

BETWEEN:

Ottawa
1967
June 27
Sept. 5

HOME JUICE COMPANY, HOME
JUICE COMPANY LIMITED and
JAY-ZEE FOOD PRODUCTS
LIMITED

APPLICANTS;

AND

ORANGE MAISON LIMITÉERESPONDENT.

Trade Marks—“Orange Maison” used in association with orange juice—
Whether indicating product home-made—Meaning of “maison” in
French—*Trade Marks Act, s. 12(1)(b)*.

Applicants applied to strike out the registration of the trade mark “Orange
Maison” used in association with orange juice on the ground that it
was clearly descriptive in French of the character or quality of the
orange juice in that the word “maison” suggested home-made quali-
ties, and that the mark was therefore non-registrable by virtue of
s. 12(1)(b).

Held, dismissing the application, the word “maison” does not indicate a
home-made product though as used in some cases in the culinary art
in France, but seldom in Quebec, it conveys a remote suggestion to
that effect.

The Solio Case (1898) 15 R.P.C. 476, referred to.

ORIGINATING NOTICE to strike out registration of
trade mark.

Christopher Robinson, Q.C. for applicants.

Gordon F. Henderson, Q.C. and *K. H. E. Plumley* for
respondent.

NOËL J.:—This is a proceeding by originating notice of
motion to strike out a registration, under the *Trade Marks
Act, R.S.C. 1952-53, chapter 49*, of the words ORANGE
MAISON as a trade mark in the name of the respondent
on December 9, 1960, under number 120,375 in respect to
orange juice.

The motion is made by the applicants on the ground
that the trade mark ORANGE MAISON was not registra-
ble at the date of registration in that it is clearly descrip-
tive in the French language of the character or quality of
the wares in association with which it is used and is thus
contrary to section 12(1)(b) of the Act.

The applicant, Home Juice Company, is incorporated
under the laws of Illinois, one of the United States of

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America, the applicants Home Juice Company Limited and Jay-Zee Food Products Limited, are incorporated under the laws of Ontario, with head offices respectively in the City of Hamilton and the City of Windsor, and the respondent is a company incorporated under the laws of the Province of Quebec, having an office at 2323 Aubrey Street, in the City of Montreal, in the said province.

The applicant, Home Juice Company, has before the Trade Marks Office an application filed in 1964 to register the words HOME JUICE in Canada as a trade mark in respect of fruit flavoured drinks on the basis of intention to use it in Canada. This application has been opposed by the respondent on the ground that HOME JUICE is confusing with the respondent's registered trade mark ORANGE MAISON, No. 120,375 and that the wares of the applicant and the respondent are identical and are merchandized to the public by identical means.

Furthermore, the applicants, Home Juice Company Limited and Jay-Zee Food Products Limited are defendants in an action brought against them in this Court under No. B-1455 by the respondent in respect of *inter alia* alleged infringement of the respondent's aforesaid registered trade mark No. 120,375.

The sole wares which have been sold or otherwise used or advertised in association with the registered trade mark ORANGE MAISON No. 120,375 are orange juice bearing the mark ORANGE MAISON which has been applied to a drink composed of fresh and reconstituted orange juice with added vitamin C, the said drink being manufactured, sold and delivered directly by the respondent to the homes of customers in 64-ounce jugs.

It is of some interest to note that respondent's trade mark was first used in Canada on January 16, 1954, was used for some seven years before it was registered on December 9, 1960, and has been used for about six and a half years since registration.

The respondent's reply to the attack made upon its trade mark ORANGE MAISON by the applicants is twofold:

- (1) its trade mark is not clearly descriptive in the French language of the character or quality of the wares 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 as set down in section 12(2) of the Act.

- (2) If its trade mark is descriptive it had acquired a distinctive meaning at least in the Province of Quebec at the date of its registration (i.e., December 9, 1960) within the meaning of section 18(2) of the Act and, therefore, because of sections 12(2) and 31(1) and (2) of the Act this acquired distinctiveness at the date of registration established by evidence of the extent to which and the time during which its trade mark has been used in Canada, should give it in any event a restricted registration "to the wares or services in association with which the trade mark is shown to have been used as to have become distinctive and to the defined territorial area in Canada in which the trade mark is shown thus to have become distinctive".

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The position taken by the respondent is, therefore, that it would be entitled to a registration in the province of Quebec even if its trade mark was held to be descriptive.

