

Federal Court



Cour fédérale

**Date: 20110118**

**Docket: T-1091-09**

**Citation: 2011 FC 58**

**Ottawa, Ontario, January 18, 2011**

**PRESENT: The Honourable Mr. Justice Mandamin**

**BETWEEN:**

**ONTARIO TEACHERS' PENSION  
PLAN BOARD**

**Applicant**

**and**

**THE ATTORNEY GENERAL  
OF CANADA**

**Respondent**

**REASONS FOR JUDGMENT AND JUDGMENT**

[1] This is an appeal pursuant to subsection 56(1) of the *Trade-marks Act*, R.S.C., 1985, c. T-13 (the *Act*). The applicant challenges the May 8, 2009 decision of Mary Carman, Registrar of Trade-marks, refusing to register the mark TEACHERS'. The Registrar found the mark is an apt trade term describing the intrinsic character of the administration, management and investment of a pension fund for teachers which should be left available for others to use and is therefore not registrable as being contrary to paragraph 12(1)(b) of the *Act*.

[2] The applicant is the Ontario Teachers' Pension Plan Board. As its name suggests, the applicant administers the Ontario Teachers' Pension Plan. The applicant applied to register the mark TEACHERS' (capitalized plural possessive). The examiners in the Canadian Intellectual Property Office (CIPO) had indicated that the trade-mark may not be registrable because it is either descriptive or deceptively misdescriptive of the applicant's wares and services. After several exchanges of correspondence, the Registrar refused to registrar the mark TEACHERS', concluding it was not registrable as it was contrary to paragraph 12(1)(b) of the *Act*.

[3] The applicant appeals this decision contending that the mark was not clearly descriptive of the wares and services provided.

[4] For reasons that follow, I am dismissing this appeal.

### **Background**

[5] This application has been before the CIPO since June of 2002. The relevant events and dates in this application are as follows:

Date	Event
June 20, 2002	Applicant applies for the trade-mark TEACHERS' under no. 1,144,430 for the services described as "administration of a pension plan, management and investment of a pension fund for teachers in Ontario."
April 29, 2003	Examiner finds that the mark may not be registrable because it is either descriptive or deceptively misdescriptive pursuant to paragraph 12(1)(b) of the <i>Trade-marks Act</i> , and invites applicant to make submissions.
August 28, 2003	Applicant asks for time extension to reply.
September 8, 2003	Time extension granted to February 29, 2004

February 29, 2004	Applicant replies stating the use of an apostrophe “signifies something belonging to those that teach others.”
November 9, 2004	Examiner’s report sent to applicant finding mark is unregistrable, as “pluralizing a word cannot save an unregistrable Trade-mark.”
March 9, 2005	Applicant replies to examiner’s report with three pages of arguments asking examiner to reconsider decision and allow application. Submits that the only service described in the word Teachers’ is teaching; these are not the services for which the mark is being registered.
February 19, 2007	Examiner issues a new report maintaining the objection, noting that “it is considered that the average Canadian would, on first impression and in association with the applicant’s services, easily and readily understand that the applicant administers a pension plan, and provides management and investment for a pension fund, for teachers”.
June 19, 2007	Applicant asks for an extension of time to December 19, 2007.
June 28, 2007	Registrar grants request for extension of time to December 19, 2007.
July 6, 2007	Applicant makes no submission, asks Registrar to withdraw objection or refuse the application pursuant to subsection 37(1) of the <i>Act</i> in a timely fashion so that Applicant may pursue appeal to the Federal Court.
December 19, 2007	Applicant repeats previous requests.
June 2, 2008	Counsel for applicant explains applicant is in a contentious dispute with respect to a mark infringer, remarking that “the slowness of response by the Trade-marks Office has resulted in prejudice to my client which will continue until a response is received.”
August 6, 2008	Applicant asks for an answer “as soon as possible.”
May 8, 2009	Registrar maintains the position that the trade-mark is unregistrable in view of paragraph 12(1)(b) of the <i>Act</i> and refuses the application pursuant to paragraph 37(1)(b) of the <i>Act</i> .
July 23, 2009	Applicant files an (amended) Notice of Application in the Federal Court.

