

Montreal, August 24, 2023

The Registrar of Trademarks
Canadian Intellectual Property Office
Trademarks Office
EXAMINATION SECTION
Place du Portage I, Room C-114
50 Victoria Street
Gatineau (Quebec) K1A 0C9

Attention: Anita Michael, Examiner

Trademark: **DIGITAL PREVIEW (&DESIGN)**
Application: 2088242
Applicant: Engineered Floors, LLC.
O/Ref.: 015454-0121 LC/CLU/SKA



Dear Sir,

We refer to the Examiner's report dated March 14, 2023, and would like to make the following observations in response to the objections raised therein.

In your report, you objected to the registration of the applicant's trademark pursuant to paragraph 12(1)(b) of the Trademarks Act on the basis that you consider the mark to be clearly descriptive or deceptively misdescriptive of the character and/or quality of the associated goods. Indeed, you mentioned that the trademark clearly describes that the applicant's services "will enable one to see the goods/services before hand through an electronic medium". Alternatively, if the services do not have this "feature, trait, characteristic, or quality", you further wrote that the trademark "is considered to be deceptively misdescriptive".

Incidentally, you also stated that the trademark is not distinctive pursuant to paragraph 37(1)(d) of the Trademarks Act as it would not be apt to distinguish the applicant's services from those of other traders in the marketplace.

We respectfully disagree with this position and, for the reasons set forth below, we believe that the trademark is registrable.

Clearly descriptive or deceptively misdescriptive

Paragraph 12(1)(b) of the Act reads as follows:

12. (1) Subject to subsection (2), a trademark 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 goods 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 their place of origin.

This section reveals that a trademark is not registrable if it is either clearly descriptive or deceptively misdescriptive of the character or quality of the services in association with which it is proposed to be used.

It is important to remember that, as Kearney J. mentioned in *Thorold Concrete Products Ltd. v. Registrar of Trade Marks*¹, “the word “clearly” in paragraph 12(1)(b) is not synonymous with accurately, but rather means easy to understand, self-evident, or plain”. [Emphasis added]

In order to determine whether the applicant’s trademark describes the services in association with which it is proposed to be used in an “easy to understand, self-evident, or plain” manner, one must consider *the meaning of the words comprised in said mark and the applied for services*.

The question of whether a trademark is clearly descriptive or deceptively misdescriptive cannot be considered in the abstract but rather must be considered in relation to the goods or services for which registration is sought. It must also consider the first impression of the average Canadian consumer of those goods or services.

We refer to *Molson Cos. Ltd. v. Registrar of Trademarks*, (1984) 3 C.I.P.R., 121 (F.C.T.D.), p. 128, where Cullen J. wrote:

In assessing the registrability of a trade-mark, the Court must look to the first impression which is made by that trademark on the minds of the consuming public.
(our underlining)

The Examiner must put himself in the position of the everyday user of the applied for services and study the first impression created by the trademark **DIGITAL PREVIEW**. We remind the Examiner that the services covered by the present application are the following:

Class 42: Providing online non-downloadable computer software for displaying pictures of vinyl flooring, laminate flooring, stone polymer composite flooring, wood flooring; providing online non-downloadable computer software for selecting and arranging the flooring of a room; providing online non-downloadable computer software for uploading photos and selecting flooring for photo simulations; providing temporary use of non-downloadable software for displaying pictures of vinyl flooring, laminate flooring, stone polymer composite flooring, wood flooring via a website; providing temporary use of non-downloadable software for selecting and arranging the flooring of a room; providing temporary use of non-downloadable software for uploading photos and selecting flooring for photo simulations;

We respectfully submit that the expression “**DIGITAL PREVIEW**” cannot be said to be clearly descriptive or deceptively misdescriptive of the associated services as a matter of first impression.

As can be noticed from the definition of the term “DIGITAL”, it usually relates to data, typically in the form of digital signals, represented by values of a physical quantity (such as voltage or magnetic polarization), or showing time by means of displayed digits.

