

BETWEEN :

STANDARD OIL COMPANY APPELLANT;

AND

THE REGISTRAR OF TRADE MARKS }

RESPONDENT.

Ottawa
1968
May 17
June 7

Trade marks—"Fior", an invented word—Whether primarily merely surname of individual—Test to apply—Rejection of application for registration—Affidavit filed by Registrar—Admissibility of—Evidence on appeal—Trade Marks Act, s. 12(1)(a), 55(5), 58(3)—Exchequer Court Rule 36(6).

An application for registration of the trade mark "FIOR" (made up of the initial letters of the words "fluid iron ore reduction") for use with appellant's wares was rejected by the Registrar of Trade Marks as being "a word primarily merely the surname of an individual" and therefore not registrable under s 12(1)(a) of the *Trade Marks Act*. Appellant appealed to this court. The Registrar filed an affidavit on the appeal pursuant to *Exchequer Court Rule 36(6)* declaring that "FIOR" appeared in Montreal's directory as the surname of one individual in 1955, in Toronto's for nine individuals in 1967, and similarly in a number of US directories.

Held, the appeal must be allowed.

"FIOR", though without dictionary meaning, is a word for trade mark purposes, but to the general public of Canada it is not primarily merely the surname of an individual, which is the test to apply. *Magnolia Metal Co's Trade Marks* (1897) 14 R.P.C. 265, applied.

The Registrar was entitled to conclude from the city directories that "FIOR" was the name of one or more living individuals in Canada.

On appeal from the Registrar this court is entitled to receive evidence in addition to that which was before the Registrar. *Rowntree Co. v. Paulin Chambers Co.* [1968] S.C.R. 134 considered; *Benson & Hedges (Canada) Ltd. v. St. Regis Tobacco Corp.* [1968] 2 Ex. C.R. 22 referred to.

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APPEAL from Registrar of Trade Marks.

R. Graham McClenahan for appellant.

André R. Garneau and *H. A. Newman* for respondent.

JACKETT P.:—This is an appeal from a decision of the Registrar of Trade Marks rendered on November 14, 1967, refusing an application by the appellant for registration of the trade mark “FIOR” on the basis of its proposed use in Canada by the appellant in association with wares described in the application as “direct reduction iron ore”.

The application was filed September 9, 1966, by Messrs. Gowling, MacTavish, Osborne & Henderson, as “Agents” for the appellant, and that firm was notified by a communication dated December 14, 1966, from the Trade Marks Office that “FIOR” was considered to be primarily merely the surname of an individual and that in view of the provisions of section 12(1)(a) of the *Trade Marks Act*, which reads as follows:

12. (1) Subject to section 13, a trade mark is registrable if it is not

(a) a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years;

it did not appear to be registrable.¹ As a result of an invitation issued to Gowling, MacTavish, Osborne & Henderson by that communication for their comments, an exchange of correspondence ensued during which, counsel are agreed, the respondent expressed his ultimate position by that part of his letter of May 8, 1967, that reads:

Since the word “FIOR” has no dictionary meaning and appears in the directories of Toronto and Montreal as a surname, it is

¹ In considering the interpretation of section 12(1)(a) adopted by the respondent, and in considering what effect should be given to it, it must be read with section 12(2) which reads:

(2) A trade mark that is not registrable by reason of paragraph (a) or (b) of subsection (1) is registrable if it has been so used in Canada by the applicant or his predecessor in title as to have become distinctive at the date of filing an application for its registration.

In effect, what section 12(1)(a) prohibits is the registration of certain words as “proposed” trade marks. When such word has been so used “as to have become distinctive”, it may be registered as a mark that falls under section 2(t)(i).

considered to be primarily merely the surname of an individual. Therefore, the objection taken under section 12(1)(a) of the *Trade Marks Act*, is maintained.

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(During the course of that exchange, the appellant filed affidavits of a professor of English, expressing the opinion that "FIOR" is not a word. In my view these affidavits are, in effect, an expression of opinion as to what the *ordinary* English word "word" means, and are not admissible evidence on what is a question of law. I see no indication that the Registrar paid any attention to them.)

As contemplated by Rule 36(2) of the Rules of this Court, when the appellant filed its Notice of Appeal in this Court on December 13, 1967, it also filed a statement of its "Allegations of Fact". As permitted by Rule 36(3) of those Rules, on January 23, 1968, the appellant filed an affidavit of one Francis X. Clair, the substantive paragraphs of which read as follows:

1 I am Trademark Counsel of the Standard Oil Company the Appellant herein, the said company being also the applicant for registration of the trade mark FIOR under application serial No. 299,506 filed in the Canadian Trade Marks Office and as such I have knowledge of the facts herein deposed to.