### Decision Under Review

[6] The Registrar communicated her final decision via a letter to the applicant on May 8, 2009

rejecting the application, finding:

“It is my position that the word TEACHERS’, being the phonetic equivalent of TEACHERS, is an apt trade term for describing the intrinsic character of the administration, management and investment of a plan/fund for teachers and as such should be left available for others to use since descriptive words are the property of all and cannot be appropriated by one person for their exclusive use.”

[7] The Registrar relies on the principle found in *General Motors Corp. v Bellows*, [1949] S.C.R. 678, 10 C.P.R. 101 at pp. 112-113 (*General Motors Corp. v Bellows*):

The rule quoted illustrates the conflict early recognized by the courts before the subject matter came under legislation, i.e. between the appropriation by a trader of a word within the range of language that would ordinarily be used by traders to describe particular goods, and the right of other traders in the normal carrying on of their business to employ the same or similar words. In the technique of advertising, the more complex and expensive the goods are, the greater the imaginative seeking by those producing them for attractive and arresting words; but in fixing the limits of legislative protection the courts must balance the conflicting interests and avoid placing legitimate competition at an undue disadvantage in relation to language that is common to all. (emphasis added)

[8] To reiterate, the Registrar found the trade-mark applied for by the applicant was unregistrable pursuant to paragraph 12(1)(b) of the *Act* and rejected the application pursuant to paragraph 37(1)(b).

## Legislation

[9] The relevant provisions of the *Trade-marks Act*, R.S.C., 1985, c. T-13 are sections 12, 37 and 56:

12. (1) Subject to section 13, a trade-mark is registrable if it is not  
...  
(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with

12. (1) Sous réserve de l'article 13, une marque de commerce est enregistrable sauf dans l'un ou l'autre des cas suivants :  
...  
b) qu'elle soit sous forme graphique, écrite ou sonore, elle donne une description claire ou donne une description fautive et trompeuse, en langue française ou anglaise, de la nature ou de

which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;

la qualité des marchandises ou services en liaison avec lesquels elle est employée, ou à l'égard desquels on projette de l'employer, ou des conditions de leur production, ou des personnes qui les produisent, ou du lieu d'origine de ces marchandises ou services;

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

(a) the application does not conform to the requirements of section 30,

(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.

37. (1) Le registraire rejette une demande d'enregistrement d'une marque de commerce s'il est convaincu que, selon le cas :

a) la demande ne satisfait pas aux exigences de l'article 30;

b) la marque de commerce n'est pas enregistrable;

c) le requérant n'est pas la personne qui a droit à l'enregistrement de la marque de commerce parce que cette marque crée de la confusion avec une autre marque de commerce en vue de l'enregistrement de laquelle une demande est pendante.

Lorsque le registraire n'est pas ainsi convaincu, il fait annoncer la demande de la manière prescrite.

56. (1) An appeal lies to the Federal Court from any decision of the Registrar under this Act within two months from the date on which notice of the decision was dispatched by the Registrar or within such further time as the Court may allow, either before or after the expiration of the two months.

56. (1) Appel de toute décision rendue par le registraire, sous le régime de la présente loi, peut être interjeté à la Cour fédérale dans les deux mois qui suivent la date où le registraire a expédié l'avis de la décision ou dans tel délai supplémentaire accordé par le tribunal, soit avant, soit après l'expiration des deux mois.

(2) An appeal under subsection (1) shall be made by way of notice of appeal filed with the

(2) L'appel est interjeté au moyen d'un avis d'appel

Registrar and in the Federal Court.

produit au bureau du registraire et à la Cour fédérale.

(3) The applicant 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 the decision.

(3) L'appelant envoie, dans le délai établi ou accordé par le paragraphe (1), par courrier recommandé, une copie de l'avis au propriétaire inscrit de toute marque de commerce que le registraire a mentionnée dans la décision sur laquelle porte la plainte et à toute autre personne qui avait droit à un avis de cette décision.

