1960
June 6-9
1964
June 18

BETWEEN:

ELGIN HANDLES LIMITED ..... APPLICANT;

AND

WELLAND VALE MANUFACTURING COMPANY LIMITED } RESPONDENT.

Trade Marks—Trade Marks Act, S. C 1952-53, c. 49, ss. 2(t), 29(h) and 56—Application to strike out entry in register—Functional use or characteristic—Whether consequence of functional process can be a trade mark.

This is an application made by way of originating notice of motion for an order that the entry in the register of the respondent's trade mark relating to fire hardened wooden tool handles be struck out on the grounds, *inter alia,* that the subject matter of the entry is not a trade mark within the statutory definition.

Held: That section 56 of the *Trade Marks Act* confers jurisdiction on the Court to make an order that an entry in the register be struck out on the ground that what is registered is not a trade mark.

2 That since the description of the "mark" included in the entry in the register describes the "mark" as consisting "of the accentuation in darker colouring of the grain of the wood of tool handles the surface of which has been fire hardened to accomplish such purpose", the "mark" is not the tool handle but the accentuation in darker colouring of the grain of the wood of the handle when such is accomplished by the process of fire hardening.

3 That a process that is believed by those in the trade to improve an article is just as functional for commercial purposes as one that creates improvements according to some absolute scientific test or standard

4 That the change in the appearance of the wood that is the ordinary consequence of fire hardening cannot be a trade mark, since the process of fire hardening is primarily designed to improve wooden handles as objects of commerce and has therefore a functional use or characteristic

ACTION to strike out a trade mark.

The action was heard by the Honourable Mr. Justice Cameron at Ottawa and retried by the Honourable the President.

W. L. Hayhurst for applicant.

Harold G. Fox, Q.C. and *D. F. Sim, Q.C.* for respondent.

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

JACKETT P. now (June 18, 1964) delivered the following judgment:

This is an application by way of originating notice of motion under section 56 of the *Trade Marks Act,* chapter 49

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of 1952-53, for an order that an entry in the register kept pursuant to section 26 of that Act be struck out.

The matter was argued before Cameron J. before his retirement. Thorson P. made an order, on February 13, 1964, for a new trial on the existing evidence and argument. I have retried the application on that evidence and argument pursuant to that order and I now deliver judgment accordingly.

Many questions were argued concerning the application of the *Trade Marks Act* to the facts of the matter but it is sufficient for the disposition thereof that I deal only with the question whether the subject matter of the entry in dispute is a "trade mark" within the statutory definition. I shall therefore refer only to so much of the statute and the facts as are necessary to deal with that question.

Before doing that, I should refer briefly to the Court's jurisdiction. Section 56 of the Act confers on the Court jurisdiction, *inter alia,* on an application such as this, to order that an entry in the register be struck out on the ground that the entry does not accurately express or define the existing rights of "the person appearing to be the registered owner of the mark". These words are not as apt as they might be to confer jurisdiction to order that an entry be struck out because what purports to be entered as a trade mark is not a trade mark. However, there can be no doubt that, if a person is registered as the owner of a trade mark when he does not own a trade mark, the entry clearly "does not accurately express or define" his "existing rights" and I am, therefore, of the view that section 56 confers jurisdiction to make the order sought on the ground that what is registered is not a trade mark. In any event, section 54 confers jurisdiction on the Court to entertain any proceeding for the enforcement of any remedy defined or conferred by the Act.

The statutory definition of "trade mark" is to be found in paragraph (*t*) of section 2 of the Act, which reads as follows:

> (*t*) "trade mark" means
>
> (i) a mark that is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others,

(ii) a certification mark,
(iii) a distinguishing guise, or
(iv) a proposed trade mark;

The entry in dispute is supported only under that part of sub-paragraph (i) that reads: "a mark that is used by a person for the purpose of distinguishing or so as to distinguish wares . . . manufactured . . . by him from those manufactured . . . by others".

Subsection (3) of section 58 provides that the proceedings on an application such as this shall be heard and determined summarily on evidence adduced by affidavit unless the Court otherwise directs. In this case, there was no direction for evidence other than affidavit evidence.

The entries in dispute are in the register as registration No. 104,424 in the name of the respondent. The initial entry consists of a picture of a wooden handle (appropriate for a hand tool such as a hammer) in which the grain of the wood can be seen, together with a description that reads:

> Consists of the accentuation in darker colouring of the grain of the wood of tool handles the surface of which has been fire hardened to accomplish such purpose.