2. That the said trade mark FIOR was created by combining the first letters of each of the words "fluid iron ore reduction" and the mark has no meaning by itself.

A Reply and Allegations of Fact were thereupon filed on behalf of the respondent under Rule 36(4) and (5), and on February 7, 1968, an affidavit, sworn by the respondent himself, was filed as contemplated by Rule 36(6). This affidavit showed that "FIOR" appeared as the surname

- (a) of one individual in Lovell's Montreal Directory (1955),
- (b) of one individual in the Illinois Bell Telephone Directory (1967),
- (c) of two individuals in the Pacific Telephone Directory for San Francisco (1966),
- (d) of three individuals in the Pacific Telephone Directory for Los Angeles (1967), and
- (e) of nine individuals in Might's 1967 Greater Toronto City Directory.

An application was thereupon made by the appellant on April 2, 1968, that the affidavit taken by the respondent

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“be struck out as inadmissible on the ground that it is not established in the affidavit that the information therein contained was available to and considered by the Registrar of Trade Marks in reaching his decision which is under appeal in these proceedings”. This application was dismissed on the ground that it was not a proper case for making such an interlocutory application. (In my view, at that time, any question as to the relevancy or admissibility of evidence contained in affidavits filed under Rule 36 should be dealt with on the hearing of the appeal in the absence of special circumstances.)

At the opening of the argument of this appeal, the question was raised as to whether the appeal must, ordinarily, be determined on the basis of the evidence that was before the respondent when he made the decision appealed from, or whether the parties are entitled, as of right, to put evidence before the Court on the appeal that was not before the Registrar when he rendered the decision appealed from.

The *Trade Marks Act* imposes on the Registrar (the respondent) the duty of making many different classes of decision. We are concerned here with the duty imposed on him, at one of the several different possible stages in the processing of an application under section 29 for registration of a trade mark, by section 36(1), which reads as follows:

36 (1) The Registrar shall refuse an application for the registration of a trade mark if he is satisfied that

(a) the application does not comply with the requirements of section 29;

(b) the trade mark is not registrable; or

(c) the applicant is not the person entitled to registration of the trade mark because it is confusing with another trade mark for the registration of which an application is pending,

and where the Registrar is not so satisfied, he shall cause the application to be advertised in the manner prescribed.

In this case, the Registrar decided that the trade mark that the appellant had applied to have registered was “not registrable” and he therefore refused the application for registration of the trade mark as he was required, by section 36(1)(b), to do. The appeal from that decision was taken under section 55 of the *Trade Marks Act* which reads, in part:

55 (1) An appeal lies to the Exchequer Court of Canada from any decision of the Registrar under this Act within two months from

the date upon which notice of the decision was despatched by the Registrar or within such further time as the Court may allow, either before or after the expiry of the two months.

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(2) The appeal shall be made by way of notice of appeal filed with the Registrar and in the Exchequer Court of Canada.

(3) The appellants shall, within the time limited or allowed by subsection (1), send a copy of the notice by registered mail to the registered owner of any trade mark that has been referred to by the Registrar in the decision complained of and to every other person who was entitled to notice of such decision.

* * *

(5) On the appeal evidence in addition to that adduced before the Registrar may be adduced and the Court may exercise any discretion vested in the Registrar.

This provision must be read with section 58, which reads:

58. (1) Where an appeal is taken under section 55 by the filing of a notice of appeal, or an application is made under section 56 by the filing of an originating notice of motion, the notice shall set forth full particulars of the grounds upon which relief is sought.

(2) Any person upon whom a copy of such notice has been served and who intends to contest the appeal or application, as the case may be, shall file and serve within the prescribed time or such further time as the court may allow a reply setting forth full particulars of the grounds upon which he relies.

(3) The proceedings shall then be heard and determined summarily on evidence adduced by affidavit unless the court otherwise directs, in which event it may order that any procedure permitted by its rules and practice be made available to the parties, including the introduction of oral evidence generally or in respect of one or more issues specified in the order.