(4) The Federal Court may direct that public notice of the hearing of an appeal under subsection (1) and of the matters at issue therein be given in such manner as it deems proper.

(4) Le tribunal peut ordonner qu'un avis public de l'audition de l'appel et des matières en litige dans cet appel soit donné de la manière qu'il juge opportune.

(5) On an appeal under subsection (1), evidence in addition to that adduced before the Registrar may be adduced and the Federal Court may exercise any discretion vested in the Registrar.

(5) Lors de l'appel, il peut être apporté une preuve en plus de celle qui a été fournie devant le registraire, et le tribunal peut exercer toute discrétion dont le registraire est investi.

(emphasis added)

## Issues

[10] The applicant raises one issue. It contends that the Registrar erred in concluding that the trade-mark applied for was not registrable on the basis that:

“the word TEACHERS’, being the phonetic equivalent of TEACHERS, is an apt trade term for describing the intrinsic character of the administration, management and investment of a plan/fund for teachers and as such should be left available for others to use since descriptive words are the property of all and cannot be appropriated by one person for their exclusive use.”

## Analysis

### *Standard of Review*

[11] This is an appeal pursuant to subsection 56(1) of the *Act*. Subsection 56(5) provides that evidence may be adduced in addition to that adduced before the Registrar, and the Federal Court may exercise any discretion vested in the Registrar.

[12] When new evidence is submitted that is significant and substantial, the Court should proceed by way of a fresh hearing. The applicable standard of review for appeals where the issue is a likelihood of confusion was canvassed by the Supreme Court of Canada in *Mattel, Inc. v. 3894207 Canada Inc.*, 2006 SCC 22, [2006] 1 S.C.R. 772 (*Mattel*). Where new evidence had been adduced before the Federal Court but not found relevant, the applicable standard of review was determined to be reasonableness *simpliciter*. However, Justice Binnie noted a different standard of review would apply where fresh relevant evidence was adduced in an appeal before the Federal Court at para. 35:

Where fresh evidence is admitted, it may, depending on its nature, put quite a different light on the record that was before the Board, and thus require the applications judge to proceed more by way of a fresh hearing on an extended record than a simple appeal (*PhilipMorris Inc. v. Imperial Tobacco Ltd. (No. 1)* (1987), 17 C.P.R. (3d) 289 (F.C.A.)). Section 56 suggests a legislative intent that there be a full reconsideration not only of legal points but also of issues of fact and mixed fact and law, including the likelihood of confusion. See generally *Molson Breweries v. John Labatt Ltd.*, [2000] 3 F.C. 145 (C.A.), at paras. 46-51; *Novopharm Ltd. v. Bayer Inc.* (2000), 9 C.P.R. (4th) 304 (F.C.A.), at para. 4, and *Garbo Creations Inc. v. Harriet Brown & Co.* (1999), 3 C.P.R. (4th) 224 (F.C.T.D.).

[13] In *Molson Breweries v John Labatt Ltd.*, [2000] 3 F.C. 145 (C.A.), (*Molson Breweries v John Labatt Ltd.*) Justice Rothstein (now of the Supreme Court of Canada) stated the following at paras 46 and 51:

Because of the opportunity to adduce additional evidence, section 56 is not a customary appeal provision in which an appellate court decides the appeal on the basis of the record before the court whose decision is being appealed. A customary appeal is not precluded if no additional evidence is adduced, but it is not restricted in that manner. Nor is the appeal a "trial de novo" in the strict sense of that term. The normal use of that term is in reference to a trial in which an entirely new record is created, as if there had been no trial in the first instance. Indeed, in a trial de novo, the case is to be decided only on the new record and without regard to the evidence adduced in prior proceedings.

...

