

TUPPER, McTAVISH, FOLEY & TUPPER

THE LAW OF
TRADE-MARKS
AND
DESIGNS
IN CANADA

BY

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AUTHOR'S NOTE.

A collection of Reports of all the Trade-Mark Cases decided in Canada down to the fall of 1903 may be found in Volume 3 of the Commercial Law Reports (Annotated), published in 1904 by The Canada Law Book Company, Toronto, and edited by Mr. W. R. P. Parker. A number of annotations from these Reports appear as part of the present work, for permission to use which I am indebted to the publishers. In the table of cases a few cases to which no reference appears in the text, have been included for the sake of record.

RUSSEL S. SMART.

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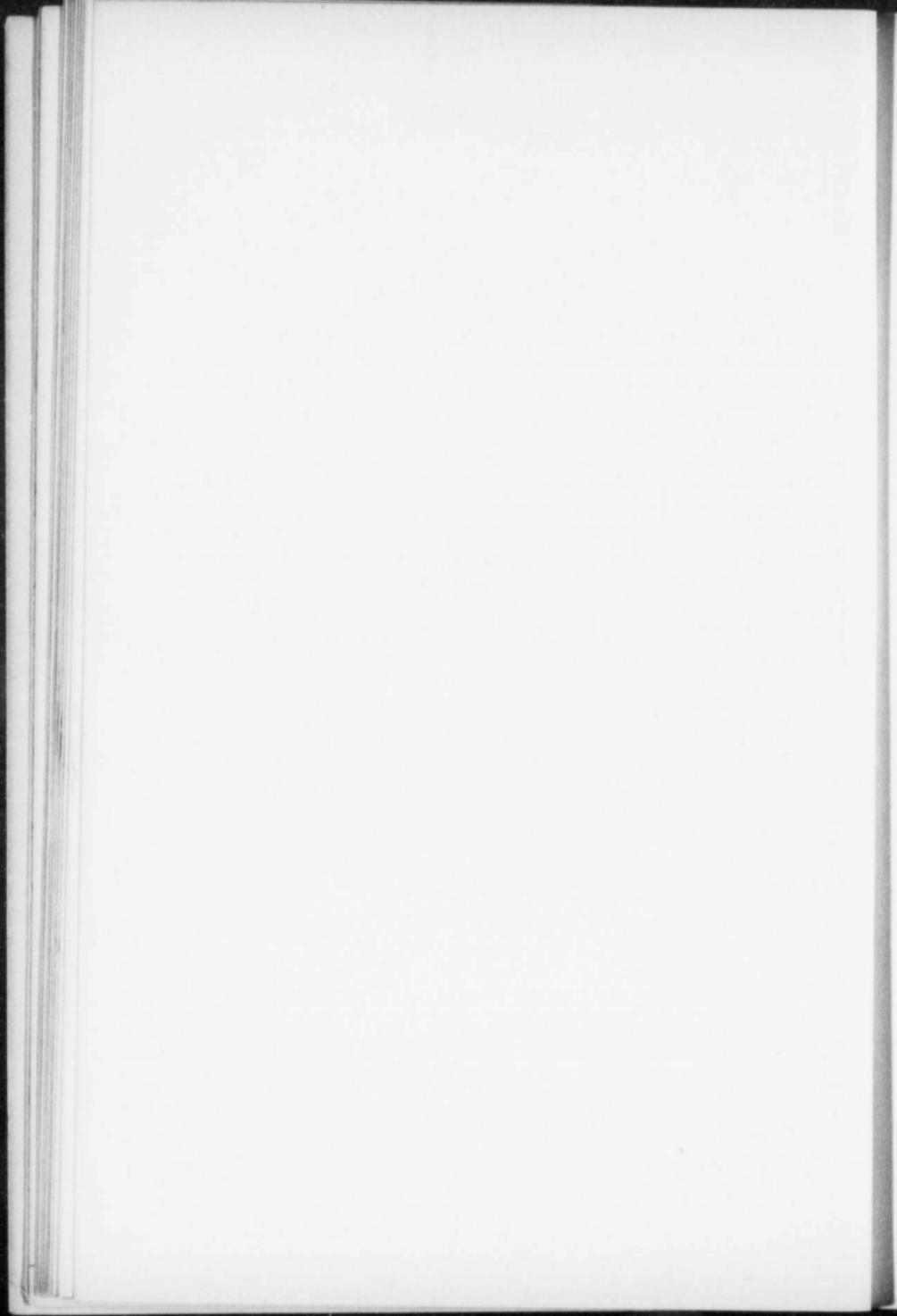
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CHAPTER I.

INTRODUCTORY.

No Definition of a Trade-Mark in Canadian Statute.—Neither the first Canadian Statutes in 1860 and 1861 nor subsequent Statutes attempt any exact definition of a trade-mark.

At the time of enactment of the Act of 1861, the text of which is similar to the present statute, there were no corresponding Statutes either in Great Britain or the United States. As the Statute attempts no definition it is necessary to refer to the common law of England.

Early English Cases.—The first English trade-mark case in 1590, *Southern v. How*, 2 Popham 44, sustained an action by one clothier to prevent the use by another clothier of a mark he used to "set to his cloth whereby it should be known to be his cloth." The development was not rapid. Lord Hardwich in 1742 said he "knew no instance of restraining one trader from making use of the same mark with another" (*Blanchard v. Hill*, 2 Cox 633). This case was followed by *Singleton v. Bolton* (1783), 3 Doug. 293; and *Sykes v. Sykes*, (1823) 3 B. v. Cr. 541, and finally by *Rodgers v. Nowill*, 5 C. B. 109, which established the right of a plaintiff to damages if he could prove that he should have been accustomed to use a certain mark upon goods of his manufacture to denote that that was so, that that mark was known in the trade, and that the defendant had imitated the mark and sold goods bearing it, as and for the plaintiff's goods, with intent to defraud.

A discussion of the history of trade-mark law is found in *Singer Mfg. Co. v. Loog*, 8 App. Cas. 29.

Litigation of trade-mark cases in England before the first Statutes was costly and unsatisfactory owing to the difficulty of proving ownership and the reputation of the goods. A Select Committee of the House of Commons was appointed in 1862, but owing to the controversial charac-

ter of the evidence offered to the Committee no Act for the registration of trade-marks resulted from its report, although the Bill which became the Merchandise-Marks Act of 1862 (25 and 26 Vict., ch. 38) was amended and favourably reported by the Committee. This Act dealt principally with the criminal law providing penalties for the false marking of merchandize. It also provided for an injunction against forging a counterfeit trade-mark, gave a statutory right of action for damages, empowered the Court to order the destruction of goods marked with spurious trade-marks, provided that a warranty that the trade-mark was genuine should be implied on the sale of any trade-marked article, and authorizes Courts of Law to grant injunctions in trade-mark cases.

British Act of 1875.—The first Trade-Marks Registration Act came in force in 1875 (38 and 39 Vict., ch. 91). It provided for registration of certain classes of trade-marks, and enacted that registration should be *prima facie* evidence of the right of the proprietor to the exclusive use of the trade-mark. It was further provided that no person should be entitled to institute proceedings to prevent the infringement of a trade-mark as defined by the Act, until and unless the trade-mark was registered. This was modified in 1875 by 39 and 40 Vict., ch. 33 to exclude old marks in use before August 13th, 1875, and which had been refused registration under the Act of 1875.

Section 10 of the Act of 1875 read in part:

“10. For the purposes of this Act a trade-mark consists of one or more of the following essential particulars; that is to say,

“A name of an individual or firm printed, impressed, or woven in some particular or distinctive manner; or a written signature or copy of a written signature of an individual or firm; or a distinctive device, mark, heading, label or ticket;

“And there may be added to any one or more of the said particulars any letters, words, or figures, or combination of letters, words, or figures, also any

special or distinctive word or words or combination of figures or letters used as a trade-mark before the passing of this Act may be registered as such under this Act

“”
This definition has been in substance preserved in subsequent Acts.

British Acts of 1883 and 1888.—The Registration Act of 1883 (46 and 47 Vict., ch. 57) conferred power to register a “fancy word or fancy words not in common use.” This was defined by the Court of Appeals in *Van Duzer’s and Leaf’s Trade-Marks* (1887) 4 R. P. C. 31, to refer to a word or words “obviously not intended to be descriptive” and which would “speak for itself and be a fancy word of its own inherent strength” and “be so obviously and notoriously inappropriate as neither to be deceptive nor descriptive.”

In 1887 Lord Herschell’s committee appointed by the Board of Trade, brought in an extensive report dealing with the general question of the registration of trade-marks. The result of their report was the Act of 1888 (51 and 52 Vict., ch. 50) which inter alia substituted for the fancy-word phrase in the Act of 1883 the phrases “an invented word or invented words; or a word or words having no reference to the character or quality of the goods and not being a geographical name.”

British Act of 1905.—The present English Act, that of 1905, enlarged the definition of registrable trade-marks by including “any other distinctive mark” deemed by the Board of Trade a court to be a “distinctive mark.” The word “distinctive” for the purpose of the Act being defined as meaning “adapted to distinguish the goods of the proprietor of the trade-mark from those of other persons.”

Distinctions Between British and Canadian Statutes.—The various English Registration Acts from 1875 to 1905 attempted no definition of a trade-mark. They were confined to stating what trade-marks might be registered. Under the Canadian Acts any “trade-mark” not “calcu-

lated to deceive or mislead the public" and not containing "any immorality or scandalous figures" may be registered.

The field for registration is obviously wider in Canada, and this taken with the declaration that after registration the proprietor "shall have the exclusive right to use the trade-mark" serves to put trade-marks on a different basis in Canada than those in England.

The Province of Quebec derives considerable of its Common Law from France, and it is necessary to give consideration to this point as affecting cases within that Province.

Cross, J., in *Lambert Pharmacel Co. v. Palmer & Sons, Ltd.*, 2 D. L. R. 358, has pointed out that Canadian Trade-Mark Law is a development from both French and English law.

"With reference to the authorities cited to us from the law of France, it may be opportune, that, speaking for myself, a few observations be added: The law of France upon the subject of trade-marks and designs is a creation of modern legislation which was not extended to this country. As the law of France stood when it prevailed in this part of Canada, it was possible to say of it, in the words of the treatise in Dalloz, Rep.:—

Industrie et Commerce No. 252: "Mais jusqu' à cette époque c'est-à-dire la réorganisation du régime industriel les noms et les marques de fabrique restèrent, malgré leur importance, sans protection et en quelque sorte à la merci des usurpateurs."

That would indicate a statement of our law much like the English common law, under which it could be said: "A man cannot give to his own wares a name which has been adopted by a rival manufacturer, so as to make his wares pass as being manufactured by the other. But there is nothing to prevent him giving his own house the same name as his neighbour's house, though the result may be to cause inconvenience and loss to the latter": *Mayne, Damages*, 8th ed. p. 9, citing *Johnston v. Orr Ewing*, 7 A. C. 219; *Day v. Brounrigg* 10 Ch. D. 294; *Keeble v. Hickeringill*, 11 East 574n.

And I take it that in England to this day, a trader who is put in peril of ruin by a supplanter in the way indicated can publish his feeble protest of "no connection with the establishment of the name next door." When it is realized that this peculiarity of English common law or case law lies at the very foundation of trade-mark or trade name law, another reason can be seen why we should hesitate to be guided by decisions given in England otherwise than as mere illustrations of the statutory construction. Civil law responsibility

for wrongful interference with the plaintiff's trade is to be determined by our law and not by English law, except in so far as it depends upon statutory construction. The same peculiarity of English law above referred to would seem to constitute the ground of decision in the *Lea & McEwan Applications Case* (or perhaps one should say of the statutory rule there applied *L. J. Weekly*, 1912, p. 142 and 28 *T. L. R.* 258), where marks in use for half a century were refused registration, a case which under our law would be decided in the opposite sense. But why, it may be asked, call attention to such a peculiarity, if the old French law as introduced in Canada is the same? The reason is that our law has developed and broadened and a defendant who has caused damage to a plaintiff by introducing confusion into his trade subjects himself to responsibility in damages just as he would by commission of any other tort (art. 1053, *C. C.*) It is upon that footing that the decision in *La Nationale v. La Societe Nationale*, cited to us from 3 *Couhin*, p. 493, and the citations from *Pouillet* and from *Fuzier-Herman*, Rep. "Concurrence Deloyale," No. 459, and *Sirey*, 91-1-165, in so far as not affected by statutory legislation are seen to be reasonable."

When it becomes necessary to consider "the essentials necessary to constitute a trade-mark," as called for in Section 11 of the Canadian Act, many of the English cases are valuable.

CHAPTER II.

NATURE AND DEFINITION OF A TRADE-MARK.

Sections 5 and 11 of the Trade-Mark and Design Act read:

5. All marks, names, labels, brands, packages or other business devices, which are adopted for use by any person in his trade, business, occupation or calling for the purpose of distinguishing any manufacture, product or article of any description, manufactured, produced, compounded, packed or offered for sale by him, applied in any manner whatever either to such manufacture, product or article, or to any package, parcel, case, box or other vessel or receptacle of any description whatsoever containing the same shall, for the purposes of this Act, be considered and known as trade-marks. R. S., c. 63, s. 3.

11. The Minister may refuse to register any trade mark:—

- (a) If he is not satisfied that the applicant is undoubtedly entitled to the exclusive use of such trade mark;
- (b) If the trade mark proposed for registration is identical with or resembles a trade mark already registered;
- (c) If it appears that the trade mark is calculated to deceive or mislead the public;
- (d) If the trade mark contains any immorality or scandalous figure;
- (e) If the so-called trade mark does not contain the essentials necessary to constitute a trade mark properly speaking. 54-55 V., c. 35, s. 1.