Section 58(3) makes it clear that, unless the Court otherwise directs, such an appeal is to be "heard and determined" on "evidence" adduced by affidavit in this Court. This would seem to indicate that the statute contemplates the possibility that the evidence concerning the material facts (i.e., in this case, the facts material to the question whether the trade mark is "registrable") might be different from the evidence concerning the material facts that was before the Registrar. If that is so, the appeal to this Court does not necessarily raise a question as to whether the Registrar's decision was right or wrong because his decision might have been right on the evidence before him while the evidence before the Court on the appeal would require the Court to find different material facts and to reach a different conclusion. In other words, if that is the correct view of the matter, the appeal to this Court might be treated as being what is sometimes described as a "new

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trial". However, the wording of section 58(3) does not necessarily drive one to the conclusion that what is contemplated on the appeal is new evidence as to the facts that are material to the question that the Registrar decided. Bearing in mind that there is no provision, apart from section 58(3), as to the material on which an appeal should be decided, and assuming that the only appeal permitted by the statute is one restricted to the question whether the Registrar decided the question properly on the material that was before him, *evidence* would be necessary.

- (a) as to what evidence was before the Registrar when he made his decision, and
- (b) if an attack is made on the propriety of the decision as not having been made in accordance with fundamental principles, as to the facts surrounding the way in which the decision was reached;

and on that view, the reference to "evidence" in section 58(3), in the case of an appeal, would relate only to such evidence. That part of section 55(5) that provides that "On the appeal evidence in addition to that adduced before the Registrar may be adduced" might be explained as being consistent with either of these views as to the nature of a section 55 appeal. However, I am of the view that the provision for evidence "in addition" to that before the Registrar suggests very strongly that what is contemplated is "additional" evidence in relation to the same issues as the issues in relation to which evidence was adduced before the Registrar. It follows that, in my view, either party may put in evidence on the facts material to the issues that were before the Registrar and that such evidence may be considered along with the evidence that was before the Registrar, which, of course, must also be placed before the Court on the appeal.

In coming to this conclusion, I reject the suggestion that what is contemplated by section 55(5) is only evidence that was not available at the time that the matter was put before the Registrar. If that is what is contemplated, I should have thought that section 55(5) would be expressed as a discretion conferred on the Court to admit additional evidence such as is found in section 67 of the *Supreme Court Act*, R.S.C. 1952, chapter 259, and in Rule 234 of the Rules of the Supreme Court of Ontario.

I do not, moreover, consider that I am in any way failing to give full effect to the decision of the Supreme Court of Canada in *Rowntree Co. v. Paulin Chambers Co.*,² concerning the effect to be given to the second part of section 55(5). As I indicated in a footnote to my judgment in *Benson & Hedges (Canada) Ltd. v. St. Regis Tobacco Corp.*,³ it does not seem to me that the effect to be given to the Registrar's exercise of discretion would be the same if, under section 55(5), there were adduced in this Court additional evidence that made a difference of substance between the facts before the Registrar and the facts before this Court.

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My conclusion on the preliminary question raised at the hearing was, therefore, that this appeal was to be heard and determined on the material in the Registrar's file, a certified copy of which had been placed before the Court in accordance with the Rules of Court, and upon the affidavits that had been filed in this Court by the respective parties before the hearing in accordance with the Rules. I made an order accordingly. I might add that while counsel for the parties argued the question, both parties were of the view, as I understood them, that the question as to what evidence should be considered by the Court on this appeal should be resolved in the way that I have decided it.

I turn now to the merits of the appeal.

The appellant, as I have already indicated, applied for registration of the trade mark "FIOR" on the basis of its proposed use in Canada by the appellant in association with wares described in the application as "direct reduction iron ore". The respondent rejected that application on the ground that the trade mark in question was a "word" that is "primarily merely the surname of an individual" and was therefore "not registrable" by virtue of that part of section 12(1)(a) that provides that a trade mark is "registrable" if it is not "a word that is primarily merely . . . the surname of an individual who is living or has died within the preceding thirty years". The respondent's conclusion was based (see his letter of May 8, 1967) on two facts, *viz*:

(a) the word "FIOR" has no dictionary meaning, and

² [1968] S.C.R. 134.

³ [1968] 2 Ex C.R. 22

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(b) the word "FIOR" appears in the directories of Toronto and Montreal as a surname.

By reason of these two facts, "FIOR" was considered by the respondent to be "primarily merely" the surname of an individual.

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Two attacks by the appellant on the respondent's conclusion can be dealt with briefly. They are

- (a) that the trade mark "FIOR" is not "a word" within the meaning of the word "word" where it appears at the beginning of section 12(1)(a) of the *Trade Marks Act*; and
- (b) that the fact that "FIOR" appears in the directories of certain Canadian cities as a surname is not a proper evidentiary basis for concluding that it is the surname of an individual.

