

BETWEEN:

SHERWIN WILLIAMS COMPANY } APPELLANT;
OF CANADA, LIMITED..... }

1937
Sept. 30.
Oct. 7.

AND

THE COMMISSIONER OF PATENTS..RESPONDENT.

Trade-mark—"Semi-Lustre"—Descriptive word within the meaning of par. (c), ss. 1, s. 26 of the Unfair Competition Act.

Held: That the trade-mark *Semi-Lustre* is descriptive within the meaning of par. (c), ss. 1, s. 26, of the Unfair Competition Act.

APPEAL from the refusal of the Registrar of Trade-Marks to register the trade-mark "Semi-Lustre."

The motion was heard before the Honourable Mr. Justice Angers, at Ottawa.

W. J. Green for appellant.

W. P. J. O'Meara K.C. for respondent.

The facts are stated in the reasons for judgment.

ANGERS J., now (October 7, 1937) delivered the following judgment:

This is an appeal by Sherwin Williams Company of Canada, Limited from the refusal of the registrar under paragraph (c) of subsection (1) of section 26 of the Unfair Competition Act, 1932, to register the word mark "Semi-Lustre."

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The application for the trade-mark states (*inter alia*):

The mark of which registration is desired, is a word mark consisting of the following letters in the following grouping

Semi-Lustre

We have used the said mark in Canada since January, 1928, on wares ordinarily and commercially described by us as Paints and Enamels.

Such use by us has been principally in United States and Canada.

In addition to wares of the kind described, we are commercially concerned with wares ordinarily and commercially described as Paints, Varnishes and Enamels.

The registrar refused to register the mark on the ground that it was descriptive under the provisions of paragraph (c) of subsection (1) of section 26 and consequently not registrable.

Subsection (1) of section 26 of the Act reads in part as follows:

Subject as otherwise provided in this Act, a word mark shall be registrable if it

(a)

(b)

(c) is not, to an English or French speaking person, clearly descriptive or misdescriptive of the character or quality of the wares in connection with which it is proposed to be used, or of the conditions of, or the persons employed in, their production, or of their place of origin;

The word mark in question is a mere combination of two English words: "semi" and "lustre."

The word lustre is defined as follows:

In the Oxford Dictionary

1. the quality or condition of shining by reflected light; sheen, refulgence; gloss.

2. luminosity, brilliancy, bright light; luminous splendour.

In the Imperial Dictionary

brightness; splendour; gloss.

The word "semi" is defined thus:

In the Oxford Dictionary

1. compounded with adjs. and pples., with the meaning "half, partly, partially, to some extent."

2. compounded with sbs.: a. with nouns of action or condition, as semi-allegiance=partial, imperfect or incomplete allegiance; b. with descriptive sbs., as semi-acquaintance=one with whom one is partially acquainted.

In the Imperial Dictionary

a prefix signifying half; half of; in part; partially.

The words compounded with the prefix "semi" are numerous, the prefix being used in the sense of half, partial or partially, imperfect or imperfectly, incomplete or incompletely, according as it is used in conjunction with an adjective or a substantive.

The word "semi-lustre" indicates a partial or incomplete lustre or, if we take the substantives by which "lustre" is defined in the dictionaries, a partial or incomplete brightness, or gloss, or splendour, or sheen.

It was submitted on behalf of the appellant that the registrar had allowed the registration of certain word marks ("Flo-Glaze," "Satinamel," "Satin-Glo," "Semiplast") and that the word "Semi-Lustre" is no more descriptive of the quality or character of paints, varnishes and enamels than the word-marks aforesaid. I do not know the conditions and circumstances in which these word-marks were allowed to be registered; there may have been particular reasons in support of their registration. Assuming, however, that there were not, the fact that the registrar might have granted word-marks which were descriptive of the character or quality of the wares in connection with which they were supposed to be used cannot affect the validity or lack of validity of the present application. Supposing that the registrar may have erred on previous occasions, he is surely at liberty to amend!

It was urged on behalf of appellant that the word-mark "Semi-Lustre" was registered by the appellant in the United States Patent Office on August 3, 1926; with all due deference I may say that I do not feel bound by the decisions of the Commissioner of Patents of the United States.

It was also urged that the appellant has used the mark "Semi-Lustre" on wares ordinarily and commonly described as paints and enamels continuously in Canada since January, 1928, and for many years previous to that in other countries and that the said mark has become associated in the mind of the public with the products of the appellant. This, in my opinion, is no ground for an appeal against the decision of the Commissioner. If, really, the

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mark "Semi-Lustre" has become associated with the products of the appellant, the appellant may possibly have a recourse under section 29 of the Act.

See Kerly on Trade-Marks, 6th ed., pp. 39 and 209; Sebastian, Law of Trade-Marks, pp. 66 and 76; *Channell Limited et al. v. Rombough et al* (1); *Sears and Nichols Company v. Brakely* (2); *Ex parte Newton* (3); *Ex parte The De Long Hook and Eye Company* (4); *J. W. Windsor Limited v. Maritime Fish Corporation Limited* (5); *Lamont, Corliss & Company v. The Star Confectionery Company* (6); *Kops Brothers v. Dominion Corset Company* (7); *Bowker Fertilizer Company v. Gunns Limited* (8).

After careful consideration I have reached the conclusion that the word "Semi-Lustre" is descriptive within the meaning of paragraph (c) of subsection (1) of section 26 and that the registrar was right in refusing to register it.

For these reasons, the appeal must be dismissed.

This is a case where I believe that there should be no order as to costs.

Judgment accordingly.

(1) (1925) 1 D.L.R. 233.

(2) (1912) 180 Off. Gazette U.S.
 Patent Office, 882.

(3) (1910) 160 Off. Gazette U.S.
 Patent Office, 1037.

(4) (1907) 128 Off. Gazette U.S.
 Patent Office, 1291.

(5) (1926) Ex. C.R., 31.

(6) (1924) Ex. C.R. 147.

(7) (1913) 15 Ex. C.R., 18.

(8) (1916) 16 Ex. C.R., 520.