It should be noted that, while paragraph (*h*) of section 29 of the *Trade Marks Act* requires that the application be accompanied by a "drawing of the trade mark", according to the description, the "mark" is not the handle a picture of which appears on the register, but is the "accentuation" in darker colouring "of the grain of the wood" of the handles in respect of which it was registered and then only when such accentuation is accomplished by a process whereby the surface of the wood is "fire hardened".

The applicant contended that this was not an entry of a trade mark at all and in support of that contention made several submissions. While I propose to refer only to one of those submissions, I must not be taken to have rejected any of the other submissions in support of that contention, nor indeed must I be taken to have rejected any of the applicant's several other contentions.

The submission of the applicant with which I propose to deal, as I understand it, is that something in, or in connection with, wares that has utility, whether ornamental or functional, cannot be a trade mark. Counsel for the applicant developed a very cogent argument, based on English and Canadian authorities, for this submission. Counsel for

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the respondent developed an argument for a contrary view based on an analysis of some of the same authorities. I am relieved of the necessity of reaching a conclusion based on that argument, because, in the meantime, the general principle involved has been settled by the Supreme Court of Canada.

In *Parke, Davis & Co. Ltd. v. Empire Laboratories Limited*[1], the Supreme Court of Canada dismissed an appeal from a decision of my brother Noël[2]. This decision establishes that that which has "a functional use or characteristic" cannot be a trade mark.

If, therefore, the subject matter of the entry in dispute falls within the principle so established, I must order that the entry be struck from the register.

The description of the mark on the register, as noted above, reads as follows:

> Consists of the accentuation in darker colouring of the grain of the wood of tool handles the surface of which has been fire hardened to accomplish such purpose

In my view, this may be paraphrased accurately as follows:

> Darker colouring of the grain of the wood of tool handles accomplished by fire hardening

Fire hardening (also called flame finishing, flame treating or fire tempering), according to the evidence, may be carried out by first passing a smooth sanded wooden handle through a flame so that the surface becomes slightly charred, then buffing or polishing the handle, and then dipping the handle in clear lacquer. This has the effect, among other things, of accentuating the grain of the wood. This happens because the dense parts of the grain (summer growth) do not char as rapidly as the soft parts (spring growth).

Fire hardening of wood, according to the evidence, was commonly believed in the trade to have many advantages of a functional character. In addition to being attractive, it was believed to have the advantage of reducing the moisture in the wood and hardening and sealing the surface and thus increasing the moisture resistance of the wood and decreasing its tendency to warp. Fire hardened handles have been advertised by manufacturers, including the respondent, as having advantages over handles not so processed, e.g.: "longer lasting", "pleasant to use", "removes all surface moisture", "thorough seasoning", "Surface stress is

[1] [1964] S C R 351 [2] [1964] Ex C R 399

relieved", "pores of the hickory are sealed", "more resilient and shock resistant", "scorched colour has high sales appeal", and "less fatigue". In particular, it might be mentioned that, on page 45 of the December 28, 1957 issue of "Hardware and Metal", there appears an advertisement of the respondent for "True Temper Fire Hardened Handles" in which the following appears:

FIRE SEALS OUT MOISTURE . . .

True Temper's exclusive Fire Hardening process locks out moisture, the enemy of all wood . ends harmful weather action adds more working life to the handle

FIRE GIVES OUTSTANDING APPEARANCE

True Temper Fire Hardened Handles sell on eye appeal alone The rich warm appearance makes it easy for you to sell your customers on the service features

FIRE MAKES TOOLS EASIER TO USE

These handles are smooth and stay smooth Grain does not raise Your customers can feel the difference

While there may be a large element of "puffing" in many of these claims, and while the advantages may to some extent exist only in the minds of the people in the trade, I am of the view that a process that is believed by those in the trade to improve an article is just as functional for commercial purposes as one that creates improvements according to some absolute scientific test or standard. In any event, fire hardening, whatever else it does, actually hardens the surface of the wood to a substantial extent.

I have therefore come to the conclusion on the evidence that the fire hardening process is primarily designed to improve wooden handles as objects of commerce and has therefore a functional use or characteristic. It follows that the change in the appearance of the wood that is the ordinary consequence of fire hardening cannot be a trade mark. If, as has been established by *Parke, Davis & Co. Ltd. v. Empire Laboratories Limited, supra,* the thing registered cannot be a trade mark if it has a functional use or characteristic, it follows, in my view, that, where a change in appearance of the goods in relation to which the alleged trade mark is to be used is the normal result of a process that has a functional use or characteristic, such a change in appearance cannot be a trade mark.

The application for an order striking the trade mark from the register is granted with costs.

Judgment accordingly.