Refer to English Law for Definition of Trade-Mark.—

The classification of Section 5 does not constitute a definition of trade-marks. For this purpose, reference must be had to English Law (*Standard Ideal Co. v. Standard Sanitary Manufacturing Co.*, (1911) A. C. 78.)

It is necessary, however, to use the English decisions with care, especially those since 1875, which are generally limited to interpretation of the definition of registrable trade-marks found in the Trade-Marks Registration Act of 1875 and subsequent Acts.

Lord Cranworth in *Leather Cloth Co. v. American Cloth Co.*, 35 L. J., Ch. 61, gives the following definition:

“A trade-mark, properly so-called, may be described as a particular mark or symbol, used by a person for the purpose of denoting that the article to which it is affixed is sold or manufactured by him or by his authority or that he carries on business at a particular place.”

Mr. Justice Clifford in *McLean v. Fleming*, 69 U. S. 245. 254, said: “A trade-mark may consist of a name, symbol, letter, form or device, if adapted and used by a manufacturer or merchant in order to designate the goods he manufactures or sells, to distinguish the same from those manufactured or sold by another, to the end that the goods may be known in the market as his and to enable him to secure such profits as result from his reputation for skill, industry, and fidelity.”

English Act of 1905.—Section 9 of the present English Act that of 1905 reads:

9. A registrable trade mark must contain or consist of at least one of the following essential particulars:—

(1) The name of a company, individual or firm represented in a special or particular manner;

(2) The signature of the applicant for registration or some predecessor in business;

(3) An invented word or invented words;

(4) A word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification, a geographical name or a surname;

(5) Any other distinctive mark, but a name, signature, or word or words, other than such as fall within the description in the above paragraphs 1, 2, 3, and 4 shall not except by order of the Board of Trade, or the Court, be deemed a distinctive mark.

Distinctions between English and Canadian Acts.—It is clear that the above definition imposes limitations not in the Canadian Statute. In the Supreme Court in *New York Herald v. Ottawa Citizen*, (1908) 41 S. C. R. 229, affirming 12 Ex. C. R. 229, Idington, J., said: “Our statutes and the English Acts are so different that, except for the fundamental purpose of determining whether any device used, may in its manner of use, be or not be a subject of such property as exists in law in trade-mark, the English cases are not very helpful.”

Distinctions between the Canadian and English Statutes have been pointed out in *Smith v. Fair*, 14 Ont. R. 729; *Provident Chemical Works v. Canadian Chemical Co.*, 4 O. L. R., at p. 549; *Fruitatives v. La Compagnie Pharmaceutique de La Croix Rouge*, (1912) 14 Ex. C. R. 30; 8 D. L. R. 917.

The more important distinctions are:

(1) The Canadian Act makes all marks, names, labels, brands, packages, or other business devices "which contain the essentials necessary to constitute a trade-mark" registrable. The English Registration Acts define what trade-marks are registrable. Most of the English decisions are concerned with the interpretation of the definition of the Act and not with the broad question of what constitutes the essentials of a trade-mark. Unregistered trade-marks, only come into Court in England, in "passing off" and "unfair competition" actions where other facts than the character of the trade-mark influence the decision.

(2) The Canadian Act not merely makes the registration prima facie evidence of ownership and right to use but states (Section 13) that after registration the proprietor "shall have the exclusive right to use the trade-mark to designate articles manufactured or sold by him."

(3) The Canadian Statute provides no statutory classification. It provides a general division, however, between "general" and "specific" trade-marks. The former endure perpetually.

(4) The provision of the Canadian Statute with respect to assignments, do not require the assignment to be only made in connection with the good-will as under the English enactments.

Property in Trade-Marks.—The property which a manufacturer or merchant obtains in a mark which he applies to articles made, or sold, by him with the intention that the mark should indicate they are of his manufacture or selection, has long been supported by English Courts, and invasions against this right of property protected, (*Ransome v. Graham*, 51 L. J. ch. 897; *Millington v. Fox*, 838, 3 My. & Cr. 338; *Hall & Barrows*, 4 De. G. J. & S. 150).

Lord Langdale said, in *Perry v. Truefitt*, 6 Beav. 66:

“A man is not to sell his own goods under the pretence that they are the goods of another man; he cannot be permitted to practise such a deception, nor to use the means which contribute to that end. He cannot, therefore, be allowed to use names, marks, letters, or other indices which may induce purchasers to believe that the goods which he is selling are the manufacture of another person.”

The protection thus afforded by the Courts is for the benefit of the public as well as of the owner of the trade-mark. The public have a right to assume that goods to which a trade-mark has been applied are genuine manufactures of the owner of the trade-mark.

In *Davis v. Kennedy*, (1867) 13 Grant 523, the judgment quotes with approval the following words of Lord Cranworth in *Farina v. Silverlock*, (1856) 6 De G. M. & G. 214:

“ . . . I apprehend that the law is perfectly clear, that any one who has adopted a particular mode of designating his particular manufacture, has a right to say, not that other persons shall not sell exactly the same article, better or worse, or an article looking exactly like it, but that they shall not sell it in such a way as to steal (so to call it) his trade-mark and make purchasers believe that it is the manufacture to which that trade-mark was originally applied.”

Functions of a Trade-Mark.—Bowen, R. J., in *In re Powell*, (2) (1893) 2 Ch. 388, said the functions of a trade-mark were “to give an indication to the purchaser or possible purchaser as to the manufacture or quality of the goods—to give an indication to his eye of the trade source from which the goods come, or the trade hands through which they pass on their way to the market.” A trade-mark has thus the function of giving the purchaser assurance as to the make and quality of the article purchased. (*Spottiswoode v. Clarke*, 2 Ph. 154.)

In the leading case of *Partlo v. Todd*, in the Supreme Court, (1886) 17 S. C. R. 196, Gwynne, J., said:

“The right which a manufacturer has in his trade-mark is the exclusive right to use it for the purpose of indicating where and by whom or at what manufactory the article to which it is attached was manufactured. A man may mark goods of his own manufacture either by his name or the initials of his name, or by using for the purpose any

symbol or emblems, however unmeaning it may be in itself, and if such symbol comes by use to be recognized in the trade as the mark of the goods of a particular person no other person has the right to stamp his goods of a like description with a mark so resembling the mark of the former as to be likely thereby to induce incautious purchasers to believe that they are buying the goods of the former; but no person can acquire property in any marks, names, letters, or symbols which are known in the trade as designating the quality merely, wholly irrespective of the goods to which they are affixed being the manufacture or stock-in-trade of any particular person."

A Trade-Mark Must Be Distinctive.—To perform its proper function, a trade-mark must be distinctive. In the words of the statute, it must be "adopted for the purpose of distinguishing." If a trader adopts a word which when used does not as a matter of fact distinguish his goods from those of any other trader, as for example when he applies a common descriptive adjective thereto, he cannot successfully claim the exclusive use of such word. He cannot be permitted to exclude others from the use of words common to all.

Descriptive Words.—Descriptive words are not distinctive. A common English word having reference to the character and quality of the goods in connection with which it is used, cannot, therefore, be an apt or appropriate instrument for distinguishing the goods of one trader from those of another. (*Standard Ideal Co. v. Standard Manufacturing Co.*, (1911) A. C. 78,—the word "Standard" as applied to bath room fixtures held descriptive.)

The following comprehensive and general statement of the law is found in *Partlo v. Todd*, 17 S. C. R. 196:

"All manufacturers of the same description of goods have equal right to use such marks, names, etc., as are known in the trade as designating quality, and each in such case can only acquire property in some name or mark used by him in connection with such indicia of quality as aforesaid, as will indicate that the particular article of the designated quality is of his manufacture; and if an article originally manufactured by a particular person comes to be known in the trade by the name of such person, not as expressing the maker of the particular specimen but as describing the nature of the article by whomsoever made, every person has a right to manufacture the article bear-

ing such name and to sell it by that name. This was one of the canons laid down by Lord Kingsdown in *American Leather Cloth Co. Case* (1865) 11 Jur. N. S. 517.

So likewise, no property can be acquired by any person in any English word, which is expressive of quality merely stamped upon the goods of his manufacture; this was the case of *Raggett v. Findlater* (1873) L. R. 17 Eq. 29, in which it was held that a person could acquire no property or trade-mark in the words "nourishing" stout or "nourishing" London stout, but that the words added showing the name of the dealer in the article and the words "analysed and reported on Dr. Hassall" were the words in which the party originated them on the stout sold by him might acquire property as his trade-mark. But a foreign word or a word in a dead language not known to people in general, because it is not understood, may become the trade-mark of the person who first uses it upon a particular article sold by him; this was the case in *McAndrew v. Bassett* (1864) 4 De G. J. & S. 380; so in *Wotherspoon v. Currie* (1872) L. R. 5 H. L. 508, where the plaintiff had first applied the word "Glenfield" to the starch, and under that name had introduced into the market starch manufactured by him which, under that name, had acquired celebrity in the trade; it was held that he had thereby acquired a property in the word "Glenfield" as applied to starch. Upon the same principle the court proceeded in *Braham v. Bustard* (1863) 1 H. & M. 447 with regard to "Excelsior White Soft Soap"; and in *Ford v. Foster* (1872) 7 Ch. App. 611, with regard to the "Eureka" shirts. All these cases are commended upon and the principle upon which they proceeded explained by Malins. V. C. in *Raggett v. Findlater* (1873) L. R. 17 Eq. 29. . . .

. . . . So no property can be acquired in the letters X, XX or XXX, applied to beer as a trade-mark, for these letters are known to be used in the trade as designating merely the strength of the beer to which they are affixed, wholly irrespective of the person by whom the beer can be manufactured. So neither can property be acquired in the use of a crown or horseshoe or any marks or words in connection with manufactures of iron which are used in the iron trade to designate a particular description or quality of the manufacture in iron on which they are stamped but the names or initial letters of the name of the firm which manufactures or deals in the article, in connection with any symbol, designating the description or quality of the iron used in the manufacture of the article, will constitute good trade-marks, as they will also when used in connection with the letters X, etc., on beer.

So far as the letters, symbols or words claimed are descriptive of quality they cannot be trade-marks—no property can be acquired therein—but when they are connected with the initials of the firm or the name of the works where the article is manufactured the whole combination constitutes one trade-mark: In *re Barrows Trade-Marks* (1877) 5 Ch. D. 363."

In the following decisions the words referred to have been held descriptive: *Young v. Macrae*, (1862) 9 Jur. N. S. 322 ("Paraffin Oil"); *Liebig's Extract of Meat Co. v. Hanbury*, (1867) 17 L. T. N. S. 298 ("Liebig's Extract of Meat") in re *Hudson*, (1886) 32 Ch. D. 311 ("Carbolic Acid Soap Powder"); In re *Dunn*, (1890) 15 App. Cas. 252 ("Fruit Salts"); *Caswell v. Davis*, (1874) 58 N. Y. 223 ("Ferro-phosphorated Elixir of Calisaya Bark"); In re *Price's Candle Co.*, (1884) 27 Ch. D. 681 (National "Sperm" Candles); *McCall v. Theal*, 28 Grant 48 ("Bazaar Patterns for Clothing"); *Rumford Chemical Works v. Muth*, (1888) 35 Fed. Rep. 524 ("Acid Phosphate"); *Bowker Fertilizer Co. v. Gunn's Limited*, (1916) Ex. C. R. ("Sure Crop" for Fertilizers); *California Fig Syrup Co. v. Putnam*, (1895) 69 Fed. Rep. 740 ("Fig Syrup").

In some cases the descriptiveness is not quite so apparent. The words "Staz-on" and "Shur-on" possess some distinctiveness, but the Supreme Court held, *Kirstein v. Cohen*, 39 S. C. R. 286:

"The hyphenated coined words "shur-on" and "staz-on" are not purely inventive terms, but are merely corruption of words, descriptive of the goods (in this case eye-glass frames) to which they were applied, intending them to be so described and therefore they cannot be properly the subject of exclusive use as trade-marks."

Where the descriptiveness is quite remote or merely suggestive as in the word "Fruitatives" as applied to a laxative medicine the trade-mark may be supported. *Fruitatives, Ltd. v. La Compagnie Pharmaceutique De La Croix Rouge, Ltd.*, (1912) 8 D. L. R. 917; 14 Ex. C. R. 30.

Geographical Names.—Geographical names which can be regarded as descriptive of the place of manufacture or sale of the goods are open to the same objection as descriptive words. Any trader in a given locality has the right to make use of the name of that locality as the place of origin of his goods. The term "Caledonia Water" was not supported as a trade-mark applied to water from Caledonia Springs. *MacLennan, J. A.*, said:

"Now the defendants have an undoubted right to describe their water correctly and truthfully. It is a saline mineral water. It is

derived from new springs and those springs are in the Township of Caledonia, and they are at a place called Caledonia Springs. If the defendants' water is likely to be more sought and more marketable, and if the licenses of selling it is likely to be more profitable by reason of the situation of the springs and their nearness to the famous old springs the defendants are entitled to the benefit of that."

(Grand Hotel Co. v. Wilson & Tune, 23 C. L. T. 82; 5 O. L. R. 141 affirmed (1904) A. C. 103; see also Robinson v. Bogle, (1889) 18 O. R. 387.)

Sometimes, however, through long-continued and undisputed use, a secondary or trade-mark meaning may be acquired by a geographical word which will make it a good trade-mark. (Re Bucyrus Trade-Mark, (1912) 14 Ex. C. R. 35; 8 D. L. R. 920; Wotherspoon v. Currie, (1892) L. R. 5 H. L. 509.)

