

BETWEEN:

THE DRACKETT COMPANY OF }  
CANADA LTD. .... }

APPELLANT  
(Opponent);

Ottawa  
1968  
Jan. 29-30  
Feb. 26

AND

AMERICAN HOME PRODUCTS }  
CORPORATION .... }

RESPONDENT  
(Applicant).

*Trade marks—Appeal from Registrar’s decision—Opposition to registration—Proposed mark “Once-a-Week” applied to floor cleaner—Whether descriptive mark—No reasons given for Registrar’s decision—Whether error in law—Trade Marks Act, s, 12(1)(b).*

An application for registration of the proposed trade mark “Once-a-Week” to be used in association with a floor cleaner was opposed on the ground that it was “clearly descriptive or deceptively misdescriptive ... of the character or quality of the wares ...” and therefore not registrable under s. 12(1)(b) of the *Trade Marks Act* and on the further grounds that it was confusing with a trade mark of the opponent and that it was not distinctive. The opposition was rejected by the Registrar of Trade Marks as “not well founded” but he stated no reasons for that conclusion.

*Held*, on appeal, the Registrar erred in law in not holding that the expression “Once-a-Week” used in association with a floor cleaner would be clearly descriptive or deceptively misdescriptive of the character or quality of the floor cleaner. No person properly addressing himself to that question could come to any other conclusion.

*Rountree Co. v. Paulin Chambers Co.* [1968] S.C.R. 134; *Benson & Hedges (Canada) Ltd. v. St. Regis Tobacco Corp.* [1968] 2 Ex. C.R. 22 distinguished.

APPEAL from Registrar of Trade Marks.

*William R. Meredith, Q.C.* and *Donald G. Finlayson* for appellant.

*Peter Thompson* for respondent.

1968  
 DRACKETT  
 CO. OF  
 CANADA LTD.  
 v.  
 AMERICAN  
 HOME  
 PRODUCTS  
 CORP.

CATTANACH J.:—This is an appeal pursuant to section 55 of the *Trade Marks Act*, chapter 49 of the Statutes of Canada, 1952-53, from a decision of the Registrar of Trade Marks under section 37 of that Act rejecting the opposition of the appellant to the respondent's application for the registration of a proposed trade mark "Once-a-week" to be used in association with a "floor cleaner".

The Registrar's decision, dated April 5, 1966 was expressed in the following terms:

The applicant applied, pursuant to Section 16(3) of the *Trade Marks Act*, for registration of the trade mark "ONCE-A-WEEK" for use in association with a floor cleaner.

The opponent opposed the application on the following grounds:—

(a) The applicant is not entitled to registration in view of Section 37(2)(b) of the *Trade Marks Act* namely that the trade mark "ONCE-A-WEEK" is not registrable under Section 12(1)(b) since such trade mark is clearly descriptive or deceptively misdescriptive in the English and French languages of the character or quality of the wares with which the said trade mark is used or proposed to be used.

(b) The Applicant is not entitled to registration in view of Section 37(2)(c) namely that the applicant is not the person entitled to registration in view of the provisions of Section 16(3)(a) by reason of the fact that at the date of filing of Application No. 279,739 for the trade mark "ONCE-A-WEEK" or at any date upon which the applicant is entitled to rely, the trade mark "ONCE-A-WEEK" was confusing with the opponent's trade mark "Once in Every Week DRANO in Every Drain" which the opponent had previously used in Canada and which the opponent's predecessor with respect to this trade mark, The Drackett Company, and the opponent had previously made known in Canada. The opponent intends to rely on a date of first use at least as early as November 1959 and intends to rely on making known at least as early as the said date of November 1959. In connection with making known in Canada, the opponent will also rely on the activity in the United States of its said predecessor, The Drackett Company, in relation to the trade mark "Once in Every Week DRANO in Every Drain" registered in the United States under No. 767,768 dated March 31, 1964.

(c) The applicant is not entitled to registration in view of Section 37(2)(d), namely that the trade mark "ONCE-A-WEEK" is not distinctive since it is not adapted to distinguish the wares which the applicant proposes to associate with it from the wares which the opponent associates with the trade mark "Once in Every Week DRANO in Every Drain".

I have considered the evidence on file, the written arguments as well as the representations of counsel for both parties at a hearing held March 29th, 1966 and have arrived at the conclusion that the grounds of opposition are not well founded. Accordingly, the opposition is rejected pursuant to Section 37 of the *Trade Marks Act*.

