares in association with which they are used, or of their place of origin," and therefore not registrable under the provisions of s. 26 (1) (c) of The Unfair Competition Act.

In support of the action taken by the Registrar there were introduced by Mr. Scott eight affidavits and to them I must refer. Mr. Young of the City of Winnipeg, there associated with The T. Eaton Co. Ltd., and occupying the position of Supervisor of Garment Departments, in his affidavit states:—

That in or about the year 1919 there was established in the Winnipeg Store what was known as the "French Room." In this room were dis-

played and offered for sale, dresses, coats, evening wraps, accessories and some varieties of footwear, all of which are imported from France.

That in more recent years reproductions of French models and merchandise from other European countries were displayed in the French Room, which on account of the variety of merchandise was renamed "Import Room" in or about the year 1927

That the term "French Room" is to-day used by our customers and our employees to describe a section of our Fancy Goods Department of the Winnipeg Store, wherein European novelties are offered for sale.

1939
 DOWER BROS.
 LTD.
 v.
 REGISTRAR
 OF
 TRADE
 MARKS.
 Maclean J.

Miss Sewell of the firm of Beresford Registered, of Montreal, in an affidavit states:

I am familiar with the shopping conditions and practices prevailing amongst the large departmental stores in the City of Montreal;

The firm of The T. Eaton Co Limited of Montreal operate a large departmental store at the corner of University and St. Catherine Streets. This firm has a room in its premises in which millinery is sold and this room has for some time been commonly known as the "French Room";

The firm of The Robert Simpson Co. Ld., Montreal, also operate a large departmental store on St. Catherine Street West in the City of Montreal. This firm has a room in which an exclusive line of dresses is sold and this room is commonly known as "The French Room"

The firm of Jas. A. Ogilvy Limited also operate a large departmental store on St Catherine Street West in the City of Montreal This firm has a room in which an exclusive line of dresses is sold and this room is commonly known as the "French Room."

Mr. Jamieson, Supervisor in the Department store of The T. Eaton Co., at Toronto, states in his affidavit that:

About twenty years ago or more The T. Eaton Company Limited established in the Yonge and Queen Street Department Store what was known as a "French Room" and the room was so referred to in the Company's advertisements from time to time and by employees and customers in the course of business.

Until five or six years ago The T. Eaton Company Limited had two "French Rooms," one used in connection with the sale of millinery, which is still carried on, and the other in connection with the sale of dresses, lingerie and accessories which accessories did on occasions include shoes

Originally, goods actually imported from France were displayed and sold from the said "French Room" but in course of time domestic goods, French design and other goods of high class domestic manufacture were introduced and sold from the "French Room"

Mr. Richardson, of Toronto, in an affidavit states:

I am at present the Vice-President and General Manager of Fairweather Limited, an old and established store situate in the City of Toronto and dealing particularly in the sale of high class ready to wear goods I came to Fairweather Limited as Merchandise Manager in September, 1936, having previously since 1934 been "French Room buyer," for the Robert Simpson Company of Toronto I have been associated with the Ladies' Wear business since 1920 and am thoroughly familiar with the trade and the terms used in connection therewith.

1939
 DOWER BROS.
 LTD.
 v.
 REGISTRAR
 OF
 TRADE
 MARKS.

At Fairweather Limited instead of the words "French Room" we use the word "Salon," but I have for many years been familiar with the words "French Room" as generally used in the trade either to designate certain high class goods or to designate a small exclusive part of the store in which are segregated expensive goods of high quality and exclusive style.

In the affidavit of Mr. Northway, President of John Northway and Son Ltd., of Toronto, it is stated:

For many years we have used the words "French Room" in connection with high class goods sold in our store, but until recently we had no express sign to that effect.

We now have a sign with the words "French Room" used in connection with that portion of our millinery department devoted to the sale of high class products.

For many years I have been familiar with the words "French Room" as used in business of the same nature as my own, originally I believe to indicate that the goods were either imported from or designed in France and subsequently to be understood to refer to any goods of high quality and high price.

Mr. Burton, General Manager of The Robert Simpson Company Ltd., of Toronto, states in his affidavit that:

About twenty-five years ago The Robert Simpson Company, Limited, established what was known as a "French Room," and the Room was regularly advertised under that name from time to time.