¹ (1961), 37 C.P.R. 166 (Ex. Court)

Definitions from [Oxford Languages](#) · [Learn more](#)



dig·i·tal

/ˈdɪdʒəl/

adjective

adjective: **digital**

1. (of signals or data) expressed as series of the digits 0 and 1, typically represented by values of a physical quantity such as voltage or magnetic polarization.
 - relating to, using, or storing data or information in the form of digital signals.
"digital TV"
 - involving or relating to the use of computer technology.
"the digital revolution"
2. (of a clock or watch) showing the time by means of displayed digits rather than hands or a pointer.
3. relating to a finger or fingers.

We respectfully submit that the applied-for trademark, when taken as a whole, and considered in connection with the applied for services, cannot have a clear meaning. In contrast to digits, values or data, the applicant provides a software that relates to *images of flooring*. On a matter of first impression, this association cannot be considered as clearly descriptive.

We believe that the Canadian consumer of average culture and attention would not, at first glance, automatically and obviously come to the conclusion that **DIGITAL PREVIEW** would enable them to display pictures of vinyl flooring, laminate flooring, stone polymer composite flooring, wood flooring.

DIGITAL PREVIEW does not suggest to the average consumer what the Applicant's Services are. It does not describe them nor describe a property which is commonly associated with them. It is certainly not self-evident that the average Canadian consumer faced with the Trademark would automatically picture a software relating to pictures of vinyl flooring, laminate flooring, stone polymer composite flooring or wood flooring.

May we remind that no intellectual effort or additional thought should be necessary to establish that the mark is clearly descriptive. In other words, if an « additional mental step » is required to make an association between the Trademark and the Services, then the Trademark is NOT clearly descriptive of the nature of the Services in question. We refer to the decision *Procter & Gamble Inc. v. Tex Pro Western Ltd.* (1992), 43 C.P.R. (3d) 426 (C.O.M.C.) in which J. Partington stated:

However, the fact that the applicant's mark SUPERSORB Design might clearly suggest to the average consumer the words "super absorbent" or "super absorbency" which themselves clearly describe the character or quality of the applicant's wares does not mean that the applicant's trade mark itself is clearly descriptive of the character or quality of diapers or pads.

(Our underlining)

In the absence of any clear meaning of the expression "DIGITAL PREVIEW" to the ordinary Canadian purchaser, in association with the services of interest, one cannot say that the trademark is clearly descriptive as a matter of immediate impression.

Indeed, not only one but several additional mental steps would be required to go from **DIGITAL PREVIEW** to “a software relating to pictures of vinyl flooring, laminate flooring, stone polymer composite flooring or wood flooring”. For the objection to be well-founded, there needs to be a direct connection between the Trademark and the Services.

In this regard, we refer you to *Ralston Purina Co. v. Effem Foods Ltd.*, (1997), 81 C.P.R. (3d) 528 (C.O.M.C.), in which an applicant sought to register the marks C'EST COMME UNE MULTI-VITAMINE A CHAQUE REPAS and SI NUTRITIF...C'EST COMME UNE MULTI-VITAMINE A CHAQUE REPAS for dog food, and in which Hearing Officer Groom stated the following:

However, whether or not most manufacturer's add vitamins to their pet food is not particularly pertinent to a consideration of registrability under section 12(1)(b) as the real issue is whether the marks clearly describe a character or quality of the applicant's wares... If the marks went on to say that the pet food will therefore make your pet healthier, that would be laudatory, but they do not. It is up to the consumer to draw that conclusion or any other conclusion they may decide to reach. Therefore, since an **additional mental step** is required on the part of the consumer before any remotely laudatory association can be made, it cannot be argued that the marks are laudatory and thus prohibited by section 12(1)(b).

(Our underlining)

We also refer to the words of Cattnach J. in *GWG Ltd. c. Registraire des marques de commerce*, (1981), 55 C.P.R. (2d) 1 (C.F.P.I.) at page 6:

In my view to attribute the meaning to the trade mark KIDFITTERS for use in association with jeans, jackets and skirts which, standing alone, are not exclusively children's wear, from meanings of the two component words, the combination of which makes up the coined word, that it is clearly descriptive of the character of those wares in that they are designed to fit children rather than the service that the manufacturer performs is an exercise in mental gymnastics. Perhaps not an advanced exercise but an exercise nevertheless.