It is to be observed, however, that a word is not to be regarded as geographical unless its primary significance is geographical, and has been recognized as such. (In re Magnolia Metal Co., (1897) 2 Ch. 371; see also In re Appolinaris Co., Ltd., (1891) 2 Ch. 186; McAndrew v. Bassett, (1864) 10 Jur. N. S. 550.) In Rose v. McLean Publishing Co., (1895) 24 A. R. 240, in which the name, "The Canadian Bookseller and Library" was in question. Burton, L. A., after discussing the cases said:

"It is by no means universally true that a person cannot appropriate the name of a geographical district as a trade-mark name: see Newman v. Alvord (1872) 51 N. Y. 189, 10 Am. R. 588; Congress & Empire Spring Co. v. High Rock Congress Co. (1871) 45 N. Y. 291; and several other cases referred to in Mr. Brown's work on Trade Marks.

In the present case, it seems to me, in the selection of the word "Canadian," the plaintiff chose merely a fanciful name. It is true the selection was made so in consequence of the journal being gotten up in the interest and for the information of the trade in Canada, but it indicates no product, no locality for the production of a specific article, no manufacture of any particular country. It is not necessary, therefore, as in some of the cases to which I have referred, to seek a secondary meaning; as a mark for this journal it was purely arbitrary, and is in no manner descriptive of any article of any manufacture."

Surnames.—A signature or a surname printed in a distinctive form is a good trade-mark. (Welch v. Knott, 4

K. & J. 707; *Massam v. Thorley's Cattle Food Co.*, 6 Ch. D. 748.) A trader may do business under a name other than his own, or under a fancy name and acquire trade-mark rights in it. (*Love v. Latimer*, 32 O. R. 231; *In re Holt*, (1896) 1 Ch. 711, re "Trilby.") A fictitious name may be used. (*Templeton v. Wallace*, 4 Terr. L. R. 340.)

A surname not represented in any special or distinctive manner is not ordinarily a good trade-mark. Its use is natural, but open to the inconvenience that there may be other traders in the same business with the same name. In *Ainsworth v. Walmsley*, (1866) L. R. 1 Eq. 518, Sir W. Page Wood, V. C., at p. 525 says: "Then, is not a man's name as strong as instance of trade-mark as can be suggested? Subject only to this inconvenience, that if a Mr. Jones, or a Mr. Brown relies on his name, he may find it a very inadequate security, because there may be several other manufacturers of the same name." (*Burgess v. Burgess*, (1853) 3 De. G. M. & G. 896; *Tussaud v. Tussaud*, (1890) 44 Ch. D. 678; *Aikens v. Piper*, (1869) 15 Grant 581.) It is open for any person of the same family name to use it. (*Slater Shoe Co., Ltd. v. The Eagle Shoe Co.*, (1910) 16 R. L. N. S. 474.)

Where a trader has, however, been long permitted to enjoy the exclusive use of a given surname, and where through such extended use and trade it has acquired a secondary trade-mark meaning in the trade, then his use of it may be protected and the name is entitled to registration. (*In re Elkington & Co.'s Trade-Mark*, 11 Ex. C. R. 293; *Gramm Motor Truck Co. v. Fischer Motor Co.*, (1913) 17 D. L. R. 745.) When it is sought to register a surname by reason of a secondary or distinctive meaning having been acquired, it is necessary to make application to the Exchequer Court. There is no machinery provided by which questions of this kind can be determined within the Department.

Surnames have had a somewhat chequered career before the English Courts. The contention that a surname in the possessive case was "in some particular or distinctive manner" and hence registrable under the Act, was

disposed of in *Pirie v. Goodall*, (1892) 1 Ch. 35, 9 R. P. C. 17. Under section 9 (5) of the British Act of 1905 surnames could be registered by order of the Board of Trade upon evidence of distinctiveness being produced. The registrability of surnames under this section was first questioned in the matter of the application of Pope's Electric Lamp Co., Ltd., for a trade-mark (28 R. P. C. 629) where Mr. Justice Warrington held "that the name 'Pope'" was in its nature not "adapted to distinguish" the goods of the applicants from those of other persons of the name of Pope who might at any time carry on trade in the goods. Later, Mr. Justice Joyce refused "McEwan's" and "Boardman's" on the same grounds. (Application of R. T. Lea, Ltd., and application of William McEwan & Co., Ltd., 29 R. P. C. 165.)

The Court of Appeals confirmed this decision but on the grounds that "the evidence fell far short of that which was required to prove distinctiveness within section 9," and that the word "Boardman's" was not "adapted to distinguish."

In the *Teofani Case* (1909) (30 R. P. C. 440) the Board of Trade made an order for the registration and this was reviewed by the Court of Appeals and supported. The Master of the Rolls in his judgment said: "It is only in very exceptional circumstances that a surname-application ought to be allowed to proceed. . . . If, as I think a surname is not incapable of being a registrable trade-mark, it seems to me that the present is one of those exceptional cases in what the order of the Board of Trade cannot be considered improper, although even in this case I think the Board of Trade might well have refused the application. The name 'Teofani' is very uncommon, and the user of that name as a trade-mark for twenty years at least has been so extensive as to have made it in fact distinctive for cigarettes."

Following this Mr. Justice Neville in the *Cadbury Case* (32 R. P. C. 9) found "Cadbury" to be a distinctive mark for confectionery, and "adapted to distinguish" the applicant's goods.

The words "adapted to distinguish" do not occur in the Canadian Act. Section 5 refers to "names" which are "adopted for use . . . for the purpose of distinguishing." It would appear that the rather fine question of whether or not a given word is intrinsically "adapted to distinguish" the goods of the applicant does not arise in Canada as in England.

The Supreme Court in *Canada Publishing Co., Ltd., et al. v. Gage*, (1885) (11 S. C. R. 306) held the plaintiff entitled to the exclusive use of the name "Beatty" in connection with copybooks.

The Court of Queen's Bench for Quebec (in *Thompson & MacKinnon*, (1882) 21 L. C. J. 335) supported the phrase "MacKinnon's Biscuits" as a trade-mark. Cross, J., said: "The name thus used is not the individual designation of John MacKinnon, the assignor of the rights, but is merely the generic name of the MacKinnon clan, as such there can be no valid objection to its having become a trade-mark for distinguishing a particular manufacture of biscuits."

Rival traders of the same name are required to take means to distinguish their goods from those of the earlier trader who has acquired trade-mark rights in the name. (*Canadian Publishing Co. v. Gage*, (1883) 11 S. C. R. 306; *Thompson v. McKinnon*, (1877) 21 L. C. J. 355; *Montreal Lithographing Co. v. Sabiston* (1899) 3 R. de J. 403; *Cash v. Cash*, (1900) 84 L. T. 349.)

Invented or Fancy Names.—A large class of trade-marks consist of "invented" or "fancy" names. The latter term has been given a limited signification by the English Courts.

Lindley, R. J., in *In re Van Duzen*, 34 Ch. D. 623, said:

"To be a "fancy word" the word must either have to ordinary English people, to whom the Act is addressed, no meaning, like the word "Eureka," or the word "Aeilylon," or, if it has any meaning at all, it must be obviously non-descriptive when used as the trade-mark."

It has not been necessary in Canada to place such a restricted meaning on this class of trade marks. Sprague,

V. C., in *Davis v. Kennedy*, (1862) 13 Grant, found the word "Pain-killer" to fall within this class as being a "fancy" name or "trade-mark" arbitrarily selected to catch the eye or ear of the public and to distinguish the article of a particular manufacturer.

For other Canadian cases on "fancy" or specially distinctive words see *Radam v. Shaw*, (1897) 28 O. R. 612, re "Microbes Killer"; *Crawford v. Shuttock*, (1867) 13 Grant 149, re "Imperial"; *Provident Chemical Works v. Canada Chemical Works*, (1902) 4 O. L. R. 545, re "C. A. P."

"Invented" Words.—Frequently the word used by a manufacturer is an entirely new one, invented by him for the purpose. This forms perhaps the best kind of trade-marks; certainly the most secure (e. g., Solio, for photographic paper, in *re Eastman Co., Ltd.*, (1898) A. C. 571; "Kodak" for cameras and accessories, *Eastman Co., Ltd. v. Griffiths Corporation, Ltd.*, 15 R. P. C. 105; in *re Kodak, Ltd.*, 20 R. P. C. 337.) If the word be an invented one, the quantum of invention is not material. It may sometimes be difficult to determine whether a word is an invented one or not.

The new combination of two or more English words, or a mere variation in the orthography or termination of a word will not generally be sufficient to constitute an invented word (e. g., "Shur-on" and "Staz-on," *Kerstein v. Cohen*, 39 S. C. R. 286).

"Devices."—Another large class of trade-marks consist of distinctive "devices." Originally trade-marks were probably all symbols of one form or another. The representation of some natural object, mathematical figures or the like frequently constitutes valuable and widely known trade-marks (e. g., an anchor, *Edelsten v. Edelsten*, 1 De. G. J. & S. 185; a lion, *Henderson v. Jorss*, Dig. 198; a bell, *Bell, Black & Co. v. Wall & Co.*, Dig. 514; a horse head, *Barslou v. Darling*, (1881) 9 S. C. R. 677; a crest, *Beard v. Turner*, (1886) 13 L. J. N. S. 746; and note, *De Kuyper v. Van Dulken*, (1894) 24 S. C. R. 114.)

Under this class comes a man's own portrait. (*Rowland v. Mitchell*, (1897) 1 Ch. 71); or a monogram or a seal, *Smith v. Fair*, (1887) 14 O. R. 729. A portrait, however, may lose its distinctiveness if it is of a person whose name has become descriptive of goods.

Initials may form a trade-mark. (*Re Anderson*, 26 Ch. D. 409; "C. A. P." in *Provident Chemical Works*, (1902) 4 O. L. R. 545; "A. F. S.," *Smith v. Fair*, (1887) 14 O. R. 729; "C. R. C.," *Robin v. Hart*, (1891) 23 N. S. 316; in *Doran v. Hogadore*, 11 O. L. R. 321, the trade-mark consisted of the letter "D" alone.)

Marks which have a mechanical purpose to serve, such as guides for the sub-division of the article cannot be exclusively appropriated by one trader. (*Dansman & Drummond Tobacco Co. v. Ruffner*, 15 O. G. 559.)

The English Hall Mark is not a good trade-mark in Canada. (*Gorham Mfg. Co. v. Ellis*, 8 Ex. C. R. 401.)

A device which represents the article itself is in a sense descriptive and has been so held in the United States cases, *Tucker Mfg. Co. v. Boyington*, 9 O. G. 455; *In re Pratt v. Farmer*, 10 O. G. 866. There are no Canadian authorities on this point. The law in England on this point appears to be still in doubt. (See *Sebastian*, 5th Ed., p. 51; *Kerly*, 4th Ed., p. 209; *Re James*, 3 R. P. C. 340.)

Name of Patented or New Article.—The name given to a patented article by the patentee may after the expiration of the patent be used by other traders. *Treat, J.*, in *Singer Mfg. Co. v. Stanage*, 2 McCrary 512, said: "Where a patented article is known in the market by any specific designation, whether of the name of the patent or otherwise every person at the expiration of the patent has a right to manufacture and vend the same under the designation thereof, by which it was known to the public." See also *Singer Mfg. Co. v. Wilson*, 2 Ch. D. 434; *Singer Mfg. Co. v. Sophie-Charlebois*, (1899) Q. R. 16 S. C. 167; *Linoleum Mfg. Co. v. Nairn*, L. R. 7 Ch. D. 834.

Where no patent is obtained a person who, producing a new article, gives it a name by which it becomes known on the market, cannot prevent another person, who can pro-

duce the same article, from calling it by that name, (e. g., Valvoline, In re Leonard & Ellis, 26 Ch. D. 288; Albion, In re Harrison, McGregor & Co., 42 Ch. D. 691; but see contra "Vaseline," In re Cheeseborough Mfg. Co., (1902) 2 Ch. 1.

Words "Publici Juris."—Words which originally are capable of appropriation as trade-marks may through widespread use become "common" to the trade. In *Watson v. Westlake*, (1886) 12 O. R. 449, it was found that the word "Imperial" had become a common brand for cough candy and its use as a trade-mark could not be protected. *Smith v. Fair*, (1887) 14 O. R. 729, decided that words as "Red" and "Seal" even if such were admitted to be publici juris might when combined and applied to a specific manufacture cease to be so. In *Wilson v. Lyman*, 25 A. R. 303, the word "pad" in "Wilson's Fly Poison Pad" was held to have become in such a measure "publici juris," that the defendants were entitled to call their poison sheets "pads."

"Deceptive" Words.—A word which if not descriptive is deceptive is not a valid trade-mark. In re *Saunion & Co.*, Dig. 625, the words "Anglo-Portugo Oysters" were descriptive if the oysters were Anglo-Portugo and deceptive if they were not.

It is not deceptive, however, for a person to adopt a fictitious name as part of his trade-mark so long as there is no intention to deceive. In *Templeton v. Wallace*, (1900) 4 Terr. L. R. 340, pills were sold under the name "Simpson's Kidney Pills," and the trade-mark sustained, though the name "Simpson" was fictitious.

Royal Arms or Portrait.—There is no statutory prohibition in Canada against the use of the word "Royal," the Royal Coat of Arms or the portrait of His Majesty, and the English practice does not apply. In *Spilling v. Ryall*, 8 Ex. C. R. 195, *Burbridge, J.*, said: "It is contended for the defendant, however, that the plaintiffs' registered trade-mark is not good because it contains a representation of His Majesty and also of the Royal Arms. That

contention is based upon the English practice in such matters. By the thirtieth paragraph of the instructions to the persons who wish to register trade-marks under the Act of Parliament of the United Kingdom, it is provided that where the mark had not been used before the 13th of August, 1875, no trade-mark will be registered if it, or a prominent part of it consists of 'The Royal Arms,' or Arms so nearly resembling them as to be calculated to deceive; representations of Her Majesty the Queen, or of any member of the Royal Family; representations of the Royal Crown or the National Arms or flags of Great Britain." Sebastian's Law of Trade-Marks, 4th ed., 335, 468. But that rule or prohibition is not in force in Canada. It is not one of the grounds on which under the Canadian Statute, R. S. C., c. 63, s. 11, as amended by 54-55 Vict., c. 35, the Minister of Agriculture may refuse to register a trade-mark; and even if it were thought that such a regulation could be made without an amendment of the Act R. S. C., c. 63, s. 6, no regulations have been made. In the absence of any such provisions as that referred to the objection fails."