The applicants' attack of respondent's trade mark ORANGE MAISON on the ground that it is descriptive and, therefore, not registrable under section 12(1)(b) of the Act as expressed by counsel for the applicants, is that the word "maison" in the French language has a meaning which suggests that the products sold in association therewith have the qualities of a home made product. He urged that the idea conveyed by the use of the word "maison" is that this is a home orange juice, either or both from the point of view of being home made or coming to the house (as being home delivered) and generally that by extension it expresses the idea of good quality. He indeed suggests that in French and probably in English also, the expression "maison" (or home) in relation particularly to a food or a beverage, had gone even beyond the strict meaning of home made to the idea of quality and that this meaning was an extension from the meaning of home made and did not necessarily import the meaning of home made.

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The applicants rely on a particular meaning of quality of the word "maison" found in a few French dictionaries such as the following:

Petit Larousse (1959)

Adj Fam. Fait à la maison; de bonne qualité; tarte maison.

Dictionnaire Alphabétique et Analogique de la Langue Française, par Paul Robert

1° T. de comm. (hôtellerie). Qui a été fait à la maison, sur place, et non pas acheté au dehors. Pâté, tarte, vol-au-vent maison (cf. de chef). —Par ext. (le fait d'avoir été fait à la maison étant considéré comme une assurance de qualité). Pop. particulièrement réussi, soigné.

Le Grand Larousse Encyclopédique—1962

Adj. Fam. De première ordre, fabriqué par une maison réputée, selon des recettes éprouvées. Une tarte maison. Pop. soigné particulièrement, même appliqué à un mot qui ne désigne pas un objet fabriqué. Un exposé maison.

The above meaning of the word "maison", however, does not occur in all French dictionaries and there are several such as Littré and Quillet, where such a meaning does not appear. It does not appear either in Belisle's Dictionnaire Général de la Langue Française au Canada, 1954, nor in the Larousse Canadien Complet, 1954. As a matter of fact "maison" to anyone is essentially a place where one lives and the meaning of quality it may convey in some cases is an exotic one even in France and is restricted to the culinary art. The use of the word "maison" in this sense merely suggests that a particular victual is made by the chef of a restaurant in which one is eating such as pâté maison or tarte maison and may (but not necessarily so) because of this, be of a better quality than if it was purchased outside.

The word "maison" used such as here, however, in association with the word orange (which although it is disclaimed in the registration and, therefore, cannot in any sense add anything to the strength of the trade mark) does not, in my view, indicate that the product is home made as in French one should not merely use the word "maison" to express or convey such an idea but should use the words "fait à la maison" and even if these words were used, they would in association with the word "orange" be complete nonsense as indicating home made oranges. They do not either indicate that one refers to an orange house where oranges are grown or kept as in such a case the word

“orangerie” should be used. As a matter of fact, they do not even describe orange juice or even a quality or characteristic thereof and if they did would be deceptively misdescriptive of the character or quality of the wares as being home made which is not an issue raised in these proceedings.

If one, indeed, considers the respondent’s trade mark in its entirety, they are not indicative of juice at all, nor do they refer to a feature or essential peculiarity of that particular product. They may at the most be suggestive of a food consumed in the house or the home but they do not, in my view, indicate some essential peculiarity or nature of the wares or some quality or character thereof.

The most one can say of the respondent’s trade mark ORANGE MAISON is that if one takes an exotic meaning of the word “maison” as used in some cases in the culinary art in France but seldom used in Quebec except in a few sophisticated restaurants on menus describing pâté maison (a meat paste or loaf made locally) which meaning can be found in some French dictionaries, but not in all, and which cannot be found in any French-Canadian dictionary, one may find a remote suggestion that something which deals with oranges is made at home, in the house, or has some characteristic of a home made product.

This, in my view, is not sufficient to render the respondent’s trade mark unregistrable as it has been held in several instances that mere suggestiveness should not deprive a trade mark of registrability even in the case where a word used skilfully alludes to the wares in association with which it is used unless, of course, it is clearly descriptive of their character or quality as contemplated by the statute.

In the *Solio* case¹ at p. 486, Lord MacNaghten had this to say on this subject:

... the word must be really an invented word; nothing short of invention will do. On the other hand, nothing more seems to be required. If it is . . . “new and freshly coined” (to adopt an old and familiar quotation), it seems to me that it is no objection that it may be traced to a foreign source, or that it may contain a covert and skilful allusion to the character or quality of the goods.

It also appears that such a solution should also be accepted in this country, as the *Trade Marks Act* (section

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¹ (1898) 15 R.P.C. 476.