I think the approach in *Benson & Hedges v. St. Regis* and in *McDonald v. Silcorp* are consistent with the modern approach to standard of review. Even though there is an express appeal provision in the Trade-marks Act to the Federal Court, expertise on the part of the Registrar has been recognized as requiring some deference. Having regard to the Registrar's expertise, in the absence of additional evidence adduced in the Trial Division, I am of the opinion that decisions of the Registrar, whether of fact, law or discretion, within his area of expertise, are to be reviewed on a standard of reasonableness *simpliciter*. However, where additional evidence is adduced in the Trial Division that would have materially affected the Registrar's findings of fact or the exercise of his discretion, the Trial Division judge must come to his or her own conclusion as to the correctness of the Registrar's decision. (emphasis added)

[14] In *Maison Cousin (1980) Inc. v Cousins Submarines Inc.*, 2006 FCA 409, (2006) 60 C.P.R.(4th) 369 (*Maison Cousin*) decided after the *Mattel* decision, the Federal Court of Appeal called for a *de novo* review in appeal where substantial new relevant evidence is adduced before the Federal Court at paras 4 and 7:



The appellant appealed this decision before the Federal Court. Alerted by the comments of the Registrar's delegate about the flimsy evidence it had in support of its opposition, the appellant invoked its right under subsection 56(5) to supplement the evidence on record. It submitted new evidence. The judge analyzed this new evidence on the basis of the standard of review. He concluded that it was sufficiently significant and probative and that he had to apply the standard of correctness. In doing so, the judge unduly restricted his discretion to intervene, in our view, because having noted the significance and probative value of the new evidence, he was no longer called on to review the decision of the registrar's delegate, but rather to decide the issue on the merits based on the evidence before him.

...

The judge deciding the issue *de novo* may intervene without having to identify any error committed by the delegate and is not obliged to defer to the delegate's decision. The judge must decide the issue on the basis of the evidence before him or her and the applicable legal principles. (emphasis added)

[15] The approach in *Maison Cousin* was applied in a subsequent decision of the Federal Court of Appeal in *Shell Canada Ltd. v P.T. Sari Incofood Corp*, 2008 FCA 279, [2008] 380 N.R. 317.

[16] Justice Mainville (now of the Federal Court of Appeal) made an extensive survey of this question in his judgment in *Advance Magazine Publishers, Inc. v Wise Gourmet*, 2009 FC 1208, [2009] 356 F.T.R. 270. He found the appropriate standard of review with respect to whether there would confusion between marks depended on whether or not parties submitted new evidence to the Court. Justice Mainville concluded that the question of whether or not new evidence was substantial and would have materially affected the Registrar's decision must precede the analysis of the issue raised on the appeal.

[17] In the foregoing cases, the issue on appeal involved the likelihood of confusion between trade-marks. In my view, the same approach is appropriate to the question of appeal on whether a trade-mark is a clearly descriptive mark as contemplated in paragraph 12(1)(b) of the *Act*. Both issues involve consideration of the mark itself, interpretation of the mark involved, assessment of the public impression the mark creates, and its effect on other enterprises in the same or related areas of commerce.

[18] During the first seven years of this application, the applicant provided very limited arguments and almost no evidence to the Registrar in support of its position. In its response on February 29, 2004, the applicant presented the argument that the mark is:

the plural term used to describe one who instructs or teaches others. The apostrophe signifies something belonging to those that teach others. The word TEACHERS' therefore does not describe, or deceptively misdescribe pension fund services, nor does it describe or deceptively misdescribe pension fund services for teachers.

[19] On March 9, 2005, the applicant submitted a three page argument which presented case law in reference to section 12(1)(b) of the *Act*, a dictionary definition of the word "teacher" from [www.dictionary.com](http://www.dictionary.com), and reference to the CIPO Trade-mark Database for applications containing the beneficiary of the applicant's service as part of the trademark.

[20] Now, on appeal, it provides three volumes of evidence contained in two substantial affidavits in support of its appeal. It is the applicant's right pursuant to subsection 56(5) of the *Act* to submit new evidence on appeal.

[21] If, on the one hand, this evidence could not have materially affected the Registrar's decision, then the standard of the appeal review is reasonableness. If, on the other hand, the evidence could have materially affected the Registrar's decision, then the appeal is *de novo* based on the record before the Registrar as well as the new evidence and all findings of fact, law and discretion are under consideration: *Molson Breweries v John Labatt Ltd.*

[22] The new evidence tendered before the Court is principally contained in two affidavits. Affiant Elenita Anastacio is an experienced trade-mark searcher for the firm representing the applicant. Deborah Allan is the director of Communications and Media Relations for the applicant.

