Intellectual Property Weekly Abstracts Bulletin — Week Of February 29

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Trademark Decisions
Federal Court of Appeal clarifies the test to determine whether a geographic name is unregistrable as a trademark because it is clearly descriptive of place of origin
MC Imports Inc. v. AFOD Ltd., 2016 FCA 60

The Federal Court of Appeal has dismissed the appeal of a summary trial (2014 FC 1161) that we previously reported in December 2014.

It was described that the appellant, MC Imports Inc., imports and sells food products under the trademark LINGAYEN (or Mark). Lingayen is a municipality in the Philippines known for its bagoong shrimp paste products characterized by their distinct aroma and flavour. The Federal Court had agreed with the respondent that the appellant's trademark was not registrable at the time of registration and was thus invalid, because it was clearly descriptive of the place of origin of the wares (the current Act uses the word goods) in relation to which it was used, contrary to paragraph 12(1)(b) of the Act. Furthermore, the mark was found to not be distinctive at the time proceedings were commenced.

On appeal, the Court dismissed the appeal but the reasons departed somewhat from the Federal Court Judge. The Court of Appeal noted there was potentially conflicting jurisprudence: a line of cases from Conzorsio Del Prosciutto Di Parma v. Maple Leaf Meats Inc. 2001 F.C.J. No. 89, [2001] 2 F.C. 536, and another from Sociedad Agricola Santa Teresa Ltd. v. Vina Leyda Limitada 2007 FC 1301, 63 C.P.R. (4th) 321.

The Court of Appeal then clarified the test to determine whether a geographic name is unregistrable as a trademark because it is clearly descriptive of place of origin:

First, by determining that the trademark is a geographical name;
second, by determining the place of origin of the wares or services;
and third by assessing the trademark's owner assertions of prior use, if any.
Applying this framework to the facts on appeal, and addressing other related issues, the appeal was dismissed.

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