Dealing with the latter submission first, I think it is fair to say that the submission is based on the contention that "These compilations are not noted for their accuracy and we have no assurance that the surname relied upon has not been mis-spelled, nor do we know in fact whether it is an actual surname or only an assumed name having no legal effect or existence". This, in my view, goes to cogency, but not to relevancy. In my view, it was open to the respondent to conclude from the fact that "FIOR" has appeared in directories in Canada as a surname that the balance of probability is that "FIOR" is the surname of one or more individuals in Canada who are living. If the appellant had had any doubt as to the correctness of this conclusion, he had ample opportunity to cause the facts to be checked and to place evidence with regard thereto before the respondent or the Court. He has not done that and I can only conclude, as the respondent did, that the balance of probability is that there are individuals in Canada whose surname is "FIOR".

With reference to the contention that "FIOR" is not a word, which was the appellant's main contention before the respondent, I have some sympathy with the respondent who did not seem to recognize sufficient merit in the argument to warrant the giving of reasons for rejecting it. The generic definition of "word" in the Shorter Oxford English Dictionary is "Speech, utterance, verbal expression".

The expression "FIOR" may not have any meaning to the general public of Canada as yet but, as far as those who know a person whose surname is "FIOR" are concerned, it means that such a person, and, if this appeal succeeds and the appellant's proposed trade mark becomes an active trade mark, it will operate to distinguish the appellant's goods from the goods of others. For trade mark purposes, there are at least three classes of "words", *viz*, dictionary words, names, and invented words. They are all words, in my view, at least for the purposes of the *Trade Marks Act*. Any other view results in limitations on the application of section 12(1)(a) that I cannot think that Parliament intended. I, therefore, reject the contention that "FIOR" is not a "word" within the meaning of that word in section 12(1)(a) of the *Trade Marks Act*.

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That brings me to the position that I am satisfied that, on the evidence before the respondent and the evidence before me, "FIOR" is "a word that is . . . the surname of an individual who is living". The further question to be decided is, whether "FIOR" is "primarily merely" such a word.

In considering this question, it has to be noted that, while it was not established before the respondent by evidence,⁴ it was established by affidavit in this Court that "the said trade mark 'FIOR' was created by combining the first letters of each of the words 'fluid iron ore reduction'." As far as the appellant was concerned, therefore, "FIOR" was a word invented by it for use as its trade mark in this connection. It follows, therefore, that "FIOR" is not "merely" the surname of a living person because it also has existence as a word invented by the appellant or persons working for it for trade mark purposes. (It does not appear that the appellant caused the respondent to address his mind to this as an alternative character of the word that ought to be considered in determining whether "FIOR" falls within the words of section 12(1)(a).)

The next stage in considering the problem of applying section 12(1)(a) to the word "FIOR" is to consider whether "FIOR" is "primarily" the surname of a living person (Note that the French version uses the word "principale-

⁴ It had been asserted, but the respondent does not indicate that he saw any relevance to it.

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ment" where the English version uses "primarily".) In other words, is the chief, main or principal character of "FIOR" that of a surname or is it principally or equally a word invented to be used as a trade mark?

Certainly, from the point of view of the people called "Fior" and their immediate circle of friends and acquaintances, the answer is that "Fior" is principally if not exclusively a surname, and from the point of view of the trade mark advisers of the appellant, the answer is that it is principally if not merely an invented word. The test, for the purposes of section 12(1)(a) is not, in my view, the reaction of either of these classes of persons. The test must be what, in the opinion of the respondent or the Court, as the case may be, would be the response of the general public of Canada to the word. My conclusion is that a person in Canada of ordinary intelligence and of ordinary education in English or French would be just as likely,⁵ if not more likely, to respond to the word by thinking of it as a brand or mark of some business as to respond to it by thinking of some family of people (that is, by thinking of it as being the surname of one or more individuals).⁶ Indeed, I doubt very much whether such a

⁵ If the two characters (surname and invented word) are of equal importance, it cannot be said that it is "primarily merely" a surname.

⁶ I have, in effect, adapted the approach taken by Kekewich J. in *In re The Magnolia Metal Company's Trade Marks*, (1897) 14 R.P.C. 265, where he deals with a similar problem concerning geographical names at pages 269-70, as follows:

Those being the words of the Act, and that being the object, am I bound to say that the Legislature meant that wherever a name proposed to be put on the Register, or being actually there and sought to be expunged, has a geographical meaning, therefore it must not go on the Register, or, being there, it must be taken off, even though its primary meaning may be something quite different, and it may have two or three other meanings, perhaps all of them better known than the geographical meaning? That is, the real question in this case is the question which was illustrated by some remarks made by myself in the *Apollinaris Company's* case, and which have been cited on page 204 of 1891, 2 Chancery. There, taking up, I suppose, what was said in argument, I instanced or illustrated what I had to say by reference to "Monkey" as connected with soap, and to "St. Paul" as connected with some other goods, I am not sure what. No ordinary person would jump at the conclusion, when he found that soap was called "Monkey", that it had any connection with the one or two by no means large places, or well known to the public, which are called by the name of "Monkey". He would naturally consider

person would respond to the word by thinking of there being an individual having it as a surname at all.