[23] Much of Ms. Allan's evidence demonstrates use of the mark TEACHERS' in public communications from the applicant including press releases and annual reports. The thrust of Ms. Allan's affidavit is to demonstrate that a significant number of Canadians have been exposed to the use of the trade-mark TEACHERS'. The use of the mark TEACHERS' by the applicant is not the most relevant evidence when inquiring into whether or not the mark is clearly descriptive. However, it is noteworthy that the exhibits attached to Ms. Allan's affidavit in one way or another make express reference to the pension plan for teachers.

[24] The evidence of Ms. Anastacio illustrates examples where marks have been registered that are descriptive of the group targeted, but not of the service offered. For example, the affiant provides the following marks have been registered:

“Great Teachers” was registered to The Teaching Company to be used in offering audio visual media on a variety of academic topics like history, literature science.

“Instant Firefighter” was registered to Firebusters Inc. for sprinkler systems.

“Principal” was registered to Principal Financial Services Inc. for financial and investment services.

“Professor Go Metric” was registered for advertising and promotional materials respecting conversion to the metric system. In that case, the exclusive use of the words Go and Metric was disclaimed.

“Professor Perfecto” was registered to Canada Post Corporation for the operation of a stamp collector’s club.

“Professors House” was registered for online information and resources relating home, gardening and general topics concerning lifestyle and quality of life.

“Relating to the Athlete in You” was registered (and subsequently expunged several years later for non-use) for financial services.

“The Wealthy Doctor” was registered for conducting business seminars on financial planning.

“Video Professor” was registered for computer training services over audio-visual media. The registrant disclaimed the exclusive use of the word video.

[25] Ms. Anastacio’s affidavit includes a list of marks advertised, opposed, rejected, expunged, allowed and registered in association with pension fund and pension plan services. The list is lengthy, but registered mark number 10 in the list stands out: “Business People Buying Businesses.” It is perhaps so generic that it is not “clearly descriptive”. In contrast, item number 42, “The Retired Teachers of Ontario”, was opposed and not registered, presumably for giving rise to a likelihood of confusion.

[26] Ms. Anastacio’s affidavit provides a similar lists of marks associated with benefit plans and retirement plans. In addition, it also provides dictionary definitions for the words “teacher” and

“professor”. Given the readily ascertainable meaning of the word ‘teacher’, and of its plural possessive, the meaning of the proposed trade-mark itself is not at issue.

[27] This new evidence filed by the applicant does have sufficient bearing on the question of whether or not the trade-mark in question, TEACHERS’, is clearly descriptive or misdescriptive as contemplated in paragraph 12(1)(b) of the *Act*. The evidence may or may not be determinative of the issue but it does require consideration anew of the application of paragraph 12(1)(b) of the *Act*.

[28] I conclude the appeal should receive consideration of this matter on the whole of the evidence. In doing so, I need not identify any error made by the Registrar nor am I obligated to defer to the Registrar’s decision (*Maison Cousin*).

#### *Applicant’s Submissions*

[29] The applicant relies on *Thomas J. Lipton, Limited v Salada Foods Ltd.*, [1980] 1 F.C. 740 (T.D.) (*Lipton*) at paras 5 and 6 to support the proposition that whether a mark is clearly descriptive is a question of fact to be determined judicially. Both the evidence and common sense are relevant to the decision maker considering whether a mark is clearly descriptive.