(Our underlining)

In this case, the Examiner must put himself in the position of the everyday user of the applied-for Services and study the first impression created by the Trademark **DIGITAL PREVIEW.**

Doing so, you will easily see that the Trademark application is **not** clearly descriptive of the character and/or quality of the Applicant's Services.

Moreover, in *Best Canadian Motor Inns Ltd. v. Best Western International, Inc.* (2004), 30 C.P.R. (4th) 481, the Federal Court concluded that composite marks are not registrable pursuant to paragraph 12(1)(b) of the Act if it contains word elements that are:

1. clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the associated goods or services or of the conditions of or the persons employed in their production or of their place of origin; **and**
2. the dominant feature of the trademark.

Therefore, the Examiners must also assess the trademark in its entirety and determine whether the descriptive word element is the dominant feature of the trademark. In particular, the elements considered in analyzing the visual impression left on the consumer include the size of the words, the size of the design, the style and layout of the words.

As mentioned in the Trademark Examination Manual², “only one element in a trademark can be dominant. Therefore, in situations where the word element and the design element are considered to be equally influential or prominent in a trademark, the Office considers that neither can be the dominant feature of the trademark. When the word element of a combination trademark is not the dominant feature of the trademark, the Registrar considers that the trademark in its totality cannot, when sounded, be clearly descriptive or deceptively misdescriptive of the associated goods or services”. [our underlining]

Turning to the present case, we respectfully submit that the words “DIGITAL PREVIEW” are not the dominant feature of the trademark, and that in any case, these words are not *clearly descriptive* but merely *suggestive* of the associated services. The dominant feature is the design element of the giant brush stroke, due to its prominent size, shape and coloured font.

Therefore, the trademark cannot be said to be clearly descriptive or deceptively misdescriptive of the character or quality of the associated goods and services and should be considered registrable.

Lack of inherent distinctiveness

In your report, you also objected to the registration of the applicant’s trademark pursuant to paragraph 37(1)(d) of the *Trademarks Act* since you considered that the mark is not distinctive as trademarks which do not appear to be registrable pursuant to Paragraph 12(1)(b) of the *Trademarks Act* are considered not inherently distinctive. As such, your position is that the trademark does not distinguish the applicant’s services from those of another person or business and should be available for use by others in the ordinary course of their business.

We respectfully disagree with this position, and we are of the opinion that this objection should be withdrawn for the reasons hereafter explained.

Paragraph 37(1)(d) of the Act reads as follows:

37 (1) The Registrar shall refuse an application for the registration of a trademark if he is satisfied that

[...]

(d) the trademark is not distinctive.
If the Registrar is not so satisfied, the Registrar shall cause the application to be advertised in the prescribed manner.

The Registrar’s authority to raise an objection that a trademark is not inherently distinctive stems from paragraph 32(1)(b) of the *Trademarks Act* which states:

² Subsection 4.4.10.1 Determination of Whether Words are the Dominant Feature of a Combination Trademark

32 (1) An applicant shall furnish the Registrar with any evidence that the Registrar may require establishing that the trademark is distinctive at the filing date of the application for its registration, determined without taking into account subsection 34(1), if any of the following apply:

[...]

(b) the Registrar's preliminary view is that the trademark is not inherently distinctive;

[...]

Although the provisions of paragraphs 32(1)(b) and 37(1)(d) have only entered into force on June 17, 2019, the concept of distinctiveness has not significantly changed with the coming into force of the new legislation. Indeed, Section 2 of the former and new *Trademarks Act* reads as follows with respect to the definition of the term “distinctive”:

Before June 17, 2019	As of June 17, 2019
distinctive , in relation to a trade-mark, means a trade-mark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or is adapted so to distinguish them; (distinctive)	distinctive , in relation to a trademark, describes a trademark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or that is adapted so to distinguish them; (distinctive)

In light of the foregoing and since the Registrar and the Courts have rendered very few decisions based on issues of distinctiveness applied under the new *Trademarks Act* of June 17, 2019, we respectfully submit that the principles mentioned in the decisions rendered under the old Act would also apply to the present case.