I am, therefore, of the view that it is probably not "primarily" a word that is a surname of an individual at all, but it is certainly not primarily "merely" such a word.

I have probably been influenced in coming to the conclusion that I have expressed as to how the word "primarily" in section 12(1)(a) should be applied by the fact that applying the provision solely by reference to the existence of a dictionary meaning of a proposed trade mark would make practically every invented word vulnerable to attack as a proposed trade mark by anyone assiduous enough to pursue his searches for its use as a surname somewhere in

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that it was connected with the inferior animal of that name. Again, as regards "St. Paul", no one would suppose, if he came across "St. Paul", that any reference was meant other than one to the Apostle known by that name. Nevertheless, it may be (and it appears that it is so) that both are geographical names. Of course, if that had been decided in that case, I should not have been discussing it now, but nothing was decided. It seems to me that on these lines I have good ground for consideration whether "Magnolia" here is a geographical name in the sense of its being the primary meaning of the word, or that which would occur to the man of ordinary education and intelligence. I must not forget that when I talk of ordinary education and intelligence, I must mean the Englishman of that character. I am not, for a moment, putting out of sight that "geographical" extends to the whole of the world, and that if there is a geographical name derived from any part of the globe, it will offend against the words of the Act; but still, the persons who are to decide, whether it be a judge or a jury, if there is any question for decision at all, must be Englishmen of ordinary education and intelligence. If there is no question to decide, it is because all that you have got to do is to establish, as has been established here, that there are several places known as "Magnolia" in the United States, and that therefore it is in one sense a geographical name, and there is an end of the whole discussion. If there is any question at all, then I think it has to be submitted to the Englishman of ordinary education and intelligence and he has to decide whether that is, I will not say even the primary meaning of the word, but the meaning which would occur to the large majority of people as that which it would be regarded in ordinary society as bearing. Without going into the evidence, I venture to say that a very small proportion of persons of the character I have mentioned would recognise in the word "Magnolia" any reference to any town or place in the United States or elsewhere. On the other hand, though not so common as many other flowers, the magnolia is thoroughly well known to all persons of the character I have mentioned, and if "Magnolia" were mentioned in any ordinary society consisting of persons of fair education, it would be understood at once

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the world (or, indeed, in a country such as Canada even if the search were restricted to Canada). I cannot believe that section 12(1)(a) was intended virtually to eliminate the creation of new words for purposes of proposed trade marks.

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to refer to the flower, or the tree which bears that flower. That seems to me to be, I will not say the primary meaning, because primary or secondary are rather out of the question, but the meaning which the word would bear ordinarily to ordinary people. Is there any reason why I should not construe the Act in that way? I admit, and I do not hesitate to say it, I am perplexed by the extreme terseness and literal use of the words "geographical name"; but, on the other hand, I do not think I am bound to decide that it was meant by the Legislature that every word that was capable of being treated as a geographical name, but was also capable of being used, and ought to have been used, among ordinary people as meaning something else, was intended to be referred to as a geographical name.

This case was dealt with by the Court of Appeal in the same volume at page 621 where Rigby L.J., delivering the judgment of the Court, said, at pages 627-8:

The objection to the word "Magnolia" as being a geographical name within the meaning of the section, in our opinion, fails as to both the marks Nos 2 and 3. It is, no doubt, shown by the evidence, that there are places in the United States called by the name "Magnolia", and if "geographical name" in Section 64, Subsection (e), were equivalent to the name of any place, "Magnolia", as the name of places mentioned in the evidence, would fall within the exception. But, in our judgment, the phrase "geographical name" in Section 64, Sub-section (e), ought not in general to receive so wide an interpretation. It must, we think, in the absence of special circumstances, be interpreted so as to be in accordance, in some degree, with the general and popular meaning of the words, and a word does not become a geographical name simply because some place upon the earth's surface has been called by it. For example, we agree with Mr. Justice Kekewich that the word "Monkey" is not proved to be a geographical name, by showing merely that a small and by no means generally-known island has been called by that name.