The evidence before the Registrar consisted initially of the respondent's application for registration of a proposed trade mark dated December 27, 1963, on a prescribed form, stating that the trade mark applied for is the words "Once-a-Week" and that the applicant intended to use that mark in Canada in association with a floor cleaner. It is clear from the fact that the application was for a proposed trade mark and from the applicant's statement that it intended to use the mark in association with a floor cleaner, that there had been no prior use of the trade mark by the applicant.

1968  
 DRACKETT  
 Co. OF  
 CANADA LTD.  
 v.  
 AMERICAN  
 HOME  
 PRODUCTS  
 CORP.  
 Cattanach J.

By letter dated March 3, 1964 the Registrar advised the applicant, in accordance with the duty imposed upon him by section 36(2) of the Act, that he considered the proposed trade mark to be clearly descriptive or deceptively misdescriptive of the character "and/or" quality of the wares in association with which it was proposed to be used and that, therefore, the mark did not appear to be registrable in view of the provisions of section 12(1)(b) of the *Trade Marks Act*. The applicant was advised that any comments it wished to make would be given consideration, which was also the statutory obligation of the Registrar to do.

Pursuant to that invitation, representations were made on behalf of the applicant by its solicitors in a letter dated April 1, 1964 which apparently resulted in the Registrar not being satisfied that the proposed trade mark was not registrable because he then caused the application to be advertised in the manner prescribed.

The appellant herein thereupon filed a statement of opposition based on the three grounds as set out in the Registrar's decision quoted above.

The respondent, as applicant, filed a counter-statement.

The appellant, as opponent to the application, filed evidence in the form of two affidavits of F. S. Knox, the president of the appellant company, one of which affidavits had annexed thereto, six exhibits being copies of advertisements of its product, "Drano", in publications extensively circulated in Canada and featuring words and slogans such as "Make one day a week Drano day"; "Drano once a week keeps drains trouble free"; "Use Drano once a week in every drain" and "once in every week Drano in every drain".

1968  
 DRACKETT  
 Co. OF  
 CANADA LTD.  
 v.  
 AMERICAN  
 HOME  
 PRODUCTS  
 CORP.  
 Cattanach J.

The other affidavit of F. S. Knox had annexed ten exhibits being photostatic copies of story-boards used in actual television commercials which featured similar words and slogans as appeared in the published advertisements exhorting prospective purchasers to use its product, "Drano", weekly.

The two foregoing affidavits establish that the appellant, long engaged in the manufacture and sale of its product under the trade mark "Drano", consistently stressed in its advertising of that product on network television programs and in consumer magazines the theme that its product should be used on a weekly basis.

Incidentally the product, "Drano", is a chemical compound for cleaning, clearing and opening the drains of sinks, washboards and the like.

There was no evidence whatsoever as to the respondent's product other than the bare statement in the application for registration of the proposed trade mark that it is a "floor cleaner". Conceivably it might be a cleansing agent exclusively, or a cleansing agent in combination with some protective property. Neither was there any evidence of its applicability to the variety of flooring in modern use, that is whether its use is restricted to a particular type of flooring or is useful with respect to all types. Further there was no information as to whether the product was designed for use on areas of heavy, modest or light traffic or all such areas.

The respondent, as applicant, was not under any obligation to, nor did it file any evidence.

Therefore the only evidence before the Registrar was the application itself and the two affidavits above. There was also before him the written argument on behalf of the contending parties in the statement of opposition and counter-statement and he had, in addition, the benefit of oral argument by counsel for both parties at the hearing before him.

In argument before me counsel for the appellant abandoned the second ground of opposition that was advanced before the Registrar, namely, that the respondent was not entitled to registration under section 37(2)(c) of the Act because the proposed trade mark "Once-a-Week" was confusing with the appellant's trade mark "Once in Every

Week Drano in Every Drain" previously used in Canada and which the appellant's predecessor had previously made known in Canada. In so doing counsel for the appellant stated that the expression "Once in Every week Drano in Every drain" was not the subject matter of a registered trade mark in Canada. It did appear, however, that The Drackett Company, the appellant's predecessor, had registered the expression in the United States as a trade mark in which jurisdiction slogans appear to be registrable. I construe counsel's withdrawal of this ground of opposition as an admission that the expression in question, excepting the word "Drano", has not been used and is not known as a trade mark in Canada.

The contention of counsel for the appellant before me was, as I understood it, twofold, (1) that the proposed trade mark is not registrable within section 37(2)(b) in that it is "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..." and so within the prohibition of section 12(1)(b) and, (2) that the proposed trade mark is not distinctive within the meaning of section 37(2)(d).