Inherent distinctiveness refers to the intrinsic ability of a trademark to distinguish the source of goods or services with which it is associated. There is a spectrum of inherent distinctiveness, ranging from no inherent distinctiveness to high inherent distinctiveness.

As mentioned in the *Trademarks Examination Manual*³, there is a clear distinction to be made between a trademark with no inherent distinctiveness and one that possesses a low degree of inherent distinctiveness, the latter being registrable:

The phrase “not inherently distinctive” in paragraph 32(1)(b) refers to a trademark having “no inherent distinctiveness” (not registrable) as opposed to a trademark possessing a “low degree of inherent distinctiveness” (registrable).

Trademarks possess some inherent distinctiveness when nothing about them refers the consumer to a multitude of sources when assessed in relation to the associated goods or services [*Compulife Software Inc v CompuOffice Software Inc* 2001 FCT 559 at para 19]. Where a trademark may refer to many sources, it is considered to have no inherent distinctiveness. When considering whether or not a trademark is inherently distinctive, the underlying question is thus: does this trademark enable the consumer to identify a unique source for these goods and/or services?

Turning to the present case, we respectfully submit that the trademark **DIGITAL PREVIEW** is registrable in connection with the applicant's services, and refers to only one source, as no other business uses this trademark in the same trade.

³ *Trademarks Examination Manual*, Section 4.9.3

We disagree with the assertion that the trademark is composed of descriptive terms, the combination of which should be left available to other traders in the same field. Such reasoning would be overlooking the trademark when taken in its entirety. The applicant has created a new linguistic construction, as **DIGITAL PREVIEW** does not have a clear meaning in association with its specific flooring images-related services.

As mentioned in the *Trademark Examination Manual*⁴, “the ultimate question is whether other traders should be free to use that trademark in association with their goods and services”. The applicant’s trademark possesses its own distinct identity and is certainly not available for everyone to use.

We respectfully submit that when used by consumers, the trademark **DIGITAL PREVIEW** refers to a single source of services. Moreover, the applicant’s trademark protection would be limited to its particular linguistic construction and would not prevent others from using the term “digital” or “preview” to describe their own goods and/or services. To this effect, in the decision *Clarkson Gordon v. Registrar of Trade Marks*⁵ Justice Reed’s comments at paragraph 13 of her decision are particularly relevant:

In this case, registration of the appellant's trade mark does not remove from the vocabulary available to others providing services comparable to the appellant's any of the common descriptive words by which those services might be described. Competitors are not being deprived of the right to describe their services as computer-assisted audits or by reference to any other comparable terms. As counsel for the appellant expressed it: registration of the mark "would not deprive anybody of anything".

[our underlining]

The purpose of the prohibition in section 12(1)(b) of the Act is to prevent any single trader from appropriating words within the range of language that would ordinarily be used by traders to describe some goods or services, thereby placing legitimate competitors at a disadvantage. In the decision *Dunlop Rubber Co Ltd's Application*⁶, Justice Simonds states the issue as follows: "The applicant's chance of success [...] must, I think, largely depend upon whether other traders are likely, in the ordinary course of their business, and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods".

As already demonstrated above, the trademark **DIGITAL PREVIEW** is not clearly descriptive, and the combination of these terms forms an original linguistic construction with respect to the associated services. Consequently, we do not see how another trader could desire to appropriate similar terms in association with its own services.

For all the above-mentioned reasons, we respectfully submit that the applied-for trademark benefits from a certain level of inherent distinctiveness, and does not contravene paragraphs 12(1)(b) and 37(1)(d) of the *Trademarks Act*.

⁴ *Trademark Examination Manual*, Section 4.9.4.
⁵ 5 CPR (3d) 252 (FCTD)

⁶ (1942), 59 CPR 134 at p. 137

We therefore respectfully ask you to reconsider your position regarding the present trademark application and confirm its approval to publication at your earliest convenience.

In the meantime, we remain,

Yours truly,

A handwritten signature in blue ink that reads "Robic". The signature is written in a cursive style with a large, prominent initial "R".

ROBIC S.E.N.C.R.L / LLP
Lawyers, Patent and Trademark Agents
Trademark Agent: Laurent Carrière
/ska