



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2010 TMOB 152
Date of Decision: 2010-09-29

**IN THE MATTER OF AN OPPOSITION by
BFS BRANDS, LLC to application
No. 1,263,672 for the trade-mark WORLD'S
TOUGHEST OFF-ROAD TIRES in the name
of MICHELIN RECHERCHE ET
TECHNIQUE S.A.**

[1] On July 6, 2005, MICHELIN RECHERCHE ET TECHNIQUE S.A. (the Applicant) filed an application to register the trade-mark WORLD'S TOUGHEST OFF-ROAD TIRES (the Mark) based on proposed use of the Mark in Canada in association with: [Translation] "tires and tubes for vehicle wheels; tire treads for retreading tires; tracks for tracked vehicles" (the Wares).

[2] The application was later amended to disclaim the right to the exclusive use of the phrase TOUGHEST OFF-ROAD TIRES apart from the trade-mark.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of July 12, 2006.

[4] On December 12, 2006, BFS BRANDS, LLC (the Opponent) filed a statement of opposition against the application. The Applicant filed and served a counter statement, in which it denies the Opponent's allegations.

[5] The Opponent's evidence consists of the affidavit of Kimberley Broome. The Applicant filed as it evidence the statutory declaration of Claire Cébron, and a certified copy of application No. 1,263,673.

[6] Both parties requested and were ably represented at a hearing.

Statement of Opposition

[7] The grounds of opposition are summarized as follows:

Section 38(2)(a)

The application does not comply with the requirements of s. 30 of the *Trade-marks Act*, R.S.C. 1985, c.T-13 (the Act) in that the Applicant could not have been satisfied that it is entitled to use the Mark in Canada in association with the Wares described in the application, since at the date of filing of the application the Mark is not, and cannot be, a "trade-mark" as defined in s. 2 of the Act. The Mark is a descriptive term which should be available to others for use in association with "tires and tubes for vehicle wheels; tire treads for retreading tires; tracks for tracked vehicles", and cannot be the subject of exclusive trade-mark rights.

Section 38(2)(b)

The Mark, WORLD'S TOUGHEST OFF-ROAD TIRES, is not registrable, having regard to the provisions of s. 12(1)(b) of the Act, on the ground that the alleged trade-mark is clearly descriptive or deceptively misdescriptive in the English language of the nature or character of the Wares in association with which it is proposed to be used.

Section 38(2)(d)

The Mark is not distinctive, within the meaning of s. 2 of the Act, by reason of the fact that the Mark does not actually distinguish and is not adapted to distinguish the Wares in association with which it is proposed to be used by the Applicant from the wares of others, including the Opponent.

Main Issue

[8] The determinative issue in this proceeding is defined by the second ground of opposition, that is, is the Mark, clearly descriptive or deceptively misdescriptive in the English language of the character or quality of the Wares. The material date that applies

to a ground of opposition based on s. 12(1)(b) of the Act is the filing date of the application [see *Fiesta Barbecues Ltd. v. General Housewares Corp.* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)].

[9] With respect to this ground, the legal burden is upon the Applicant to show that its Mark is registrable. However, there is an initial evidential burden on the Opponent to adduce sufficient evidence which would support its allegation that the Mark is clearly descriptive or deceptively misdescriptive of the Wares. In this respect the Opponent has relied on the Broome affidavit which introduces into evidence printouts from the *Oxford English Dictionary* online website for the words “world”, “tough”, “off-road” and “tire”.

[10] The Broome affidavit also serves to introduce into evidence third party use of phrases such as “world’s toughest...” and “world’s toughest tire” to describe wares related thereto (Broome affidavit Exhibits E through P and Exhibits S and T). However, as most of these websites are not dated, I can only draw the conclusion that they were in existence on the day the search was conducted, namely August 29, 2007. As this search postdates the material date by a significant length of time, I am not prepared to infer that these websites were in existence at the relevant date. Accordingly, this evidence will only be afforded very minimal weight.

[11] As for the evidence pertaining to the dictionary definitions, the Applicant argues that one must bear in mind the date of dictionaries vis-à-vis the material date respecting the ground in order to assess the relevancy of any proffered dictionary definitions. In this regard the Applicant directs my attention to discrepancies between the “edition date (1989)” and “Draft Entry date (2004)” of these definitions and their respective copyright date (2007), submitting that it is not clear whether or not these words were only updated in the 2007 versions, thus beyond the material date. Although the Applicant’s argument is not without merit, I wish to point out that I am entitled to take judicial notice of dictionary definitions [see *Yahoo! Inc. v. audible.ca inc.* (2009), 76 C.P.R. (4th) 222 (T.M.O.B.)] and having consulted the *Oxford Dictionary of the English Language*, second edition and copyright date of 2004, I confirm that all of the words in the Mark are therein defined. Accordingly, I am satisfied that the Opponent has met its initial burden

respecting this ground. The legal onus is thus upon the Applicant to show that its Mark is registrable.

[12] The statutory section which deals with this ground is s. 12 (1)(b) of the Act and reads as follows:

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 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 [...]