The head note in this case reads: "A label, as applied to boxes containing cigars, bearing upon it 'in an oval form, a vignette of King Edward VII., with a coat of arms on one side, and a marine view on the other, surmounted by the words, "Our King," and with the words, "Edward VII." underneath, constitutes a good trade-mark in Canada, and may be infringed by the impression, upon boxes containing cigars, of a fac-simile of the Royal Arms surmounted by the words "King Edward."'"

In *Spilling v. O'Kelly*, 8 Ex. C. R. 426, it was held that no right could be obtained to the term "King" and representation of some particular king.

English Hall Mark.—Any mark such as the sterling silver "hall mark" which has a recognized and well known meaning in the trade, cannot be appropriated as a trade-mark by any individual trader. In *Gorham Manufacturing Company v. Ellis & Company*, 8 Ex. C. R. 401, the plaintiffs brought an action for the infringement of their

registered specific trade-mark, to be applied to goods manufactured by them from sterling silver which it was thought so resembled the Birmingham Hall Mark, or a hall mark, as to be calculated to deceive or mislead the public, and it appeared that during the time that the plaintiffs' goods, bearing such mark, were upon the Canadian market, goods bearing the Birmingham Hall Mark were also upon the market here:—Held, that the plaintiff could not, under the circumstances acquire the exclusive right to the use as a trade-mark of the mark.

Trade Union Labels.—Many trade unions adopt distinctive forms of labels authorized to be applied by their members or by the employers of their members to goods manufactured by them. The objection to such labels as trade-marks was put in the following terms by Judge Thayer, in *Carson v. Ury*, 39 F. 777:

“It is no doubt true that the union label does not answer to the definition ordinarily given to a technical trade-mark, because it does not indicate with any degree of certainty by what particular person or firm the cigars to which it may be affixed were manufactured, or serve to distinguish the goods of one cigar manufacturer from the goods of another manufacturer, and because the complainant appears to have no vendible interest in the label, but merely a right to use it on cigars of his own make, so long and only so long as he remains a member of the union. In each of these respects the label lacks the characteristics of a valid trade-mark.”

In New York decision of *People v. Fisher*, (50 Hun. 552, 3 N. Y. Suppl. 786, 20 N. Y. St. 537) the following reasons are given in support to such labels as trade-marks:

“First. The only recognized indication of a trade-mark is the source, origin or ownership of the article of merchandize on which it is placed. . . . This means that the trade-mark is calculated to distinguish the articles which bear it from those of other makers or vendors. It need not indicate any particular person as maker, manufacturer or vendor, or give the name or address of either. When the mark has become recognized by purchasers as a distinctive description of a particular maker, manufacturer, or seller of a certain quality of goods, it will be sufficient indication of the origin or ownership within the rule requisite to its protection as such, although purchasers may not from the work or otherwise be able to tell who is particular maker or seller of the article. . . .

“Second. The fact that the goods are produced by the work of

one person in the service of another to whom they belong, and that a label cannot be placed upon them without the consent of the owner, does not seem to be in the way of the right of the workmen through the means of a trade-mark which he may have devised and caused to be affixed to the product of his labor, to have property in such trade-mark entitled to protection as such. . . .

"Third. The fact that their work is not performed under a single employment, but under many different employers in as many widely separated shops, may go to the value of the mark in its application to the cigars made by them, rather than to the rights to its protection as such."

The United States cases are conflicting. A detailed examination of them may be found in Sec. 356 et seq. of Martin on The Modern Law of Labor Unions (1910). Mr. Martin reaches the conclusion that while there is a right of property in union labels, they cannot be supported as technical trade-marks. Courts of equity have in numerous instances protected union labels where there appears to have been a design to deceive the public by concealing the true origin of the goods and to make it appear that they were the goods of another. (*Weener v. Brayton*, 152 Mass. 101; *Lawlor v. Merritt*, 78 Conn. 629; *Tracy v. Banker*, 170 Mass. 266.) The label in such cases has been viewed as a property right of the Union in which all the members have a common interest. (*Hetterman v. Powers*, 102 Ky. 133; *State v. Hazen*, 6 Ind. App. 167; *Strasser v. Moonelis*, 55 N. Y. Sup. Ct. 197.) In many States, legislation has been enacted especially protection labels of trade Unions from infringement.

In Great Britain, a provision for the Registration of Standardization or certification marks by order of the Board of Trade, was introduced for the first time by the Trade-Marks Act (1905), section 62 of which reads in part:

"Where any association or person undertakes the examination of any goods in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristic, and certifies the result of such examination by mark used upon or in connection with such goods the Board of Trade may, if they shall judge it to be to the public advantage permit such association or person to register such mark as a trade-mark in respect of such goods, whether or not such association or person be a trading association or trader or possessed of a good will in connection with such examination or certifying"

There is no corresponding provision in the Canadian Statute and the present practice of the Department is not to register such labels. It may be noted, however, that this practice conflicts with the case of *Todd v. Brener* in the Chancery Division at Toronto, (29 L. R. A. 202, note, *Cigar Makers' Official Journal*, March, 1891).

There would not appear to be much difficulty in finding a trade Union entitled to register a trade-mark if properly entitled thereto. Trade Unions are usually voluntary associations and as such can own property as well as can a partnership (*Cigar Makers' Union No. 1 of Baltimore v. Link*, 29 L. R. A. 203). While section 5 of the Trade-Mark and Design Act refers to trade marks adopted for use by any "person" the operative section A refers only to any "proprietor." It would not seem necessary, therefore, to consider whether a voluntary association was a "person" within the Act.

It would also appear that the language of Section 5 of the Act—"all marks adopted for use by any person in his trade, business, occupation, or calling, for the purpose of distinguishing any manufacture manufactured, produced, compounded, packed, or offered for sale by him"—was sufficiently broad to include Union labels, provided they contain "the essentials necessary to constitute a trade-mark" as called for by section 11.

CHAPTER III.

CLASSIFICATION—GENERAL AND SPECIFIC TRADE-MARKS.

The classification of trade-marks in Section 5 of the Act into "Marks, names, labels, brands, packages or other business devices" is of little value.

"Marks" and "Names" have been discussed in the previous chapter.

Labels.—"Labels" are impressions of trade-marks on paper or other substances which may be attached to the article sold or the package containing them. *Wotherspoon v. Currie*, (1872) L. R. 5 H. L. 508. On a label the trade-mark is frequently accompanied by ornamentation or printing relative to the use or merits of the article sold. A certain trade-mark right may be acquired in the arrangement of the letter-press, ornamentation, and coloring, irrespective of the trade-mark word or design proper. *Day v. Binning*, C. P. Cooper 489; *Wolfe v. Alsop*, 10 V. L. R. (E) 41; *Franks v. Weaver*, 10 Beav. 297. For Canadian cases involving labels, see *Robin v. Hart*, 23 N. S. 316; *Templeton v. Wallace*, 4 Terr. L. R. 340; *In re Melchers*, 6 Ex. C. R. 82; *Spilling v. Ryall*, 8 Ex. C. R. 195; *Grand Hotel v. Wilson*, (1904) A. C. 103; *Annheuser-Busch Brewery v. Edmonton Brewery & Malting Co.*, (1910) 15 W. L. R. 421, (1911) 16 W. L. R. 547; *Fafard v. Ferland*, 6 Qué. P. R. 119.

Brands.—"Brands" under the English Acts has been interpreted to refer to cases in which the trade-mark is branded on the goods or their containers. *Motley v. Douman*, (1873) 3 My. & Cr. 1; *Seixo v. Provezende*, (1863) L. R. 1, Ch. 192. The following cases in Canada involved "brands" of one form or another: *De Kuyper v. Van Dulken*, 24 S. C. R. 114; *Boston Rubber Shoe Company v. Boston Rubber Co.*, 32 S. C. R. 315; *Davis v. Reid*, 17 Grant 69; *Barsalou v. Darling*, 9 S. C. R. 677.

Packages.—"Packages" may refer to some shape or design of package which are sufficiently distinctive to be supported as a trade-mark. In the United States, a particular shape of barrel, bottle, box, parcel, etc., is no trade-mark for the goods contained in it. *Moorman v. Hoge*, 2 Lawy. 78; *Babbit v. Brown*, 75 N. Y. Sup. Ct. 515. In England, imitation of package has been restrained in "passing off" rather than in trade-mark actions. *Great Tower Street Tea Co. v. Langford & Co.*, 5 R. P. C. 66; *Day v. Riley*, 17 R. P. C. 517. There are no cases in Canada on this point. It may be that our courts will find our statute has enlarged the field within which distinctly trade-mark rights will be protected beyond that covered in England.

Business Devices.—"Other Business Devices" refer to mechanical devices capable of use as trade-marks, or to designs forming a subsidiary class of "marks." The qualifying adjective "business" would appear to indicate that something more than a "device" or a design marked on the goods is meant. If so it could give a wide range to trade-mark protection. In *Smith v. Fair*, 14 O. R. 729 a seal of wax to be used on a cigar box was held a good trade-mark within the terms of the statute.

General and Specific Trade-Marks.—The classification into "general" and "specific" trade-marks provided by Sections 4 and 16 and 17 is more important.

These sections read:

Section 4.—4. In this Part, unless the context otherwise requires,—

(a) "General trade-mark" means a trade-mark used in connection with the sale of various articles in which a proprietor deals in his trade, business, occupation or calling generally;

(b) "Specific trade-mark" means a trade-mark used in connection with the sale of a class merchandise of a particular description. R. S., c. 63, s. 4.

Section 16.—16. A general trade-mark once registered and destined to be the sign in trade of the proprietor thereof shall endure without limitation.

Section 17.—17. A specific trade-mark, when registered shall endure for the term of twenty-five years, but may be renewed before the expiration of the said term by the proprietor thereof, or by his legal representative, for another term of twenty-five years, and so on from

time to time; but every such renewal shall be registered before the expiration of the current term of twenty-five years. R. S., c. 63, s. 14.

General Trade-Mark.—A general trade-mark is “designed to be the sign in trade of the proprietor,” and covers all classes, and endures perpetually. The Act does not define what is meant by a general trade-mark. Two recent judgments in the Exchequer Court have cleared part of the ground. In the case of *In re Noelle's Trade-Mark*, (1913) 14 Ex. C. R. 499, 14 D. L. R. 385, the petitioner, manufacturers of forks and spoons made of Britannia metal, sought to register the word “Albaloid” as a general trade-mark in the face of a general trade-mark “Albolene” already registered by McKesson & Robbins, wholesale druggists.

Cassels, J., in delivering judgment, said:

It is not contended that the word “Albaloid” could be registered with the word “Albolene” previously registered as a general trade-mark, if the question merely depended on the register and without further evidence.

Under clause 11, sub-sec. (b) of the Trade-Mark and Design Act, the application was rightly rejected.

The Minister or his deputy has no means of ascertaining except from the registry whether such trade-mark should or should not be registered. There is no power in the statute regulating trade-marks which enables the Minister or his deputy to take evidence and adjudicate on the facts and to determine whether having regard to the particular circumstances of the case, such trade-mark should be registered or not. . . .

. . . . It would appear that the applicants have registered in England and elsewhere the word “Albaloid” as their trade-mark. It does not appear that this word has been registered in these countries as a general trade-mark, and I am not aware whether the statutes in these various countries contain the same provisions as in our statute, enabling the registration of a general trade-mark as distinguished from a specific trade-mark.

These foreign trade-marks are not produced. I gathered from Mr. Scott's careful argument that the clause of our statute permitting a registration of a general trade-mark is unique.

Under the Imperial Trade-Marks Act, 1905, sec. 8, it is provided that “a trade-mark must be registered in respect of particular goods or classes of goods.”

Section 16 of the Canadian Trade-Mark and Design Act (R. S. 1906, c. 71) provided that:—

“A general trade-mark once registered and destined to be the sign in trade of the proprietor shall endure without limitation.”

The definition of a trade-mark as given by Mr. Lowe, Deputy Minister of Agriculture, in the case of *Bush v. Hanson*, (1888) 2 Ex. C. R. 557, is that the essential element of a trade-mark is the “universality of right to its use, i. e., the right to use it in the world over as a representation of, or substitute for, the owner’s signature.”

Mr. Paul, in his work on Trade-Marks (Ed. 1903, p. 5) puts it in this way: “It has been well defined as one’s commercial signature.”

Mr. Scott argued before me that the same rules should be applied to a general trade-mark as those held to apply in the case of specific trade-marks. That if in the case of a specific trade-mark a mark already registered as a specific trade-mark can be taken by another and registered and used as a specific trade-mark for an entirely different class of merchandise, so in the case of a general trade-mark registered in connection with a general class of business another person can register and use the same as a general trade-mark in connection with an entirely different class of business.

There is no authority on the point and the question is one of considerable difficulty. My own view is that there is a distinction between the case of a general trade-mark and that of a specific trade-mark.

I am of the opinion that once a general trade-mark has been registered for a particular word, the same word cannot be registered as a general trade-mark by anyone else. If this were permitted it would lead to confusion. I think the second applicant is limited to an application for a specific trade-mark if otherwise entitled thereto. . . . I will come now to the consideration of the Canadian Trade-Mark and Design Act (R. S. 1906, c. 71).

Section 4 of the statute is the interpretation clause. It provided as follows:—

“(a) In this part unless the context otherwise requires ‘general trade-mark’ means a trade-mark used in connection with the sale of various articles in which a proprietor deals in his trade, business, occupation or calling generally;

“(b) ‘Specific trade-mark’ means a trade-mark used in connection with the sale of a class of merchandise of a particular description.”

