Federal Court

Cour fédérale

Date: 20101216

Docket: T-1097-09

Citation: 2010 FC 1296

Ottawa, Ontario, December 16, 2010

PRESENT: The Honourable Madam Justice Simpson

BETWEEN:

INTERACTIVE SPORTS TECHNOLOGIES INC.

Applicant

and

THE ATTORNEY GENERAL OF CANADA

Respondent

REASONS FOR JUDGMENT AND JUDGMENT

[1] Pursuant to section 56 of the *Trade-Marks Act*, R.S.C. 1985, c. T-13 (the Act), Interactive Sports Technologies Inc. (the Applicant) appeals a decision of the Registrar of Trade-marks (the Registrar) dated May 15, 2009 wherein she refused the Applicant's application no. 1,277,334 (the Application) for the registration of the trademark HIGH DEFINITION GOLF (the Mark).

[2] The Respondent has not made submissions and, although present, did not participate in the hearing of the appeal.

BACKGROUND

[3] The Applicant is a manufacturer and vendor of golf simulators. They are advertised as "the most realistic golf simulators in the world". In addition to simulating golf on several real-world golf courses, the simulator provides other services including detailed analyses of the user's swing and the ball's trajectory.

[4] The Applicant filed the Application on October 18, 2005, on the basis of proposed use in connection with the wares "golf simulators". The Applicant has been using the Mark in connection with its simulators since at least December 2005.

[5] A First Examiner's Report in relation to the Mark was issued on April 11, 2006. It was brief, and concluded as follows:

> The mark which is the subject of this application is considered to be either clearly descriptive or deceptively misdescriptive of the character of the wares in association with which it is proposed to be used since it clearly indicates that the applicant's golf simulators are high definition golf simulators.

[6] A Second Examiner's Report was issued on February 12, 2008. It was more detailed and stated that the Mark "clearly describes, in a way that is easy to understand, that the golf simulators are devices using high definition technology to play virtual golf". It concluded:

> In view of the wide use of the expression HIGH DEFINITION in the broadcasting industry, we consider that the average consumer would react to the mark HIGH DEFINITION GOLF used with golf simulators by thinking that the devices are golf simulators using high definition technology.

THE DECISION

[7] The Registrar's decision is dated May 15, 2009 (the Decision). She stated that the issue was whether the Mark was clearly descriptive of the character of the Applicant's wares. She noted that the issue had to be considered from the point of view of the average consumer or user of the wares, as a matter of first impression. Further, she wrote that the Mark had to be considered as a whole and not dissected.

[8] The Registrar referred to a definition of "HIGH DEFINITION" in the Merriam-Webster Online Dictionary. It read: "...being or relating to an often digital television system that has twice as many scan lines per frame as a conventional system, a proportionally sharper image, and a wide-screen format". In light of this definition, the Registrar concluded that the ordinary Canadian dealer or purchaser, faced with the Mark used in association with golf simulators, would immediately conclude that the simulators used HIGH DEFINITION technology.

[9] The Registrar also noted that HIGH DEFINITION GOLF is a natural combination of words that "other traders may wish to use to describe a feature, trait or characteristic of their golf simulators" and referred to a case in the Supreme Court of Canada which indicated that descriptive words cannot be appropriated by a single party.

[10] The Registrar concluded that, because the Mark is clearly descriptive, paragraph 12(1)(b) of the Act rendered the Mark unregistrable pursuant to paragraph 37(1)(b) of the Act.

THE NEW EVIDENCE

[11] The following is a description of the fresh evidence the Applicant filed on this appeal pursuant to subsection 56(5) of the Act. The evidence is found in the affidavit of Elenita Anastacio sworn on November 5, 2009 (the Anastacio Affidavit):

(i) Particulars of trade-mark applications and registrations in the Canadian Trade-marks Database belonging to various third parties. These documents incorporate the words "high definition" and relate to the following wares and services: optometry, laser eye surgery, etc.; eyeglasses; cosmetics; roofing shingles; fabrics and hard surfaces containing camouflage patterns; laminates, laminate flooring and furniture; hearing aids; lighting fixtures and light bulbs and stainless steel flatware. I note that only one of the listed registrations deals with the use of HIGH DEFINITION in the context of video screens. It is the May 2008 registration for "Living in HD" in association with electronics such as home theatre systems, TVs and laptops;

(ii) A website of a third party distributor of products called virtual golf systems. The site uses the phrase HIGH DEFINITION GOLF in its description of its video presentations of golf courses;

(iii) Archived copies of the Applicant's website, dating back to 2005, showing continuous use of the Mark;

(iv) Particulars of trade-mark applications and registrations in the Canadian Trade-marks Database belonging to other traders in golf simulators. None refer to high definition;

(v) Printouts from the "Dictionary.com" website showing that there are no dictionary results for HIGH DEFINITION and HIGH-DEFINITION in Merriam-Webster;

(vi) Particulars of the marks, High Resolution Vision, Bent Grass Golf, Homegolf and Ultimate Golf.