[13] The issue as to whether WORLD'S TOUGHEST OFF-ROAD TIRES is clearly descriptive or deceptively misdescriptive of "tires and tubes for vehicle wheels; tire treads for retreading tires; tracks for tracked vehicles" must be considered from the point of view of the average consumer of those wares. Further, in determining whether the Mark is clearly descriptive of the Applicant's Wares, it must not be dissected into its component elements and carefully analysed, but rather must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd. v. Canada (Registrar of Trade Marks)* (1978), 40 C.P.R. (2d) 25 (F.C. T.D.); *Atlantic Promotions Inc. v. Canada (Registrar of Trade Marks)* (1984), 2 C.P.R. (3d) 183 (F.C.T.D.)]. Character means a feature, trait or characteristic of the wares and "clearly" means "easy to understand, self-evident or plain" [see *Drackett Co. v. American Home Products Corp.* (1968), 55 C.P.R. 29 (Can. Ex. Ct.)].

[14] In the present case the Applicant has disclaimed the phrase TOUGHEST OFF-ROAD TIRES. Having regard to the dictionary definitions, I am of the view that these combined words are clearly descriptive of the character and quality of the Applicant's Wares. I can reach no other conclusion, particularly since I consider each of the words to be commonly known. The plain and ordinary meaning of this portion of the Mark to the average English speaking consumer of the tires and related wares is that they are the

toughest off-road tires. The question then becomes whether the addition of the term WORLD'S to this phrase, renders the Mark as a whole not clearly descriptive.

[15] The Applicant argues that the addition of the term WORLD'S removes the clearly descriptive aspect of the Mark particularly when viewed in its entirety, stating that reference to the term WORLD'S is simply suggestive of the place where the Wares could eventually be made available. Furthermore, the Applicant adds that the reference to the term WORLD'S is not an inherent characteristic of the Applicant's Wares, removing it from the realm of clearly descriptiveness. It also points to a number of third party registrations which it claims are similar to the Mark and which include the term WORLD'S.

[16] On the other hand the Opponent argues that the superlative adjective TOUGHEST is intended to convey the specific quality of the Wares and that WORLD'S only serves to define the scope of the claim of superlative character.

[17] I agree with the Opponent. I consider that WORLD'S must be read in conjunction with the superlative adjective TOUGHEST which together, in my view, form a laudatory epithet. There are a number of decisions in which the Federal Court has concluded or commented on the fact that words or prefixes having a laudatory connotation are *prima facie* descriptive terms [see *Mitel Corp. v. Canada (Registrar of Trade Marks)* (1984), 79 C.P.R. (2d) 202 (F.C.T.D.); *Molson Cos. v. John Labatt Ltd.* (1981), 58 C.P.R. (2d) 157 (F.C.T.D.); *Imperial Tobacco Ltd. v. Benson & Hedges (Canada) Inc.* (1983), 75 C.P.R. (2d) 115 (F.C.T.D.); *Cafe Supreme F. & P. Ltée c. Canada (Sous-procureur général)* (1984), 4 C.P.R. (3d) 529 (F.C.T.D.)] Having regard to these decisions, it is clear that trade-marks consisting solely of laudatory epithets which qualify clearly descriptive terms offend the provisions of s. 12(1)(b) of the Act.

[18] The purpose of s. 12(1)(b) was aptly set out by Justice Cattanach in *GWG Ltd. v. Canada (Registrar of Trade-marks)* (1981), 55 C.P.R. (2d) (F.C.T.D.) where he quotes from the decision in *Eastman Photographic Materials Co. Ltd. v. Comptroller-General of Patents, Designs & Trade-Mark* [1898] A.C. 571, as follows:

... any word in the English language may serve as a trade-mark - the commonest word in the language might be employed. In these circumstances it would obviously have been out of the question to permit a person by registering a trade-mark in respect of a particular class of goods to obtain a monopoly of the use of a word having reference to the character or quality of these goods. The vocabulary of the English language is common property: it belongs alike to all; and no one ought to be permitted to prevent the other members of the community from using for purposes of description a word which has reference to the character or quality of goods.

If, then, the use of every word in the language was to be permitted as a trade-mark, it was surely essential to prevent its use as a trade-mark where such use would deprive the rest of the community of the right which they possessed to employ that word for the purpose of describing the character or quality of goods.

[19] As was stated in *General Motors Corps. v. Bellows* (1949), 10 C.P.R. 101 (S.C.C.) "...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".

[20] It is also recalled that the test for clearly descriptiveness of a trade-mark must be considered from the point of view of the average consumer of those wares as a matter of immediate impression. Furthermore, the Registrar must not only consider the evidence but also apply common sense to the assessment of the facts in light of the wares in question [see *Neptune S.A. v. Canada (A.G.)* (2003), 29 C.P.R. (4th) 497].