The contrary contention advanced by counsel for the respondent was that the proposed trade mark "Once-a-Week" is not "clearly descriptive of the character or quality" of a floor cleaner but is, at most, merely suggestive or meaningless when so associated and that the mark is capable of being adapted to distinguish the respondent's wares from those of another and is, therefore, "distinctive" within the relevant portion of the definition of that word in section 2(f) of the Act.

If the responsibility for the initial decision had been mine, I would have concluded that the proposed trade mark was not registrable under section 12(1)(b). I think that the words "Once-a-Week" are merely informative, descriptive or generic as applied to a floor cleaner and that such words are not likely to serve any purpose other than to inform prospective purchasers of the frequency with which the product should be used.

In so concluding, I accept without question the submission of the respondent that the decision that a trade mark is clearly descriptive is one of first impression.

1968  
 DRACKETT  
 Co. OF  
 CANADA LTD.  
 v.  
 AMERICAN  
 HOME  
 PRODUCTS  
 CORP.  
 Cattanach J.

1968  
 DRACKETT  
 CO. OF  
 CANADA LTD.  
 v.  
 AMERICAN  
 HOME  
 PRODUCTS  
 CORP.  
 Cattanach J.  
 —

My first impression, and my continuing impression, is that the words "Once-a-Week" would convey to a prospective purchaser and immediately identify a floor cleaner with which it is associated as one that need be used only once a week and that one application thereof would endure for that period of time.

The word "clearly" in section 12(1)(b) of the Act, which precludes the registration of a trade mark that is "clearly descriptive...of the character or quality of the wares or services in association with which it is used or proposed to be used", is not synonymous with "accurately" but rather the meaning of the word "clearly" is "easy to understand, self-evident or plain".

It is not a proper approach to the determination of whether a trade mark is descriptive to carefully and critically analyse the word or words to ascertain if they have alternative implications when used in association with certain wares but rather to ascertain the immediate impression conveyed thereby. I do not accept the submission of counsel for the respondent that the words, "Once-a-Week" are merely suggestive of the results to be obtained. I think the use of such mark goes further than that. A person faced with a floor cleaner described as "Once-a-Week", in my opinion, would assume that the product need only be used weekly and would endure for that period of time which, to me, is an attribute or property that has a direct reference to the durable and excellent quality of the product. Further the word "character" as used in section 12(1)(b) must mean a feature, trait, or characteristic of the product. The proposed trade mark "Once-a-Week" clearly implies that the product with which such mark is associated is to be used weekly. This, to me, is a direct reference to the "character" of the product. For the same reasons I do not accept the submission that the words "Once-a-Week", when associated with a floor cleaner are meaningless. As applied to the product in question the words to be meaningless should be so obviously and notoriously inappropriate as to be not calculated to suggest description which, in my view, is not the case here. I feel that the meaning of the words is abundantly clear.

Since I would come to a conclusion diametrically opposed to that of the Registrar, that the grounds of opposition to the registration of the proposed trade mark,

"Once-a-Week" are not well founded, the question arises whether it is open to me to substitute my conclusion for his and allow the present appeal.

The nature of this Court's duty was considered by the Supreme Court of Canada in *The Rowntree Company Limited v. Paulin Chambers Co. Ltd.*<sup>1</sup> In that case there was an appeal from the decision of the Registrar that a trade mark, the registration of which was sought, would be confusing with an existing trade mark, the concurrent use of which would lead to the inference that the wares of the conflicting parties emanated from the same source. This Court substituted its view on the issue whether the marks were confusing and on appeal to the Supreme Court of Canada, that Court by a unanimous judgment delivered by Ritchie J. allowed the appeal and restored the Registrar's decision. Ritchie J. said:

It is contended on behalf of the respondent that the conclusion reached by the learned trial judge should not be disturbed having regard to the terms of s. 55(5) of the Act which provides that "on the appeal... the Court may exercise any discretion vested in the Registrar". I do not, however, take this as meaning that the Court is entitled to substitute its view for that of the Registrar unless it can be shown that he proceeded on some wrong principle or that he failed to exercise his discretion judicially.

...

In my view the Registrar of Trade Marks in the present case applied the test required of him by the statute and I do not think that grounds were established justifying the learned judge of the Exchequer Court in interfering with his conclusion. For all these reasons I would allow this appeal and restore the decision of the Registrar of Trade Marks refusing the respondent's application S.N. 264951.