The definition under (a) of general trade-mark means, I think, a trade-mark used in connection with the various articles in which the proprietor deals in his trade, and may cover several classes of merchandise if the proprietor is trading in these several classes.

A specific trade-mark is limited to a class of merchandise of a particular description, so if the applicant dealt in two different classes of merchandise he would have to apply under sub-sec. (b) for two specific trade-marks, one applicable to each class. The general trade-mark would, however, cover all the classes of merchandise in which the applicant deals. I do not think, however, that the general trade-

mark would confer an unlimited right the world over as against those carrying on a business of an entirely different character.

The business of McHesson & Robbins is that of dealers in druggist supplies. If another trader manufactures steam engines, a business entirely different from that carried on by McKesson & Robbins, these latter people could not be possibly injured in any way by a specific trade-mark adopted and used by the other trader in connection with steam engines, although the word might be the same. The whole purport of the law of trade-marks is to prevent the passing off of goods of one as the goods of another whether intentional or not.

To come to the present case, I fail to see how the registration of "Albaloid" as a specific trade-mark as applicable to "forks and spoons of Britannia metal," could possibly enable the applicants to mislead the public into the belief that their goods were the goods of McKesson & Robbins. Moreover while dealing with the question it must be borne in mind that the word "Albaloid" could not, in my judgment, be registered as a general trade-mark as long as the word "Albolene" stands on the registry, there is some dissimilarity between the two words.

On the whole, I am of opinion that the applicants are not entitled to have registered the word "Albaloid" as a general trade-mark. I think, however, if limited to a specific trade-mark as applied to "forks and spoons of Britannia metal" it may be registered."

The foregoing judgment makes it clear that a general trade-mark registered by a trader who deals in a particular class of goods is not a bar to the registration of the same trade-mark by another for a different class of goods.

In Re Vulcan Trade-Mark.—In a subsequent case, *In re "Vulcan" Trade-Mark*, (1914) 15 Ex. C. R. 265, 22 D. L. R. 214, Mr. Justice Cassels further considered the nature of General Trade-Marks. In this case the word "Vulcan" had been registered by a firm of wholesale grocers as a general trade-mark and the petitioner who manufactured matches asked to register certain trade-marks including the word "Vulcan" in their own name as applied to matches. The owners of the general trade-mark resisted on the grounds, *inter alia*, that they were selling matches under this name, and that the petitioner had abandoned whatever rights they had in Canada to sell their goods under this name in Canada. On the evidence Mr. Justice Cassels held the petitioner to have made good title to the trade-mark as applied to matches, and that they were entitled to have it registered for this class.

In discussing the general trade-mark registration the learned Justice said:

"Nice questions would arise as to whether the law as applied in England, apply under our Canadian statute to a general trade-mark. I thought it fair to the respondents that they should have liberty to file an affidavit setting out dates of assignments and consideration received for such assignment. It now appears that any sales made by the respondent firm of the right to use the word "Vulcan" were in regard to articles manufactured not covered by their trade-mark,—according to the view I have expressed in the case referred to of Gebr. Noelle's application. I have received a communication from the counsel of the petitioners to the effect that they do not desire to have the trade-mark of the respondents expunged except so far as applicable to matches. I would be very loth to declare that the trade-mark of the respondent should be expunged from the register in toto. The consent of the petitioners assists in relieving me from having to so decide. "The Canadian statute differs materially from the English Act."

. . . Under the English Act an applicant can apply for a trade-mark for the particular articles under each class. There are a long series of decisions in the English reports in which applications were made for registration of trade-marks which would embrace all the articles mentioned in the particular class, and where the applicant for the registration, although obtaining the registration, failed to use the trade-mark in respect to one or other of the particular articles. The courts in England have in such cases rectified the register by expunging from the trade-mark register the particular article not so used. For instance, *In re Hart's Trade-Mark* (19 R. P. C. 569) "Condensed Milk" was covered by the registration but not used. The register was amended by striking out "Condensed Milk" from the register.

In *Hargreaves v. Freeman* (3 Ch. D. 39), *Anglo-Swift Condensed Milk Co. v. Pearks* (20 R. P. C. 509), and *Edwards v. Dennis* (30 Ch. D. 454) and in numerous cases, a limitation has been imposed upon the trade-mark excluding from its scope articles which might have been covered.

On the whole, having regard to the facts of the case, I will direct that the general trade-mark be limited by excluding therefrom the use of the word "Vulcan" as applied to matches. The respondents will not be injured to any great extent, as the correspondence shows they were willing to sell the right to the present petitioners for a comparatively small sum.

I think the respondents are liable to pay the costs of the petitioners, and so I order. I give no costs for or against the Minister of Agriculture.

The case was appealed to the Supreme Court (51 S. C. R. 411, 24 D. L. R. 621) and the judgment of the Exchequer

Court sustained. In the Supreme Court, Idington, J., at p. 120, said:

"The term "general trade-mark" is so indefinite that I am not quite prepared to accept what seems to be the view of the learned trial judge that because the dealings in a particular article may properly fall within the ordinary course of a business classified as, for example, "Wholesale Grocers," therefore, every article within that class must, for the purpose of this Act, be held covered by the trade-mark adopted and used by a wholesale grocer. The wholesale grocer may, in fact, confine his trade to a few articles; and he may expand or contract his list just as his capital and facilities for and perhaps necessities of business may demand.

Without going farther than this to illustrate my meaning, I think the course of dealing and of use of a general trade-mark in relation thereto for a number of years after registration of such trade-mark may well be looked as the measure of what was claimed and intended to be registered. If a firm having registered as herein such a general trade-mark for ten or twelve or more years, never used it but for limited purposes and then assigned to another, I think that other got nothing beyond that which its assignor by use and mode of dealing had thus and thereby rendered definite. If it had been shown that the firm registering had prior thereto in fact used the trade-mark more extensively in the sense of covering a greater variety of kinds of articles and dealings than it chose to apply it to later than the registration, I by no means think it would have lost its property therein. It is possible to lose by abandonment property of any kind. But it is not the case of abandonment by the firm registering we have to deal with so much as the finding of what the firm really intended to register. . . .

The registration is of that, and that only, which at the time of registration was the property of him registering. . . .

I wholly dissent from the view that this registration creates a right not only akin to but also identical in kind with that created by a patent."

No Classes for General Trade-Mark.—Under the system prevailing at present an applicant for a general trade-mark registration is not required to state the classes to which he has applied or intends to apply it. Consequently a general trade-mark when registered still forms a bar so far as the Registrar is concerned to the registration of a specific trade-mark for the same trade-mark in any class. When a subsequent applicant ascertains that the owner of a general trade-mark is not using it in the classes for which he seeks a specific registration, it is necessary for

him to apply to the Exchequer Court for an order to register. (For procedure, see *infra*, pages 46 to 48.)

Classification.—An applicant for registration of a specific trade-mark must indicate the classes to which it is to be applied. There is no official classification, and sometimes difficulty is met with in preventing different registrations of the same trade-mark overlapping. Questions may also arise as to how many classes may be included in a single registration. The Registrar has wide discretion on this point. In the main, the lines of division indicated by the English classification are followed.

Conflicting Classes.—The question as to whether or not the right to use the trade-mark or trade name applied to one article extends to other articles of a different character but belonging to the same general class, is one of considerable difficulty, and each case has to be considered in the light of all the circumstances surrounding the same, as to whether the articles are susceptible of the same use, or of some of the same uses dealt in by the same dealers.

In England a distinction is made between the same natural and the same statutory class. A trade-mark may be used and registered for particular goods in a statutory class and others may use or register the same mark for other species of goods in the same statutory class: *Harman v. Freeman*, (1891) 3 Ch. D. 39, 61 L. J. Ch. 23 (discussing and applying *Edwards v. Dennis*, 30 Ch. D. 454, 55 L. J. Ch. 125); *Jay v. Ladler*, 40 Ch. D. 649, 60 L. T. Rep. N. S. 27; *Edwards v. Dennis*, 30 Ch. D. 454, 55 L. J. Ch. 125 (reversing *Cab. & E.* 428); *In re Braby*, 21 Ch. D. 223, 51 L. J. Ch. 637. *In re Hargreaves*, 11 Ch. D. 669, 27 Weekly Rep. 550, there being four trade-marks, each consisting of the device of an anchor, registered for different varieties of goods in the same general class, the Court refused the application to register a fifth for still another kind of goods in the same general class.

There are two reasons for this rule. The first is that if a second trader were to adopt and use the mark of another within the same class of goods he would thereby acquire

exclusive rights to the mark as applied to this particular variety of goods, and if the first user of the mark should subsequently desire to add that particular variety of goods to his general line, within the class, he would be unable to use his own trade-mark upon his own goods: *Collins v. Oliver Ames, etc., Corp.*, 18 Fed. 561, 20 Blatchf. 542. But see remarks of Cotton, L. J., in *Edwards v. Dennis*, 30 Ch. D. 454, 55 L. J. Ch. 125, and of Jessel, M. R., in re *Jelley*, 51 L. J. Ch. 639; 46 L. T. Rep. N. S. 381, note. Another reason is that the public cannot know how many varieties of the same class of goods the owner of the mark makes and sells under the mark, and if they should see that mark upon other goods of the same class they would be deceived and the owner of the mark might be injured in his reputation because of the quality of the goods over which he has no control: *Amoskeag Mfg. Co. v. Garner*, 54 How. Pr. (N. Y.) 297; *Wamsutta Mills v. Allen*, 12 Phila. (Pa.) 535; see *Edwards v. Dennis*, 30 Ch. D. 454, 55 L. J. Ch. 125 (per Cotton, L. J.); *Delaware, etc., Canal Co. v. Clark*, 13 Wall. (U. S.) 311, Cyc., vol. 38, p. 685. In Canada a decision on this point is rendered difficult by the absence of any definite classification.

"Listerine" Case.—In *Lambert Pharmacel Co. v. Palmer & Sons, Ltd.*, 2 D. L. R. 358 (annotated), 21 Que. K. B. 451, it was sought under the registration of the word "Listerine" for medical preparations, to restrain use of the words "Listerated Tooth Powder." Cross, J., delivering Judgment of the King's Bench, said:

"Looking at "Listerine" as a medical preparation designed by nature of it to serve as an antiseptic or germicide and to go into use whenever and wherever physicians or surgeons might prescribe a drug which would serve such a purpose, and then looking at "Listerated Tooth Powder," simply as a tooth powder, the defendant's position certainly appears to be well taken because the plaintiff's mark is specific and the statute gives the right of exclusive use of it only to designate "a class of merchandise of particular description" (Sees. 46 and 13). But the appellant refers us to the testimony of physicians, who say that medical science and practice comprehends dentistry and treatment of the teeth and mouth. What these witnesses have said is probably accurate, but I consider that it does not prove that tooth

powder is a medicine or medical commodity. Taking this view respecting the difference in the nature of the things to which the trade-mark is applied, it becomes unnecessary to consider whether or not the defendant's uses of the word "Listerated" is an infringement of the plaintiff's mark "Listerine" as "Apollinis" was held to be an infringement of "Apollinaris," in *Apollinaris Co. v. Herrfeldt* (1887) 4 R. C. P. 478, in an action between rival dealers in table waters.

I consider that the plaintiff cannot extend by construction the scope of its title under the registered trade-mark in the way contended for. Where an exclusive right is the creation of a statute it is not to be enlarged by construction, and doubt is to be resolved in the direction of freedom and not of the exclusive right. I, therefore, consider that the defendant is not shown to have infringed the registered trade-mark "Listerine," or, in other words, is not shown to have violated the statutory title of the plaintiff.

It is to be observed, however, that the same argument is available to the plaintiff in support of his action apart from the effect of the Trade-Mark and Design Act; that is to say, taking it as an action directed against interference with the plaintiff's trade name "Listerine." I now proceed to consider the action as grounded on that basis.

The plaintiff's case is that it has proved that "Listerated" was copied from "Listerine" after it had made "Listerine" publicly known at great expense, and that the acts of the defendant in selling a tooth powder called "Listerine Tooth Powder," which in fact does not contain "Listerine," are representations that it does contain "Listerine," and amounts as a passing off of defendant's goods for plaintiff's goods and a deception detrimental to the plaintiff.

It has already been pointed out that the plaintiff expressly found upon the fact that it makes or sells tooth powder as a ground of action against the defendant, though it does rely upon the fact that "Listerine" has been and is advertised and sold as a mouth wash and to serve the purpose of a tooth powder for those who choose to use it instead of tooth powder.

It is argued for the plaintiff that it is entitled to have any and other person stopped from using the name "Listerine," or a name liable to be confounded with it, not only upon the medical preparation "Listerine," but also upon any commodity "of the same class," such as it contends that tooth powder is.

Besides, as has already been stated, there is the contention for the plaintiff that medical preparations include tooth powder on the ground that medical science comprehends dentistry and care and treatment of the teeth.

It is also broadly asserted for the plaintiff that it is owner of the name or mark "Listerine" by actual adoption of it, and (if such adoption were not sufficient) by such long use of it as would make its exclusive title good, and, being such owner is entitled to prevent use of it by the defendant or any other person.

In support of their argument to the effect that the plaintiff is en-

titled to have the use of the mark stopped upon goods of the same class as those to which it has itself applied, counsel for the appellant have cited a number of decisions.

Amongst them special reliance was placed upon the "fruit salt" case: *Eno v. Dunn*, 7 R. P. C. 311, and 10 ib. 261, wherein the owner of the name "fruit salt," used to designate an effervescing powder, successfully object to the registration in favour of the defendant of the same words as a name of a baking powder in the form of a lozenge. That case, however, dealt with an application to register, and one can well understand that the registrar might be justified in refusing to register a mark from motives of caution, whereas, in actual case, the name objected to might not be held to involve infringement or danger of deception.