[21] Bearing these principles in mind and for the reasons previously discussed, I am not persuaded that the addition of the term WORLD'S removes the Mark from the realm of clearly descriptiveness. To view it otherwise would allow the Applicant to circumvent the prohibition of s. 12(1)(b) of the Act. Clearly descriptive words should remain the common property of dealers and the public generally and no person or corporation should be granted the exclusive right to or a monopoly in the use of such words as it would place legitimate competition at an undue disadvantage.

[22] I have also considered the Applicant's state of the register evidence of third party registrations which it claims are similar to the Mark and which include the term WORLD'S (Cébron statutory declaration).

[23] To counter this argument, the Opponent points to several deficiencies in the Applicant's evidence which distinguish many of the marks identified in the Cébron statutory declaration. For instance, some of these marks cannot be said to be clearly descriptive as the wares and services are unrelated to the trade-marks. Other marks include design elements or additional registrable reading matter distinguishing them from the Mark.

[24] This leaves 14 registrations which are arguably similar in structure to the Mark. I note however that one of these registrations has since been expunged, and three of which fell within the exception provided in s. 14 of the Act, leaving 10 relevant marks. The Applicant argues that in view of the acceptance of the registration in these cases, the rejection of the present application would result in an unexplained inconsistency on the register citing in support of this proposition *Rothmans, Benson & Hedges Inc. v. R.J. Reynolds Tobacco Co.* (1993), 47 C.P.R. (3d) 439 (F.C.T.D.). The facts in the present case can be distinguished from those in *Rothmans* where the Court found that although the trade-mark THE MILD ONE, for cigarette tobacco and cigarettes, included a descriptive term: MILD, the trade-mark as a whole appeared to be distinctive, as were the other similar marks on the register. In the present case, as I am of the view that the Mark as whole is clearly descriptive of the Applicant's Wares, the *Rothmans* case is of little assistance to the Applicant.

[25] Furthermore, regarding these 10 registrations which are arguably similar in structure to the Mark, the Opponent submits that each application for registration of a trade-mark in Canada is decided on its own merits and, in the case of opposed applications, the specific evidence of record in an opposition proceeding. I agree and I would further note that eight of these registrations were not the subject of an opposition, meaning that they were advertised following the examination stage pursuant to s. 37 of the Act. A decision of the Registrar at the examination stage to advertise a trade-mark for opposition is not a decision that the mark is registrable. Unlike the initial examination of an application before the Registrar, an opposition is an adversarial proceeding wherein the onus is on the Applicant to show that its mark is registrable [see *Thomas J. Lipton Inc. v. Boyd Coffee Co.* (1991), 40 C.P.R. (3d) 272 (T.M.O.B.)]. I do not know, nor do I

consider it appropriate to speculate on the conditions and circumstances in which these third party marks were allowed to be registered, as there may have been particular reasons in support of their registration [see *Proctor & Gamble Inc. v. Morlee Corp.* (1993), 48 C.P.R. (3d) 377 (T.M.O.B)]. Consequently, I have attached little importance to these prior registrations in assessing the question of registrability under s. 12(1)(b) of the Act.

[26] In the context of opposition proceedings, the onus of establishing that a trade-mark is registrable rests with the Applicant and in light of the foregoing, I find that the Applicant has not discharged its burden with respect to this ground. I am of the view that the phrase WORLD'S TOUGHEST OFF-ROAD TIRES clearly describes as a matter of first impression the Applicant's Wares "tires and tubes for vehicle wheels; tire treads for retreading tires; tracks for tracked vehicles" and consider it to be a laudatory description that is contrary to s. 12(1)(b) of the Act, particularly since the Mark is comprised of an ordinary grammatical phrase that others in the industry should be allowed to use to describe their products.

[27] Accordingly, this ground of opposition is successful.

Section 38(2)(d) / Distinctiveness

[28] The Opponent has pleaded that the Mark is not distinctive, within the meaning of s. 2 of the Act, by reason of the fact that the Mark does not actually distinguish and is not adapted to distinguish the Wares in association with which it is proposed to be used by the Applicant from the wares of others, including the Opponent.

[29] The material date with respect to a distinctiveness ground is the date of filing the statement of opposition, namely December 12, 2006 [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

[30] In *Canadian Council of Professional Engineers v. APA- The Engineered Wood Assn.* (2002), 7 C.P.R. (4th) 239 (F.C.T.D.) Mr. Justice O'Keefe stated, "a purely descriptive or a deceptively misdescriptive trade-mark is necessarily not distinctive".

Therefore based on my earlier finding that the Mark is clearly descriptive, I conclude that the Mark is also not inherently adapted to distinguish the Wares of the Applicant from similar wares of others.

[31] In addition, the application is based on proposed use, and the Applicant has not filed any evidence of use since the filing of its application, with the result that there is no basis on which to conclude that as of December 12, 2006 the Mark had acquired sufficient distinctiveness in Canada as to result in it actually distinguishing the Applicant's Wares.

[32] Accordingly, this ground of opposition succeeds.

[33] Having already determined that the Opponent is successful on two grounds, it is not necessary to discuss the remaining ground of opposition.

Disposition

[34] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

Lynne Pelletier
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office