[30] The applicant contends that on first impression, the mark TEACHERS’ is not “clearly descriptive” of the services associated to its use. It relies on *Oshawa Group Ltd. v Canada (Registrar of Trade Marks)*, [1981] 2 F.C. 18, 46 C.P.R. (2d) 145 (T.D.) at para. 11 which reads:

...the decision that a trade mark is clearly descriptive is one of first impression from which it follows that it is not the proper approach to critically analyze the words of the mark but rather to ascertain the

immediate impression created by the mark in association with the services proffered." (applicant's emphasis)

[31] The applicant stresses that the adjective employed in paragraph 12(1)(b) of the *Act*, the term "clearly", is an essential element in determining whether a descriptive mark offends the statutory prohibition in the *Act* against registration. The applicant refers to *Lipton* as support for this requirement. Paragraph 9 of *Lipton* reads:

Even a "specific descriptive suggestion or implication" or "a clear implication or suggestion" that a mark is descriptive or misdescriptive is not sufficient to disqualify it for registration under section 12(1)(b). That enactment admits of no mere implication or suggestion. Parliament used the word "clearly" before the word "descriptive" and "deceptively" before the word "misdescriptive" and the Registrar has made no finding that the word was either clearly descriptive or deceptively misdescriptive. As to whether a mere suggestive description suffices, one might refer to a decision of the former Exchequer Court of Canada in the case of *Kellogg Company of Canada Limited v. The Registrar of Trade Marks*. (applicant's emphasis)

[32] The applicant reviews the CIPO's reasoning set out in the various exchanges for its rejection. The CIPO examiners considered that the mark clearly described that the applicant's services were a pension fund for teachers and that this was further established by the use of the apostrophe which indicates possession of the plan.

[33] The applicant argues the Registrar has confused the intended users of the plan as being the same as a particular character of the service. It points to a finding by the Trade Marks Opposition Board in *Faber-Castell Canada Inc. v Binney & Smith Inc.*, (1991), 36 C.P.R. (3d) 388 where the board finds the use of the phrase "MY FIRST" in relation to wares for children. The Board found describing the intended consumers does not offend paragraph 12(1)(b) stating: "...the fact that the

trademark MY FIRST may indicate that the applied for wares are for young children does not establish that the mark offends section 12(1)(b) of the *Act*...The mark does not, in my view, describe any particular character or quality of the applied for wares.”

[34] The applicant argues the Registrar was wrong to deduce the intended target of services is inherently a characteristic of that service because, it submits, the Registrar had misread the authority it was relying on. Instead, the applicant argues that there is a difference between those who are providing the service described and those who are targeted by it. It submits that TEACHERS’ describes the people who will use the service, rather than the financial planners or tax planners who deliver the service.

[35] The applicant adds that the Registrar’s finding TEACHERS’ is an “apt trade term” is also wrong. It argues there is no relationship between TEACHERS’ as a trade-mark and the services of financial planning in general: “There is absolutely **no** evidence that ‘TEACHERS or TEACHERS’ are common to the trade or would put competitors at an undue advantage” (emphasis by applicant). It notes that the evidence of Ms. Anastacio establishes that existing trade-marks used in connection with financial planning, pension fund and benefit plan very rarely use the word TEACHERS or TEACHERS’.

[36] The applicant returns to this theme of “services” throughout its submissions: the trade-mark concerns “services” which involve administration, management and investment of funds. It says these services are not provided by teachers. Instead, teachers are the possible end consumers of such

services. The applicant says the mark is not clearly descriptive of services provided as describe by paragraph 12(1)(b).

[37] The applicant traces the variations in wording used by different CIPO examiners and contends that the examiners miss the point that, to offend paragraph 12(1)(b), the mark must clearly describe the services and not the persons who may avail themselves of the services. It points out that the mark TEACHERS' does not clearly describes the persons who are "employed or engaged in the provision" of the services of "administration of a pension plan, management and investment of a pension fund for teachers in Ontario".

#### *Consideration of the Proposed Trade-Mark in Context*

[38] The applicant carefully skirts around the elephant in the room - the pension fund itself.