[12] The Applicant submits that, given this new evidence, I should consider the matter *de novo*. However, I will not proceed on this basis since I am not persuaded that the new evidence is substantial and significant. In my view, it would not have materially affected the Decision.

THE STANDARD OF REVIEW

[13] In *Tradition Fine Foods Ltd. v. Groupe Tradition'l Inc.*, 2006 FC 858 at paragraph 53, Mr. Justice Edmond Blanchard concluded that the pragmatic and functional analysis conducted by Mr. Justice Ian Binnie in the Supreme Court of Canada in the *Mattel* case also applied when the Registrar looked at distinctiveness. In *Mattel*, the Registrar had dealt with confusion (See *Mattel, Inc. v. 3894207 Canada Inc.*, [2006] 1 S.C.R. 772, 2006 SCC 22). In both cases, reasonableness was selected as the standard of review.

[14] In my view, Justice Binnie's analysis is apt in this case as well and leads me to conclude that a Registrar's decision about whether a proposed mark is clearly descriptive should also be reviewed on a reasonableness standard.

THE ISSUES AND DISCUSSION

[15] The Applicant says that the Registrar failed to appreciate that HIGH DEFINITION has a variety of meanings in the context of a golf simulator. For example, the Applicant says that, as a matter of first impression, a golfer would understand that the Mark conveys the idea that the simulator is a precision learning tool in which a swing would be analyzed in detail. However, I have not been persuaded that HIGH DEFINITION has multiple meanings. I think it was reasonable for the Registrar to have concluded that the Mark referred to a golf simulator that incorporated high definition technology in its video screen.

[16] The Applicant suggested that the marketing material before the Registrar showed that, in fact, high definition technology was not always offered in its simulator. However, my reading of that material which is found at page 23 of the Applicant's record, leads me to conclude that it was reasonable for the Registrar to assume that the Applicant's simulator used high definition technology at all times.

[17] I have reached this conclusion because, under the heading HIGH DEFINITION GOLF, the following language appears: "Our revolutionary image processing software combines high resolution digital images and satellite data into a 3D model of a golf course to produce a totally realistic indoor golf experience..." "High Definition Golf ™ - It looks like the real thing! …HDTV compatible display delivers…" As well, purchasers are offered either a domestic or a commercial projector which is compatible with a HIGH DEFINITION television.

[18] The Applicant also said that the Registrar used the wrong test when she said in paragraph 6 of the Decision that “The courts have recognized and held that descriptive words are the property of all…” The statement is said to be fatal to the Decision because the word “clearly” was not inserted before the word “descriptive”. However, the Registrar began paragraph 4 of her Decision with the following “The issue as to whether the Applicant’s trademark High Definition Golf is clearly descriptive of the character or quality of the Applicant’s wares must be considered…” I am therefore satisfied that she applied the correct test in spite of her failure to include the word “clearly” in paragraph 6 of the Decision.

[19] The Applicant said that the Registrar failed to provide a source for her definition of HIGH DEFINITION and that her definition does not exist because, when a website called Dictionary.com was searched, no such definition appeared on Miriam Webster. However, as noted above in paragraph 8, the Registrar did provide her source and it was not searched by the Applicant. The Miriam-Webster online Dictionary does provide the Registrar’s definition.

[20] The Applicant said that there was no evidence provided by the Registrar to support her finding of fact that HIGH DEFINITION GOLF is a natural combination that other traders may wish to use. It submits that the evidence in the Anastacio Affidavit shows that other simulator vendors have not yet used High Definition in connection with their wares.

[21] In my view, the rationale for the Decision is set out in paragraph 5 and involves the descriptive quality of the Mark. The subsequent comments about the Mark as a natural combination,

which other traders may wish to use, are simply the Registrar's observations. They are not findings of fact which underpin the Decision. Accordingly, they do not require evidentiary support.

CONCLUSION

[22] I have concluded that the Decision is reasonable and that the appeal will therefore be dismissed.

JUDGMENT

THIS COURT'S JUDGMENT is that this appeal is hereby dismissed.

"Sandra J. Simpson"
Judge

FEDERAL COURT

SOLICITORS OF RECORD

DOCKET:	T-1079-09
STYLE OF CAUSE:	Interactive Sports Technologies Inc. v. The Attorney General of Canada
PLACE OF HEARING:	Toronto, Ontario
DATE OF HEARING:	June 15, 2010
REASONS FOR JUDGMENT:	SIMPSON J.
DATED:	December 16, 2010

APPEARANCES:

Kenneth McKay	FOR THE APPLICANT
Abigal Browne	FOR THE RESPONDENT

SOLICITORS OF RECORD:

Sim Lowman Ashton & McKay LLP Toronto, Ontario	FOR THE APPLICANT
Myles J. Kirvan Deputy Attorney General of Canada Toronto, Ontario	FOR THE RESPONDENT