In this Room were displayed chiefly goods actually imported from France, although better class goods modelled on French importations were also displayed there.

Somewhere about two years ago the name of the Room was changed to "St. Regis Room," but to this day many of our customers still know the Room as the "French Room."

There were several reasons why it was thought desirable to change the name of the Room from "French Room" to "St. Regis Room." For one thing, owing to the steady improvement in the quality of local goods and to tariff changes, the goods displayed in the Room consisted from year to year less of goods actually imported from France and more of domestic goods of the best quality. Also it was thought that, for advertising purposes it was desirable to make a change in the name of the Room.

There were produced also the affidavits of Mr. Murray, of the firm of Murphy-Gamble Ltd., and Mr. Asselin of the firm of A. J. Freiman Ltd., both of Ottawa, but as they are substantially to the same effect as some of those to which I have already referred I need not quote from them.

The words "French Room," to be applied to women's or misses' shoes, on their face seem so inappropriate for the purposes of a trade mark that most persons would at

once be curious as to the reason prompting the adoption of such a mark. Literally construed the words plainly mean a "Room" called "French," descriptive words when so used, but seemingly misdescriptive of an article such as a woman's shoe; nor do those words suggest an invented word mark to be applied to an article of merchandise. I think the affidavits to which I have referred afford the explanation. The words "French Room" have come to indicate, in the larger cities, a certain room or department of a store which is devoted to the display and sale of a class or classes of wares indicating high quality, excellence, superiority, popularity, craftsmanship, or foreign origin, in contradistinction to goods of the same general character, exhibited for sale in the same store, but not of the same origin, or of the same excellence in quality, and probably not of the same price. Originally, I have no doubt, those words were used to indicate that the goods displayed in a "French Room" were of French origin, that is to say, they were imported from France. Those words may still be used for that precise purpose, but apparently it may relate now to goods of domestic origin or goods imported from some country other than France. The segregation of merchantable goods in one room, which space was called "French Room," was to distinguish those goods from others in the same premises, because of their quality, or their origin, or both. The origin or quality must have been intended as the distinguishing characteristic of such goods, so segregated, otherwise there would be no sense in the proprietor incurring the additional expense of devoting one room or department of his business premises to such a use. As shown by the affidavits, the words "French Room" are or have been used to indicate a display of goods of French origin, or goods possessing special qualities, and the public have come to believe that such words signify that such goods possess a special value or attraction over other goods falling within the same class, and for that reason they are displayed before customers in a special room or department given the name in question here.

The appellant here is interested in the sale of footwear, other than women's or misses' shoes, as disclosed in its

1939
 DOWER BROS.
 LTD.
 v.
 REGISTRAR
 OF
 TRADE
 MARKS.
 Maclean J.

1939
 DOWER BROS.
 LTD.
 v.
 REGISTRAR
 OF
 TRADE
 MARKS.
 Maclean J.

application, and I cannot conceive of any reason for adopting the words "French Room" as a mark for women's or misses' shoes unless it were to indicate the place of origin, or that they were imitative of French designs or models, or that they were of a quality or excellence superior to other footwear and garments on sale in the appellant's store. The words "French Room" have acquired a significance in the merchandising centres of the country, and the appellant seeks to designate some of his goods by that mark and thus attribute to his goods the qualities or characteristics usually imputed to goods displayed for sale in a room or department of a store, known as "French Room." I think the use of the word "French," particularly when used in connection with women's apparel, would lead many people into believing that France was the country of origin of the appellant's goods, although on a strict interpretation the use of that word does not necessarily indicate "France." The use of the word "French" in conjunction with another word, when applied to certain classes of goods for sale in merchandising establishments, would suggest, I think, that France was the place of origin, unless there were some accompanying notice or explanation to the contrary. It is notorious, and a matter of common knowledge, that many persons are, for a time at least, deceived by the use of the word "English" when applied along with another word to certain goods, as a trade mark. For example, the mark "English Mixture," when applied to containers of tobacco, will mislead purchasers into thinking that the same as sold originated in England, though the vendor might not so have intended. I think the words "French Room" will be understood by many as being directed to the quality of the appellant's shoes, or their place of origin, and in either case they would fall within the prohibition of s. 26 (1) (c) of the Unfair Competition Act. I think the Registrar was right in refusing the application and I dismiss the appeal with costs.

Appeal dismissed.