[39] The applicant is the Ontario Teachers' Pension Plan Board. Its staff is the financial managers who administer, manage and invest a very large pension fund, the pension fund of Ontario teachers. The Ontario teachers may be described as the possible end consumers of the financial services provided by the financial managers of the Ontario Teachers' Pension Plan Board. The teachers of Ontario, working or retired, may also be described as the beneficial owners of the pension fund itself. In addition, the various enterprises which seek to have the pension funds invested in their ventures may also be described as possible consumers

#### *Clearly Descriptive*

[40] Paragraph 12(1)(b) of the *Act* uses the term "clearly descriptive" in relation to several aspects concerning the use of a proposed trade-mark, namely:



- the wares or services in association with which it is used or proposed to be used, or
- the conditions of or the persons employed in their production or of their place of origin.

[41] I agree with the applicant's submission that TEACHERS' does not clearly describe the services provided. Nor do I consider the proposed trade-mark to describe the conditions of or the persons employed in their production or of their place of origin.

[42] However, the use of the phrase "wares or services" requires consideration of something more than just services. In my view the pension fund comes within the broader subject matter encompassed by the phrase "wares or services".

#### *Context*

[43] A proposed trade-mark is to be considered in context. Paragraph 12(1)(b) specifically sets out that "wares or services" are to be considered "in association with which the proposed trade-mark is used or proposed to be used." As Justice Cattanach stated in *Molson Companies Limited*, "the mark must be considered in conjunction with the wares and not in isolation ..." As I noted earlier, the applicant's evidence listing examples of its actual use of the proposed trade-mark invariably made reference to the pension plan within the examples provided.

[44] I conclude TEACHERS' is to be considered in the context of a pension fund, in particular, the Ontario teachers' pension fund.

*Wares or Services*

[45] In my view, one may consider the meaning of the phrase ‘wares or services’ in subsection 12(1)(b) of the *Act* rather than just wares or just services. Wares are usually regarded as the articles of merchandise or manufacture while services may be understood as involving activities benefiting another. However, I do not think it was Parliament’s intention to exclude the various forms of financial funds from the application of subsection 12(1)(b) as being neither merchandise nor services. Indeed, I note with some interest although not in reliance, that the Shorter Oxford English Dictionary Third Edition includes an obscure definition of ‘ware’ as “invest (money)”. I should think that Parliament in referring to “wares or services” intended including commercial financial funds in that broad area of commerce which is the subject matter of the *Act*.

*Characteristic*

[46] Paragraph 12(1)(b) of the *Act* also refers to “the character or quality” of the wares or services. The word “character” does not necessarily completely describe the wares or services rather; it describes a distinguishing or prominent feature of wares or services. In *Café Suprême F et P Ltée v Canada (Register of Trade Marks)*, [1984] 3 C.I.P.R. 201, 4 C.P.R. (3d) 529 (F.C.T.D.) (*Café Suprême F et P Ltée*) Justice Dubé stated:

That is, while the mark “Café Suprême” is clearly descriptive of the character of the services provided, it should be borne in mind that the adverb “clearly” is not synonymous here with accurately, but with apparently, in a manner capable of being readily understood. The word “character” here means the distinguishing or special feature of the product or services. (emphasis added)

[47] This was reiterated by Madame Justice Tremblay-Lamer in *ITV Technologies Inc. v WIC Television Ltd.*, 2003 FC 1056 where she stated in para. 67:

With regard to ITV Technologies’ first ground, in order for a mark to be clearly descriptive, pursuant to paragraph 12(1)(b), it must be more than merely suggestive of the character or quality of the wares or services in association with which it is used or proposed to be used. The descriptive character must go to the material composition of the goods or services or refer to an obvious intrinsic quality of the goods or services which are the subject of the trade mark, such as a feature, trait or characteristic belonging to the product in itself (*Proviensano v. Registrar of Trade-Marks* (1977), 37 C.P.R. (2d) 189.)

(emphasis added)

I take from the foregoing that a proposed trade-mark that clearly describes a prominent characteristic of the wares or services will come within the prohibition against registration in paragraph 12(1)(b).