The President of this Court rendered a decision in *Benson & Hedges (Canada) Limited v. St. Regis Tobacco Corporation*,<sup>2</sup> which was also an appeal from a decision of the Registrar on the similar issue as to whether two trade marks were confusing. Although he would have reached a contrary decision to that of the Registrar, he concluded, in the circumstances of the case before him, that it was not open to him to substitute his decision for that of the Registrar on the authority of the *Rowntree* case. He added:

In this case, no submission has been made that the Registrar proceeded on a "wrong principle" or "that he failed to exercise his

1968  
 DRACKETT  
 Co. OF  
 CANADA LTD.  
 v.  
 AMERICAN  
 HOME  
 PRODUCTS  
 CORP.  
 Cattanach J.

<sup>1</sup> [1968] S.C.R. 134.

<sup>2</sup> [1968] 2 Ex. C.R. 22

1968  
 DRACKETT  
 Co. OF  
 CANADA LTD.  
 v.  
 AMERICAN  
 HOME  
 PRODUCTS  
 CORP.  
 Cattanach J.

discretion judicially" and I know of no basis upon which any such submission could have been made. Not only is there no indication that he failed to follow the requirements of any provision in the statute, but there is no room for suggesting that he left out of account any material fact (Presumably the situation would be different if, under section 55(5) of the *Trade Marks Act*, additional evidence were adduced in this Court that made a difference of substance between the facts before the Registrar and the facts before this Court. Compare *The Queen v. Secretary of State*, [1953] 1 S.C.R. 417, per Locke J. at pages 425-6.) or came to any conclusion on the facts that could not be supported on the evidence. Certainly, there is no room for suggesting that he did not act judicially. That being so, there is no occasion for this Court to interfere with his conclusion and substitute its decision for his.

In the present appeal counsel for the appellant did submit that the Registrar had proceeded on a "wrong principle", that "he failed to exercise his discretion judicially", that his conclusion on the facts could not be supported on the evidence before him and that he gave no reasons for his decision as it was his obligation to do by virtue of section 37(8).

In contradiction counsel for the respondent submitted since the issues of whether a proposed trade mark is clearly descriptive of the character or quality of the wares with which it is to be associated and whether a proposed mark is adapted to distinguish those wares are both matters of first impression and accordingly the Registrar could say no more than he did. He further submitted that there was evidence before the Registrar upon which he could reasonably find as he did and, therefore, his decision cannot be reviewed.

I have looked at the language employed by the Registrar in stating his conclusion in an attempt to ascertain whether he attached the weight he should have to the material before him, or whether he rejected material which he should have considered and in short to determine if he arrived at his conclusion judicially.

I have been unable to obtain any assistance therefrom. After identifying the proposed trade mark and the product with which it was to be associated, reciting the three grounds of opposition to its registration and stating that he considered the evidence on file, the written and oral representations on behalf of the respective parties, he then announced his conclusion that "the grounds of opposition



are not well founded” and rejected the opposition. Other than that he did not elaborate upon the grounds by which he reached that conclusion.

1963  
DRACKETT  
CO OF  
CANADA LTD.  
v.  
AMERICAN  
HOME  
PRODUCTS  
CORP.  
Cattanach J.

Having regard to the nature of the application, the simple question that the Registrar had to decide under section 12(1)(b) of the Act was whether the expression “Once-a-Week” used in association with a “floor cleaner” would be clearly descriptive or deceptively misdescriptive of the character or quality of the floor cleaner. Making every allowance for the possibility of different minds reacting differently to the same set of circumstance, I cannot escape the conclusion that the Registrar erred in law in not holding that it would be. Just as no person, properly addressing himself to the question to be decided, could come to any conclusion with reference to a word such as “tender” used in association with meat, except that it is clearly descriptive or deceptively misdescriptive within the meaning of section 12(1)(b), so, in my opinion, no person, properly addressing himself to the question to be decided, could come to any conclusion with reference to the expression “Once-a-Week” used in association with a floor cleaner, except that it is clearly descriptive within the meaning of section 12(1)(b).

It follows that I must conclude that the Registrar misconceived the question that he had to decide when considering that branch of the case and is manifestly wrong.

Having reached that conclusion, there is no need to decide whether the other attack on the application for registration, that is, that the proposed trade mark is not capable of being adapted to distinguish the respondent’s product and is therefore not distinctive, should have succeeded.

The appeal is allowed with costs and the matter is referred back to the Registrar for appropriate action in accordance with these reasons.