I believe that this distinction was pointed out in the same case of *Eno v. Dunn* (1890) 15 A. C. 252, as in *Speer's Case* (1877) 4 R. P. C. 525. *Turney's Trade-Mark*, 11 R. P. C. 37, was cited to show that a mark for beer might be infringed by using it as a mark for rum. It is to be observed that *Tunrey's Case* also arose on application to register. The *Australian Wine Importers' Case*, 41 Ch. D. 278, was cited to show that a mark for wine could extend to spirits. *Eastman v. Griffiths*, 15 R. P. C. 105, was referred to as showing that the owner of a mark used on cameras could validly object to the use of it on bicycles. Reference was also made to the comments upon the decisions in *Kerly*, pp. 33, 537, and *Hopkins*, pp. 268-270, and to the United States decision in *Collins v. Ames*, 18 Fed. Rep. 561, wherein it was decided that the plaintiffs were entitled to have the defendants restrained from using their trade-mark on iron shovels though they had not themselves made or sold shovels, but dealt in axes and similar articles. The United States' decision of *Baker v. Harrison*, 138 Off. Gaz. Pat. Off. 770, is cited as shewing that the owner of a mark for cocoa might restrain the use of it for coffee. In addition, there has been quoted from 28 Eng. and Am. Enc. of Law, p. 389, which I consider an accurate statement of the law, worded as follows:—

"No general right to a trade-mark or trade name, apart from its particular application, exists. The right is merely a prior right to use such mark or name in connection with the particular goods or business to which it is applied and which it has come to indicate. Other persons may, without wrong, use the identical name or mark in connection with a different kind of goods or business. But the right extends to other goods or business of the same general class as that in which it has been applied. When one has acquired a trade-mark in connection with particular goods, no one else will be permitted to use such trade-mark upon goods, which, while different belong to the same class. There are two reasons for this rule. The first is that if a second trader were to adopt and use the mark of another within the same class of goods, he would thereby acquire exclusive rights to the mark as applied to this particular variety of goods to his general line within the class, he would be unable to use his own trade-mark upon

his own goods, and if the first user of the mark should subsequently desire to add that particular variety of goods to his general line within the class, he would be unable to use his own trade-mark upon his own goods. Another reason is that the public cannot know how many varieties of the same class of goods the owner of the mark makes and sells under the mark and if they should see that mark upon other goods of the same class, they would be deceived, and the owner of the mark might be injured in his reputation because of the quality of goods over which he has no control."

Reverting briefly to some of the decisions for the appellant, it may be said in relation to the case of *Collins v. Ames*, 18 Fed. Rep. 576, that it was shewn that the plaintiffs had for many years made and sold edge tools and had continuously marked upon them the trade-mark "Collins & Co.," a mark which, being the plaintiff's own name at once announced the goods of the plaintiff's make. The defendants, persons of a different name, commenced to sell shovels marked "Collins & Co.," with the proved intention of getting the benefit of the plaintiff's reputation. One can see why, in such circumstances, shovels were held to come within the class of goods denoted by the mark which practically asserted that they were manufactured by the plaintiff.

In addition to what has been said of the "fruit salt" case, it may be added that the specification of one of the plaintiff's registrations described the commodity as intended for use as a medical substance and that of another registration referred to it as intended for a non-alcoholic beverage. The substance claimed for by the defendant came fairly within one or other of the specifications. Regarding the kodak case, *Eastman v. Griffiths*, 15 R. P. C. 105, it can be pointed out that it was shewn that the plaintiffs in that case had advertised cameras as specially adapted to be fitted to bicycles.

I add these references merely to shew that one can readily see grounds for the conclusion that the defendants in the cases mentioned were palpably proposing to profit by the use of the plaintiff's trade-mark upon goods which buyers would mistakenly take to have been manufactured by the plaintiffs."

CHAPTER IV.

REGISTRATION.

These following sections of the Trade-Mark and Design Act refer to registration:

8. A register shall be kept at the Department of Agriculture for the registration of trade marks. R. S. c. 63, s. 5.

9. Subject to the provisions of this Act, the Minister shall on application duly made, in that behalf, register therein the trade-mark of any proprietor applying for such registration in manner as provided by this Act in that behalf and by the rules and regulations made thereunder. R. S., c. 63, ss. 5 and 8.

10. Every proprietor of a trade-mark who applies for its registration shall state in his application whether the said trade-mark is intended to be used as a general trade-mark or as a specific trade-mark. R. S., c. 63, s. 9.

11. The Minister may refuse to register any trade-mark:—

(a) If he is not satisfied that the applicant is undoubtedly entitled to the exclusive use of such trade-mark;

(b) If the trade-mark proposed for registration is identical with or resembles a trade-mark already registered;

(c) If it appears that the trade-mark is calculated to deceive or mislead the public;

(d) If the trade-mark contains any immorality or scandalous figure;

(e) If the so-called trade-mark does not contain the essentials necessary to constitute a trade-mark, properly speaking. 54-55 V., c. 35, s. 1.

12. The Minister may in any case in the last preceding section mentioned, if he thinks fit, refer the matter to the Exchequer Court of Canada, and, in that event, such court shall have jurisdiction to hear and determine the matter, and to make an order determining whether and subject to what condition, if any, registration is to be permitted. 54-55 vs., c. 35, s. 1.

13. Subject to the foregoing provisions, the proprietor of a trade-mark may, on forwarding to the Minister a drawing and description in duplicate of such trade-mark, and a declaration that the same was not in use to his knowledge by any other person than himself at the time of his adoption thereof, together with the fee required by this Act in that behalf, and on otherwise complying with the provisions of this Act in relation to trade-marks and with the rules and regulations made thereunder, have such trade mark registered for his own exclusive use.

Thereafter such proprietor shall have the exclusive right to use the

trade-mark to designate articles manufactured or sold by him. R. S., c. 63, ss. 3, 5, 8 and 13.

14. Upon any trade-mark being registered under this Act, the Minister shall return to the proprietor registering the same one copy of the drawing and description forwarded to him with a certificate signed by the Minister to the effect that the said trade-mark has been duly registered in accordance with the provisions of this Act; and the day, month and year of the entry of the trade-mark in the register shall also be set forth in such certificate. R. S., c. 63, s. 13.

20. No person shall institute any proceeding to prevent infringement of a trade-mark, unless such trade-mark is registered in pursuance to this Act. R. S., c. 63, s. 19.

39. The Minister may, from time to time, subject to the approval of the Governor in Council, make rules and regulations and adopt forms for the purposes of this Act respecting trade marks and industrial designs; and such rules and regulations and forms circulated in print for the use of the public shall be deemed to be correct for the purposes of this Act. 2. All documents executed according to the said rules, regulations and forms, and accepted by the Minister shall be deemed to be valid so far as relates to official proceedings under this Act. R. S., c. 63, ss. 6 and 23.

48. In case any trade mark or industrial design in respect of which application for registry is made under this Act shall not be registered, all fees paid the Minister for registration shall be returned to the applicant or his agent, less, in the case of trade-marks, the sum of five dollars, and in the case of industrial designs, the sum of two dollars, which shall be retained as compensation for office expenses. R. S., c. 63, ss. 10 and 26.

English Definition of Registrable Trade-Mark.—A summary of the essentials of a registrable trade-mark in England is found in Section 9 of the Trade-Mark Act of 1905.

9. A registrable trade-mark must contain or consist of at least one of the following:—

(1) The name of a company, individual or firm represented in a special distinctive manner;

(2) The signature of the applicant for registration or some predecessor in his business;

(3) An invented word or invented words;

(4) A word or words having no direct reference to the character or quality of the goods and not being according to the ordinary signification a geographical name or a surname;

(5) Any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the above paragraphs (1), (2), (3) and (4), shall not except by order of the Board of Trade or the Court be deemed a distinctive mark:

Provided always, that any special or distinctive word or words, letters, numeral, or combination of letters or numerals used as a trade-mark by the applicant or his predecessor in business before the thirteenth day of August, one thousand eight hundred and seventy-five, which has continued to be used (either in its original form or with additions or alterations not substantially affecting the identity of the same) down to the date of application for registration shall be registrable as a trade-mark under this Act. For the purpose of this section "distinctive" shall mean adapted to distinguish the goods of the proprietor of the trade-mark from those of other persons.

In determining whether a trade-mark is so adapted the tribunal may, in the case of a trade-mark in actual use, take into consideration the extent to which such user has rendered such trade-mark in fact distinctive for the goods with respect to which it is registered or proposed to be registered.

This section defines what may be registered in England. As pointed out previously the field is wider in Canada. No doubt anything which is a good trade-mark under this section would be supported as such by our Courts, and to this extent at least the English cases interpreting the section may be relied upon.

Registration a Precedent to Suit.—Registration is a necessary precedent to a suit for infringement of a trade-mark. Section 20 of the Trade-Mark and Design Act is not, however, a bar to relief based on "passing off." Even without registration the "straight and arbitrary adoption or imitation of a trader's label or 'get up'" will be restrained. *Anheuser-Busch v. Edmonton Brewing Co.*, (1911) 16 W. L. R. 547; 15 W. L. R. 421. The disadvantage of lack of registration lies in the difficulty of proving "passing off." See, *infra*, chapter VIII.

The Trade-Mark Register.—The register referred to in Section 8 is kept in some eighty volumes. A loose leaf index under titles has been prepared, and is kept up to date. There is no index as to names of owners of registered trade-marks since 1909. It is the practice to attach to each folio of the register the trade-mark application form prepared and executed by the applicant. This application form is prepared in duplicate, one form being attached to the certificate of reg-

istration. Both general and specific trade-marks are entered in the same register.

Rules and Regulations.—The rules and regulations made under Section 9 are simple. They may almost be said to be “singularly bald in their provisions,” a characterization which Hagarty, C. J. O., in *Partlo v. Todd*, 140 A. R. 444, applied to the entire Act. (See, *infra*, p. 44.)

Grounds of Refusal to Register.—The discretion of the Minister under Section 11 is wide. It is exercised on his behalf by a departmental official entitled the “Registrar of Trade-Marks.”

Sub-section (a) appears to refer to the question of title. It becomes operative when two applications are made simultaneously for the same trade-mark. The Registrar in such cases is not satisfied that either applicant “is undoubtedly entitled to the exclusive use of such trade-marks” and the practice is to refuse to act on the matter until one of the parties obtains a judgment of a competent court to the effect that he is entitled to the trade-mark.

The Registrar under this sub-section would give due weight to any protests filed against registration of any particular trade-mark; and might also raise objection if he knew the trade-mark to be in common use in the trade. In *re Partlo v. Todd* (17 S. C. R. 96) it was found that the words “Gold Leaf” used on flour were in common use as designating merely a particular description or quality of flour.

Under sub-section (b) the Minister may refuse to register “if the trade-mark proposed for registration is identical with or resembles a trade-mark already registered.” This is the most usual ground of objection. The search made by the Registrar frequently reveals registered trade-marks which conflict in whole, or in part, with the trade-mark sought to be registered. A registered trade-mark which has expired, is considered evidence of use, and forms a bar to a second registration until expunged or cancelled.

Sub-section (c) is in accordance with the well estab-

lished law that the use of a mark which contains false representation does not deserve to be supported and involves a deceit on the public which will not be tolerated.

No definition of this phrase occurs in the Canadian Act. Canadian courts have referred to the English decisions on this point. *Carey v. Goss*, 11 O. R. 619; *Rose v. McLean Publishing Co.*, 24 O. A. R. 240.

In Canada, the reference corresponding to that provided by sub-section (5) of Section 9 of the English Act is to the Exchequer Court.

Sub-section (c) of Section 11, excludes any mark "calculated to deceive or mislead the public."

In *re Edge*, 8 R. P. C. 207; *Ginter v. Kinney Tobacco Co.*, 12 Fed. 782; In *Anheuser-Busch v. Edmonton Brewing Co.*, (1911) 16 W. L. R. 547, in a "passing off" action, it was held that misrepresentation in the label as to registration was not fatal, as it was not about the goods themselves, and the public was not deceived thereby.

Any "immoral or scandalous figure" is properly excluded by sub-section (d).

Sub-section (e) opens a wide question as to what comprises "the essentials necessary to constitute a trade-mark, properly speaking." The case of *New York Herald v. Ottawa Citizen*, (1908) 41 S. C. R. 229, in the Supreme Court gave occasion for some discussion of "the essentials necessary to constitute a trade-mark." The case involved the registration of the words "Buster Brown," applied to a series of comic cuts or sketches in a newspaper. The majority of the Court refused to support the words so used.

Idington, J., said:

"The case of trade-marks and their recognition by law as property preceded legislation requiring or facilitating their registration.

Our Canadian legislation in that regard preceded that in England by some fifteen years.

An Act, 23 Vict., ch. 27, of the old Province of Canada, which related to trade-marks, was punitive in its character and next year repealed by 24 Vict., ch. 21, of the same province, which provided for registration of trade marks as therein defined.

That definition has been in substance and almost in the same words adhered to throughout the many changes that may have taken place.

. . . I do not think the alleged trade-marks in question here fall

within this definition of what may be registered as trade-marks. It does not appear to me that either of them is or ever was intended as a device to distinguish anything "manufactured, produced, compounded, packed or offered for sale," as described in this section. The plain ordinary meaning of the words does not warrant putting such an interpretation on them. . . .

The production which the appellant sells is not a kind of paper coloured in any particular way or covered with a peculiar kind of ink or set form or figures. It is the nonsense that is produced by the brain of the man writing for the diversion of the idle that in truth is sold.

I am not, however, going to wander into the field of whether or not a trade-mark can exist in such a name or names, or in the name of a title given any literary production of any kind, for I am quite sure that it never was intended this section should apply to such a thing.

Our statutes and the English Acts are so different that, except for the fundamental purposes of determining whether any device used may in its manner of use be or not be a subject of such property as exists in law in a trade-mark, the English cases are not very helpful.