#### *Common Sense*

[48] In *Neptune S.A. v Canada (Attorney General)*, 2003 FCT 715 (*Neptune S.A.*), Justice Martineau stated that the decision maker must not only consider the evidence at his or her disposal but also common sense in the assessment of the facts. Therefore, in assessing the validity of a proposed trade-mark, one must consider not only the evidence but have regard to common sense. Moreover, the decision that the trade-mark is clearly descriptive is to be based on the initial impression having regard to the wares or services in question: *Neptune S.A.*

[49] When one thinks of a pension fund, one is just as likely, or more likely, to think of the pensioner or prospective pensioner than the administrator or the manager. That is, one would more readily think of whom the pension plan is for, in this case the teachers, rather than who the pension fund is administered by, the financial managers. Certainly, the people described by the applicant as

the possible end consumers of the services it provides, the Ontario teachers, would readily consider, on first impression, the proposed trade-mark as describing their pension fund.

[50] In my view, the first impression created by the proposed trade-mark, TEACHERS', considering the context of a pension plan, the pension fund itself and the services provided by the applicant, is that the proposed trade-mark describes a prominent characteristic of a pension fund for teachers and is caught by subsection 12(1)(b) as being clearly descriptive even though it does not describe the administration, management or investment of the pension funds in question.

### **Conclusion**

[51] The fundamental objective of paragraph 12(1)(b) is to prevent a monopoly on the use of a word common to others providing a similar service: *General Motors Corp. v Bellows*. The applicant administers, manages and invests a pension fund for Ontario teachers. However, the scope of the proposed trade-mark is national. There are teachers in other provinces and territories who, no doubt, have pension plans. There are also other groups of teachers in private schools or institutional settings within Ontario that are not necessarily included. They too likely have pension plans or other specialized financial funds.

[52] It is no answer for the applicant to say that there is no evidence in this regard since it is evidence that one would not expect to be forthcoming from the applicant in pursuit of registering its trade-mark. On this point, I consider I may rely on the knowledge and expertise of the Registrar of Trade-marks who stated:

It is my position that the word TEACHERS', being the phonetic equivalent of TEACHERS, is an apt trade term for describing the

intrinsic character of the administration, management and investment of a plan/fund for teachers and as such should be left available for others to use since descriptive words are the property of all and cannot be appropriated by one person for their exclusive use.  
(emphasis added)

The applicant has not provided any evidence to displace the conclusion by the Registrar that term ‘teachers’, whether possessive or plural, should be left available for others to also make use of the term.

[53] I conclude the trade-mark in question, the word TEACHERS’ in its plural and possessive form, is a distinguishing feature, and therefore the character, of this pension plan because it is a pension plan exclusively for teachers. It clearly describes a prominent characteristic of the wares or services provided. Providing the applicant with a monopoly on the use of this word would prevent other pension or financial services targeted to or belonging to teachers within Ontario or in other provinces and territories from using the term.

[54] In result, notwithstanding the new evidence submitted, I come to the same conclusion as the Registrar. The Registrar was correct to find the mark TEACHERS’ is unregistrable pursuant to paragraph 12(1)(b) of the *Act*.

[55] The appeal is dismissed.

#### *Costs*

[56] The applicant sought an order for costs. Since the applicant is unsuccessful, I do not make any order of costs in favour of the applicant.

[57] On the other hand, the Registrar serves in an official function in making determinations pursuant to the *Act* with respect to trade-mark applications. The Respondent has not responded on behalf of the Registrar to oppose this appeal and has not incurred costs in this regard.

[58] Accordingly I do not make any order as to costs.

**JUDGMENT**

**THIS COURT ORDERS AND ADJUDGES that:**

1. The appeal is dismissed.
2. No order for costs is made.

“Leonard S. Mandamin”

Judge

**FEDERAL COURT**  
**SOLICITORS OF RECORD**

**DOCKET:** T-1091-09

**STYLE OF CAUSE:** ONTARIO TEACHERS' PENSION PLAN BOARD v.  
THE ATTORNEY GENERAL OF CANADA

**PLACE OF HEARING:** TORONTO, ONTARIO

**DATE OF HEARING:** MAY 10, 2010

**REASONS FOR JUDGMENT  
AND JUDGMENT:** MANDAMIN J.

**DATED:** JANUARY 18, 2011

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