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12(1)(b)) seems to contemplate the acceptance of some descriptive connotation. It indeed does not say any description of any kind but one which is *clearly* descriptive of the character or quality of the wares.

If I had to determine here the matter of descriptiveness on the basis of the words used being a covert allusion to the quality or character of the respondent's wares, I would have considerable difficulty in doing so because the use of the word "maison" with "orange" (particularly without the use of other words such as "fait à la maison" or "jus d'orange") does not, in my view, even suggest a feature or even an essential peculiarity of the respondent's wares.

I cannot even accept that the word "maison" used with another word to indicate quality is in general use even in France. It is certainly not in common or current use anywhere in the world in association with the word "orange". As for this country, to the greater part of its French population, the word "maison" is certainly seldom, if at all, used in association with another word to indicate a home made product nor so far as ordinary language is concerned is the word used to denote the quality of anything. It, therefore, follows that it is not a word with which the word "orange" would be used in any country by others in the description of their products or wares nor would it be used particularly in Canada where its descriptiveness must be realistically considered for the purpose of the Act.

I have, therefore, reached the conclusion that the word "maison" is not descriptive and that its registration as a trade mark is not excluded by subsection (b) of section 12(1) of the *Trade Marks Act*.

Having determined that the respondent's trade mark ORANGE MAISON is not descriptive, there is no necessity to deal with respondent's alternative reply in that it would at least be entitled to a registration restrictive to the wares in association with which its trade mark had been so used as to have become distinctive and to the defined territorial area in Canada in which it is shown to have become distinctive. In view, however, of the possibility of an appeal herein, it may be useful to deal with this submission.

Without considering the evidence submitted by the respondent, by way of affidavits, which goes beyond the

date of December 9, 1960 (which is the date upon which the registration of the trade mark was obtained) to which counsel for the applicants objected on the basis that such evidence, subsequent to the date of registration, was irrelevant, or the statements by some of respondent's witnesses on the very point the Court is called upon to adjudicate such as whether the trade mark of the respondent has become well known and distinctive of the respondent or whether the said trade mark was known to persons engaged in this business as being distinctive of the respondent's orange juice, or was well known to competitors as being distinctive and even disregarding a letter produced by Maurice Primeau the owner of the respondent company in paragraph 25 of his affidavit relating to the expansion of his business and without, however, deciding their relevance or admissibility, I must conclude on the basis of the remaining evidence that the respondent and its predecessor, Plus 4, Limitée, has manufactured, advertised extensively and sold orange juice directly to householders in jugs in association with the mark "maison" for a considerable period of time prior to the date of registering its trade mark. This evidence indeed discloses that the first sales were in Montreal and from 1954 until the date of registration of the said mark ORANGE MAISON (i.e., December 9, 1960) orange juice was sold in association with its trade mark in Montreal and in other cities of the Province of Quebec such as Hull, Trois-Rivières, Ste-Rose, Verchères, L'Assomption, Drummondville, Quebec City, Joliette, Lachute, St-Jérôme, Valleyfield, St-Hyacinthe, St-Jean, Chaudière and Terrebonne.

Since 1954 the respondent and its predecessor in title has continuously and extensively advertised in the Province of Quebec its orange juice in association with the trade mark ORANGE MAISON by product information mailed or delivered directly to household consumers, by contests concerning and advertising its orange juice on home delivery trucks, letterheads, invoices, exterior signs, posters placed on transit vehicles, cards, radio and television advertising and decals placed on store windows.

There is, therefore, no question in my mind that by virtue of continuous use and extensive advertising in the Province of Quebec at the date of registration, the respondent's trade mark ORANGE MAISON had

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acquired a distinctive meaning of the orange juice of the respondent and its predecessor in title among dealers and purchasers of orange juice and other fruit flavoured drinks and non-alcoholic beverages in the Province of Quebec within the meaning of section 18(2) of the *Trade Marks Act*, R.S.C. 1952-53, chapter 49.

Having thus acquired a distinctive meaning in the Province of Quebec within the meaning of section 18(2), I must hold that the respondent's trade mark ORANGE MAISON was registrable even if it had been held that it was not registrable under subsection (b) of section 12, i.e., as being "clearly descriptive or deceptively misdescriptive in the English or French languages of the character or quality of the wares" although in such a case such registration would be in accordance with section 31(2) of the Act restricted "to the wares or services in association with which the trade mark was shown to have been so used as to have become distinctive and to the defined territorial area in Canada in which the trade mark is shown thus to have become distinctive".

The motion will accordingly be dismissed with costs.