To appreciate "the essentials necessary to constitute a trade-mark" required by sub-section (e) of section 11 of our Act, many of these cases may be valuable."

Duff, J., dissenting in the same case, expressed the view that the part of the newspaper in which these cartoons were published were within the term "product" as used in Section 5. He was further of the opinion that the question was settled by the decision of the Registrar in allowing the registration.

"The effort of the statute, I think, is that if the trade-mark, so-called, falls within the definition given by section 5 and the conditions of section 13 have been complied with, the registration alone confers upon the proprietor the exclusive right to the use of it."

". . . and where a statute has committed to a specified authority the determination of a particular class of questions, it would be repugnant to establish principles to hold that the decision of the statutory authority acting within the scope of its duty is, in the absence of fraud or manifest error of law, open to review in a collateral proceeding."

When the Registrar on behalf of the Minister refuses to register any mark, he notifies the applicant and returns the fee less five dollars. If the applicant believes the refusal unwarranted it is open to him to submit the application again, with or without amendments, and ar-

gument. No special time limit is set within which the case may be presented again or arguments submitted. No additional fees are necessary unless new matter is introduced which would necessitate a further search by the Registrar. In this event if the application is accepted the applicant is required to pay the full fee instead of the refunded portion. In other words, the application is treated as a new one, instead of as a continuation of the old one.

Use in Canada and Foreign Use.—Section 13 calls for a declaration from the applicant that the trade-mark “was not in use to his knowledge by any other person at the time of his adoption thereof.” The question of whether this refers to use in Canada or in a foreign country has been much canvassed. The weight of opinion supports the view that the statute refers to use in Canada.

The late Mr. Low, Deputy Minister of Agriculture, as far back as 1888, expressed the opinion that the applicant must be the proprietor of the trade-mark the world over. *Bush Manufacturing Co. v. Hanson*, 2 Ex. C. R. 557; *Groff v. The Snow Drift Baking Powder Co.*, 2 Ex. C. R. 568. In *Smith v. Fair*, (1887) 140 R. 729, it was held that the user of a trade-mark in a foreign country is no justification for an infringement of a registered mark in the country where the action is brought; therefore it would follow that prior user out of Canada will not disentitle a person to an exclusive right in Canada. Proudfoot, J., in *Smith v. Fair*, speaking of the effect of the assignment of a foreign trade-mark to the plaintiff said: “But besides it does not seem necessary for the plaintiff to rely on the assignment. If the Berliner cases be good law it would have been sufficient for the plaintiff to declare that the mark was not used by any person in Canada when he adopted it.” The case referred to by the learned Judge, *Berliner, etc., v. Knight*, (1883) W. N., p. 70, is a decision of the Chancery Division on appeal from an interlocutory order of Mr. Justice Chitty restraining the defendants from selling, etc., as being Tivoli beer, any beer not manufactured by the plaintiffs. The plaintiffs were a Berlin

company of brewers whose beer known as Tivoli beer was sold extensively in England. Until the defendants did so, no beer had been sold in England under the name Tivoli except by the plaintiffs. Despite the defendant's contention that Tivoli beer denoted a particular description of beer, and that they had never used the word Tivoli except in conjunction with their own name, the Court (Baggallay and Cotton, L. C. J.) considered that the plaintiffs had made out a prima facie case of the defendants having sold their goods in a way calculated to pass them off as goods made by the plaintiffs, and that the injunction had been rightly granted.

It has been also held in England that user abroad is not such user as will bring the person using within the "three-mark" rule, by which rule similar marks up to three are allowed to be registered, if they are proved to have been used side by side before the Trade-Marks Act (Imp.) 1875. In *re Munch*, (1884) 50 L. T. N. S. 12 it was held that foreign user alone could not entitle an applicant to registration. Such user was not contemporaneous user within the meaning of the three-mark rule. And *cf.* *Jackson v. Napper*, (1886) 35 Ch. D. 162, where the applicant, a foreigner, was required to shew user in England before going on with his registration. "It is said," said *Sterling, J.*, at p. 177, "and I think rightly, that in order to entitle you to register, there being a similar mark already on the register, you must make out that there was a user of the mark in England." So in *In re Meens' Application*, (1891) 1 Ch. 41, it was thought, though not actually decided, that the importation of goods marked with a distinctive brand or label for the purpose of transshipment only was not sufficient user to acquire a title thereto.

In *Spilling v. Ryall*, 8 Ex. C. R. 195, Mr. Justice Buridge guards himself against expressing any opinion as to what might be the result were the goods of the owner of the prior trade-mark in the United States placed upon Canadian market.

Mr. Justice Cassels, in *Re Vulcan Trade-Mark*, (1914)

15 Ex. C. R. 265, 22 D. L. R. 214 (affirmed 24 D. L. R. 621, 51 Can. S. C. R. 411), refers to the preceding cases on this point.

The effect of sub-section 2 of Section 13 then Section 8 received minute examination in *Partlo v. Todd*, (1888) 17 S. C. R. 196, where it was argued in all the courts that the registration once made constitutes an indefeasible right to the trade-mark. This contention was disposed by the judgment of the Supreme Court, which held that if the registration was improperly made the court would supply a remedy. In this case it was shown that the words "Gold Leaf" as applied to flour were common to the trade, and indicated quality. The action was one for infringement. It was held that it is only a mark or symbol in which property can be acquired and which will designate the article in which it is placed as the manufacture of the person claiming an exclusive right to its use, that can properly be registered as a trade-mark, and that the defendant in an action for infringement may show that the mark is or symbol was in common use before such registration, and therefore could not properly be registered.

Gwynne, J., after referring to the leading English cases, said:

Construing now the Dominion Statute, 42 Viet., ch., 22, by the light of the principles established by these decisions, we find by the first section that the register authorized to be kept is of "trade-marks" only; and that it is only a proprietor of a "trade-mark" who is authorized to have his trade-mark registered. That section provides the proceedings to be adopted by "the proprietor of a trade-mark" to have it registered. That section provides the proceedings to be adopted by "the proprietor of a trade-mark" to have it registered.

By the 7th section the Minister of Agriculture is authorized only to register the trade-mark of a proprietor thereof, and by the eighth section it is enacted that for the purposes of the Act "all marks, names, brands, labels, packages or other business devices which may be adopted for use by any person in his trade for the purpose of distinguishing any manufacture, product or article by him manufactured, etc., etc., shall be considered and known as trade-marks and may be registered for the exclusive use of the party registering the same in the manner herein provided.

Then, by the 17th section it is the "proprietor of a trade-mark" who is given an action against any person using his registered trade-

mark, or any fraudulent imitation thereof, and by the 4th section it is enacted that:

“No person shall be entitled to institute any proceedings to prevent the infringement of any ‘trade-mark’ until and unless such ‘trade-mark’ is registered in pursuance of this ‘Act.’ ”

We see, therefore, that the statute expresses sufficiently clearly, as I think, that the only action which the statute authorizes to be brought as for an infringement of a trade-mark is one which must be brought by the “proprietor of the trade-mark” who has registered under the provisions of the statute the “trade-mark” of which independently of registration he was the “proprietor,” and that no name, brand, etc., which may not be adopted by a trader for the purpose of distinguishing his goods from the goods of a rival trader, shall be considered to be a trade-mark or capable of being registered for the exclusive use of the party registering.

Now, as the words “Gold Leaf” stamped on flour was a brand in common use in the trade for the purpose of designating the quality merely of the flour, and the process by which it was manufactured, namely, by “roller mill process” or “patent process,” and not at all for the purpose of distinguishing the manufacture of the plaintiff, or of any miller in particular from the manufacture of another, that the word could not have been adopted by the plaintiff as his special property or trade-mark; and it was not a trade-mark within the meaning of the statute, and could not be registered for the exclusive use of the person registering. Registration, therefore, of such word could not vest in the plaintiff a right to the exclusive use of it as if it were a trade-mark. The plaintiff’s contention, that by registering the word he could take it out of its common use and make it his own special property (to use the language of Sir George Jessel in *Re Hyde’s Trade-Mark* (1878), 7 Ch. D. 726, applied to somewhat similar facts, is not the law.

Contemporaneous Use.—No cases of contemporaneous use have arisen under Canadian law. The statute gives the exclusive right to the trade-mark throughout the whole Dominion to the registered owner. It is not seen, therefore, that there is any room for the acquisition of concurrent rights by different owners.

Prior Abandoned User.—A prior user, which had been discontinued under conditions to constitute abandonment, would not be a bar to the subsequent adoption and registration of the mark by another trader. *Partlo v. Todd*, 14 A. R. 444.

Description and Declaration.—The description of the trade-mark and declaration as to use is embodied

in the form provided by the Department. The drawing and description are read together. The registration protects only the trade-mark described and cannot be extended by something appearing in the drawings which has not been described. *Mickelson Shapiro Co. v. Mickelson Drug and Chemical Co.*, (1914) 15 Ex. C. R. 276.

To comply with Section 13 both a drawing and description is necessary. The absence of a description might constitute an objection of substance. *De Kuyper v. Van Dulken*, 24 S. C. R. 114.

The Registrar has permitted considerable latitude in the nature of the drawing filed. A tracing is preferred, as it facilitates duplication for certified copies, etc. Original pen and ink drawings, blue prints, and printed representatives of the trade-mark are, however, usually accepted.

The declaration is usually signed by the applicant, but may be signed by a duly authorized agent. (*Spilling v. Ryall*, (1903) 8 Ex. C. R. 195.) The right of an agent to sign the declaration was questioned in the earlier case of *Davis v. Kennedy*, (1867) 13 Grant 523. No evidence of the authority of the agent is required by the Registrar.

The application for registration embodying the declaration and description, must be in duplicate, both copies being executed.

Renewal.—No special authority is required to effect a renewal of a specific trade-mark at the end of twenty-five years. Upon payment of the fee (\$20.00) a renewal certificate is issued. General trade-marks and specific trade-marks registered before 1879 endure perpetually. Even if not renewed a trade-mark once on the Register stands as a bar against subsequent similar registration by another applicant.

Appeal to Exchequer Court.—An applicant for registration of a trade-mark, who is dissatisfied with a ruling of the Registrar may apply to the Exchequer Court under Section 42 of the Act, which reads:

42. The Exchequer Court of Canada may, on the information of the Attorney General, or at the suit of any person aggrieved by any omission, without sufficient cause, to make any entry in the register of trade-marks or in the register of industrial designs, or by any entry made without sufficient cause in any such register, make such order for making, expunging or varying any entry in any such register as the Court thinks fit; or the Court may refuse the application.

2. In either case, the Court may make such order with respect to the costs of the proceeding as the Court thinks fit.

3. The Court may in any proceedings under this section decide any question that may be necessary or expedient to decide for the rectification of any such register. 54-55 V., c. 35, s. 1.

Any case may also be referred to the Court by the Minister under Section 12 which reads:

12. The Minister may in any case in the last preceding section mentioned, if he thinks fit, refer the matter to the Exchequer Court of Canada, and, in that event, such court shall have jurisdiction to hear and determine the matter, and to make an order determining whether and subject to what conditions, if any, registration is to be permitted. 54-55 V., c. 35, s. 1.

The following general rules of the Exchequer Court apply:

Rule 34.—In the case of any proceeding for the registration of any copyright, trade-mark or industrial design, a notice of the filing of the petition, giving the object of the application and stating that any person desiring to oppose it must, within fourteen days after the last insertion of the notice in the Canada Gazette, file a statement of his objections with the Registrar of the Court and serve a copy thereof upon the petitioner, shall be published in four successive issues of the Canada Gazette. The notice of the filing of the petition in the case of any proceeding for the registration of any copyright, trade-mark or industrial design, may be in the form published in Schedule "A" hereto. In the case of any proceeding to have any entry in any register of copy-rights, trade-marks or industrial designs, expunged, varied or rectified, it shall not be necessary to publish any notice of the filing of the petition.

Rule 35.—In the case of any proceeding for the registration of any copyright, trade-mark or industrial design, a copy of the petition and notice above mentioned shall be served upon the Minister of Agriculture and upon any person known to the petitioner to be interested and to be opposed to the application.

In the case of any proceeding to have the entry in any register of copyrights, trade-marks or industrial designs expunged, varied or rectified, it shall not be necessary to serve a copy of the petition upon the Minister of Agriculture, and it shall suffice if such petition be served

upon any person known to the petitioner to be interested in and to be opposed to the application.

Rule 37.—In the case of any proceeding for the registration of any copyright, trade-mark or industrial design, if any person appears to oppose the application he shall, within fourteen days after the last publication of said notice in the Canada Gazette, file with the Registrar and serve upon the petitioner a statement of his objections to the application.

Rule 40.—Notice of trial in any proceeding for the registration of any copyright, trade-mark or industrial design, shall be given to the Minister of Agriculture and to the opposite party if the application to register be opposed. But in the case of any proceeding to have any entry in any register of copyrights, trade-marks or industrial designs expunged, varied or rectified, notice of trial shall be given to the opposite party only.

SCHEDULE "A."

Notice.

IN THE EXCHEQUER COURT OF CANADA.

In the matter of the petition of

A. B. of the

City of

and

In the matter of

The Trade-Mark consisting of

Notice is hereby given that, on the _____ day of _____ 19____, there was filed, in the Exchequer Court of Canada, a petition of A. B., of the City of _____ etc., that a certain trade-mark described in the said petition, as consisting of (here give description) be registered as a trade-mark in the Register of Trade-Marks in _____ the Department of Agriculture at Ottawa.

Any person desiring to oppose the said petition, must, within fourteen days after the last _____ insertion of the present notice in the Canada Gazette, (the date of the last insertion being the _____ day of _____ 19____) file a statement of his objections with the Registrar of the Exchequer Court of Canada at Ottawa, and serve a copy thereof upon the petitioner or his solicitor.

Dated this _____ day of _____ 19____.

