

Cautions Concerning Choosing a Descriptive Trade Mark

August 7, 2013

The Facts

Backrack Inc. filed an application for the trade mark BACKRACK based on use in Canada since at least 1989 in association with:

Pick-up truck racks, namely, headache racks designed to protect the cab and mount a variety of accessories, namely, light, antenna and toolbox brackets.

Distribution services in the field of automotive parts.

The Opposition

The application was opposed by STK, LLC a competitor of Backrack Inc., on the grounds that the mark was clearly descriptive of the character or quality of the wares applied for.

The Trade-marks Opposition Board allowed the application for the services but rejected it for the wares on the grounds it was clearly descriptive.

The hearing officer referred to the fact that there was no evidence of any dictionary definition for the term “backrack” as one word and found that the meaning of the term BACKRACK by itself, was not self-evident. However there was evidence that showed that the Applicant’s headache racks were designed to be installed at the back of the cab of a pick-up truck.

The hearing officer said the issue as to whether the mark was clearly descriptive of the character or quality of the wares must be considered from the point of view of the average purchaser of the wares. In this regard the following principles applied;

- a) “character” means a feature, trait or characteristic of the wares and “clearly” means “easy to understand, self-evident or plain”
- b) The mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression
- c) The purpose of the prohibition is to prevent any single trader from monopolizing a term that is clearly descriptive or common to the trade, and placing legitimate traders at a disadvantage.

The hearing officer said the word “rack” was clearly descriptive of the applied for wares. The question was whether the addition of the word “back” rendered the mark as a whole not clearly descriptive.

The hearing officer concluded that BACKRACK clearly described the Applicant’s rack as one for the back of the cab of one’s pick-up truck.

The Federal Court

Backrack Inc. appealed from this decision to the Federal Court. The judge agreed with the principles as stated by the board but said the hearing officer had proceeded contrary to the principle b) in that the mark had been dissected into its components and not considered in its entirety. As a result the decision was unreasonable leaving it open to the judge to decide this issue on the evidence.

The judge said the mark when considered on its own, as a matter of first impression, had a number of meanings beyond pick-up truck racks. As a result the mark was not clearly descriptive of the character or quality of pick-up truck racks and was registerable.

Some Cautions Concerning Choosing a Descriptive Trade Mark

For those who did not attend our recent seminar there are cautions about choosing this type of mark.

First, a registration can be more expensive to obtain as a result of the necessity of responding to examiners reports, the requirement in some cases of filing evidence to show acquired distinctiveness and responding to this type of opposition at the suit of competitors.

Second, there may future problems associated with the choice of this type of mark as opposed to a more unique mark. If it is anticipated the product may have a short life or the marketing budget is small individuals responsible for marketing may wish to use a descriptive mark which will quickly convey to consumers the benefits of the product. Unfortunately if the product is successfully introduced in association with such a mark it may be impossible to stop competitors from using similar marks on competing products.

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These comments are of a general nature and not intended to provide legal advice as individual situations will differ and should be discussed with a lawyer.