C. D. (Petitioner in person).
or E. F.

No. _____ Street, Ottawa,
Solicitor for the Petitioner.

Registration of Surnames by Exchequer Court Order.

—The procedure outlined in the foregoing rules is frequently used to secure registration of a surname, or other

mark which ordinarily would not be considered a good trade-mark, but which has through long-continued and undisputed use acquired a secondary or trade-mark meaning.

The petition to the Court must be printed, and a certified copy served on the Minister of Agriculture. If no objections are filed the case, after the necessary advertising has been completed, may be disposed of on motion of which ten days' notice must be given the Minister of Agriculture. The evidence on such motion is usually in the form of affidavits, showing how the trade-mark has been used, the extent of use, and other facts to establish that a secondary or trade-mark meaning has been acquired for the trade-mark sought to be registered.

Conflicting Applications—In the case of conflicting applications for registration it is the practice of the Registrar to notify the applicants, and require them to have the matter adjudicated by reference to the Exchequer Court.

CHAPTER V.

ACQUISITION AND ABANDONMENT.

Acquisition.—The title to a trade-mark is originally secured by adoption for use. *Partlo v. Todd*, (1886) 11 O. R. 171; 17 S. C. R. 196; *Smith v. Fair*, 14 O. R. 729; In re *Vulcan Trade-Mark*, (1915) 51 S. C. R. 411, 24 D. L. R. 621. Registration confirms this title.

Registration Without Use Is an Incomplete Title.—“It is not the registration that makes the party proprietor of the trade-mark; he must be the proprietor before he can register.” *Partlo v. Todd*, 17 S. C. R. 196. It is not necessary that there should be use before registration. In re *Hudson*, 32 Ch. D. 311. The registration must, however, in such cases be followed by use, if the proprietor wishes to retain his right to the trade-mark. In this respect there is no difference between the law of Canada, and that of England. *Spilling v. Ryall*, 8 Ex. C. R. 195.

Use in Canada.—In the preceding chapter on Registration the question whether an applicant for registration must claim use in Canada was discussed. Under the decisions there referred to it is believed that title to a trade-mark in Canada must be based on use in Canada.

Many American trade-marks receive wide publicity through magazines, and other advertising before the merchandise to which they refer is actually sold in Canada. In such cases a rather fine question may be raised as to whether the date of “use” which gives title to the trade-mark, is the date of publication of the advertising matter, or the date of sale of goods. In England it has been decided that to constitute public use it is not sufficient for the marked goods to be advertised; they must be actually in the market. *McAndrew v. Bassett*, 4 De. G. J. & S. 380; *Maxwell v. Hogg*, L. R. 2 Ch. 307; *Wheeler v. Johnston*, 3 L. R. Ir. 284.

Who May Acquire Trade-Marks.—There is no limitation as to what persons may acquire trade-marks. "Any person" capable of acquiring any other species of property may acquire a trade-mark right. A foreigner is quite capable and may acquire a trade-mark on the same terms as a native or resident. *Collins Co. v. Cowen*, 3 K. & J. 428; *Davis v. Kennedy*, 13 Grant 523; *McCall v. Theal*, 28 Grant 48.

Even apart from a registered trade-mark an alien may prevent unfair competition in trade. *The Pabst Brewing Co. v. Ekers*, 21 Que. S. C. 545. An agent cannot acquire an interest in his principal's mark from his use of it. *Re Bueyrus Trade-Mark*, 14 Ex. C. R. 35, 8 D. L. R. 920 (affirmed 10 D. L. R. 513); *Hirsch v. Jonas*, 3 Ch. D. 584; *Swift v. Peters*, 11 O. G. 1110.

Scope of Registration.—Since title is only acquired by use it follows that a registration covering a number of classes can only be ultimately maintained for the classes in which the mark has been used. The use of the word "listerated" on a label to qualify or describe a tooth powder was held not an infringement of the word "listerine," registered and known as the name of a liquid preparation for general antiseptic purposes. *Lambert Pharmacel Co. v. Palmer*, (1912) 21 Que. K. B. 451, 2 D. L. R. 358 (annotated).

With a general trade-mark it is necessary to look to the course of dealing and use thereof, for a number of years to see the measure of registration. *Idington, J.*, in *Re Vulcan Trade-Mark*, 51 S. C. R. 411, 24 D. L. R. 621, said: "If a firm having registered as herein such a general trade-mark for ten or twelve or more years, never used it but for limited purposes, and then assigned it to another, I think that other got nothing beyond that which its assignor by use and mode of dealing had thus and thereby rendered definite."

Abandonment.—The right to use a trade-mark may be lost by abandonment or disuse. *Blackwell v. Dibrell*, 14 O. G. 633; *Re Vulcan Trade-Mark*, 51 S. C. R. 411, 24 D. L. R.

621. Abandonment forms a ground for expunging a registered trade-mark from the register. *Autosales Gum and Chocolate Co. v. Faultless Chemical Co.*, 14 Ex. C. R. 302, 14 D. L. R. 917; *In re Batt*, (1898) 2 Ch. 432.

To constitute abandonment, an intention to abandon must be shown. *United States Playing Card Co. v. Hurst*, (1916), 31 D. L. R. 596 (annotated), 10 O. W. N. 207. Mere non user of a trade-mark can no more be said to constitute abandonment than the mere non user of the right to foul a stream belonging to a mill as an easement can be said to constitute an abandonment of the easement. (*Mousson & Co. v. Boehm*, 26 Ch. D. 398.) The burden of proof lies on the party who affirms abandonment. *Julian v. Hoosier Drill Co.*, 75 Ind. 408; *Saxlehner v. Eisner*, 179 U. S. 19.

In re Vulcan Trade-Mark, 22 D. L. R. 214, 15 Ex. C. R. at p. 265, Mr. Justice Cassels, considering a contention that the petitioners had abandoned their right to the trade-mark by reason of length of time which had elapsed between the various shipments of matches from Sweden to Canada said: “. . . it is to be borne in mind that no intention to abandon can reasonably be inferred in this case as the petitioners were continuously engaged in the manufacture and sale of these matches practically over the world. Sales, according to the evidence, have amounted in value to about one million pounds sterling and according to the evidence of Palmgren at the time of giving his evidence the sale of goods was at the rate of over one hundred thousand pounds sterling per annum.”

Words May Become Publici Juris.—In some cases, words which are originally distinctive are used in such a way as to indicate an article itself, or its method of manufacture instead of the origin. If a trader allows a word coined by him to be generally used and appropriated by others in the trade, it may become “publici juris” and cease to be capable of protection as a trade-mark. In the leading Canadian case of *Partlo v. Todd*, 17 S. C. R. 196, the words “Gold Leaf” were found to be well known, and in use as a brand designating a par-

ticular quality of flour manufactured by what was known in trade as "patent process," by whomsoever manufactured; the term had no connection with any particular persons or mill. "Gold Medal" has been held open to the same objection. *Dominion Flour Mills Co. v. Morris*, 2 D. L. R. 830.

The word "Singer" as applied to sewing machines has been the source of extended litigation involving this point. In the *Singer Manufacturing Co. v. Dame Sophie Maria Charlebois et vir* (Q. R. 16 S. C. 167) it was held that the petitioner had not the right to prevent the respondent from using the word "Singer" in connection with sewing machines, although they were entitled to an injunction against the use of the name in any way which would deceive the public and lead to the belief that the machines made by her were of petitioner's manufacture.

The decision in the above case is consistent with the principle established in a number of cases in England, that where a word, which has no descriptive meaning to persons unacquainted with the particular trade, indicates to traders in those goods a process or principle, it is descriptive and incapable of exclusive appropriation.

In *Wheeler & Wilson v. Shakespear*, (1870) 39 L. R. Ch. 36, the defendant had advertised himself as the agent for sale of the Wheeler-Wilson machine, although he was not the plaintiffs' agent, and was not selling their machines. James, V. C., while restraining him from advertising himself as the plaintiff's agent refused to restrain him from describing the machines sold by him as Wheeler & Wilson's. That was not the name of the makers, but of the principle or process and the monopoly granted under the expired patent could not be continued by granting a monopoly in the name.

The decision was followed in 1875 in *Singer v. Wilson*, L. R. 2 Ch. 434. The House of Lords, however, (1877) 3 App. Cas. 376, gave no decision as to whether the word "Singer" was indicative of a maker or of a principle of construction, the defendant's evidence being incomplete; but in *Singer v. Loog*, (1880) 18 Ch. D. 395; (1882) 8 App.

Cas. 15 it was decided that a trader has a right to make and sell machines similar in form and construction to those made and sold by a rival trader, and in describing and advertising his own machines to refer to his rival's machines and his rival's name, provided he does so in such a way as to obviate any reasonable possibility of misunderstanding or deception. There the defendant had placed upon the machines which he sold a plate marked Singer Machine, but bearing also words referring to the foreign makers of the goods. This plate he offered to abandon, but he claimed the right to use the word Singer to describe his machines. In his advertisement he referred to "our Singer Machines," and to machines made on the Singer system. It having been held by the Court of Appeal and the House of Lords that the documents issued by the defendant were not calculated to deceive and the action having, therefore, failed, the question as to the secondary meaning of the word Singer did not arise (18 Ch. D. 417), but the plaintiffs admitted that if the defendant should show that the article in question was a specific article known by a specific name, and that, as in the case of Wellington boats or Hansom cabs, he was unable to designate the article in any other way than by its known name, the plaintiffs could claim no exclusive use of the word. Lush, L. J., said, at the close of his remarks (18 Ch. D., p. 428):

Possibly the time has come when the Singer Machine might now be popularly understood to mean not a machine made by any person of the name of Singer, but a machine of the description and kind known as the Singer machine. However . . . that question does not arise. . . . I would only further observe that whenever the question does arise, there is a great body of evidence before us now to shew . . . that at all events at the present time the word Singer has become in popular use and acceptance a word of description, rather than a word denoting the maker.

Lord Selbourne, on the other hand, came to the conclusion (8 App. Cas., p. 26), unhesitatingly, that the term Singer system had become a bona fide and intelligible description of some really distinctive character or characters in that method of construction.

In the United States there are a number of cases following the lines indicated above: *Singer Manufacturing Co. v. Larsen*, (1878) 8 Biss. 181; *Singer Manufacturing Co. v. Stanage*, (1881) 2 McRary 512; *Singer Manufacturing Co. v. Riley*, (1882) 11 Fed. Rep. 706, and *Brill v. Singer*, (1884) 41 Ohio 127. Treat, J., in the *Stanage* case: "Where a patented article is known in the market by any specific designation, whether the name of the patentee or otherwise, every person, at the expiration of the patent, has a right to manufacture and vend the same under the designation thereof by which it was known to the public."

In England where a trade-mark is found to be in use by more than three firms in different parts of the country, what is known as the "three mark rule" is applied and the mark is considered to be common to the trade: In *re Walkeden Aerated Water Co.*, 54 L. J. Ch. 394; In *re Hyde & Co.*, 54 L. J. Ch. 395.

In *Lambert Pharmacel Co. v. Palmer*, (1912) 2 D. L. R. 358 (annotated), 21 Que. K. B. 451, the failure by the owner of the trade-mark "listerine" to complain against a party using the word "Listerated" for tooth powder in the United States was held to create a presumption that he suffered no injury therefrom, and was estopped from taking proceedings subsequently in Canada for infringement.

Fraudulent Use Does Not Make Word Publici Juris.— Long use by another, if fraudulent, does not render trade-mark publici juris. In the case of *The United States Playing Card Co. v. Hurst*, 31 D. L. R. (annotated), 37 O. L. R. 85, the trade-marks in question consisted of the word "Bicycle" and special designs applied to Playing Cards. It was alleged that the marks had become publici juris, not only on account of the defendants user but because of the manufacturing of cards which might be deemed infringement by Montreal manufacturers. Middleton, J., in his judgment, said:

I am content to accept the law as laid down by the Hon. H. Fletcher Moulton in the Article on Trade-Marks, Halsbury's Laws of

England, vol. 27, p. 774, para. 1356. Long user by another, if fraudulent, does not affect the plaintiff's right to a final injunction.

But I think that here there clearly has been no sufficient evidence of any acquiescence in the use by the defendant or Messrs. Goodall & Co. to constitute an abandonment.

In 1905, apparently, an action was threatened, exactly what for is not made plain; but the defendant himself says that the action was not prosecuted because of his assurances; and his further conduct has not been shown to have come to the knowledge of the plaintiff company before the bringing of this action.

In *Ford v. Foster* (1872) L. R., 7 Ch. 611, the test is clearly stated by Sir G. Mellish, L. J., at p. 628: "I think the test must be, whether the use of it by other persons is still calculated to deceive the public, whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trade as if they were his goods. If the mark has come to be so public and in such universal use that nobody can be deceived by the use of it, and can be induced from the use of it to believe that he is buying the goods of the original trader, it appears to me, however hard to some extent it may appear on the trader, yet practically, as the right to a trade-mark is simply a right to prevent the trader from being cheated by other persons' goods being sold as his goods through the fraudulent use of the trade-mark, the right to the trade-mark must be gone." Lord Justice James thus deals with the argument that the thief acquires a right by continual thieving, saying (p. 625): "It has been said that one murder makes a villain and millions a hero; but I think it would hardly do to act on that principle in such matters as this, and to say that the extent of a man's piratical invasions of his neighbour's rights is to convert his piracy into a lawful trade."

National Starch Manufacturing Co. v. Munn's Patent Maizena and Starch Co. (1894) A. C. 275, shows that, where the trade-mark has become *publici juris*, mere fraud on the part of the defendant is not enough to entitle the plaintiff to an injunction; but that cannot help the defendant here; for, in my view, the trade-marks never become, in any sense, *publici juris*, within the meaning of that term as explained by Sir George Mellish.

CHAPTER VI.

TRANSFER OR ASSIGNMENT.

Section 15 of the Trade-Marks and Design Act reads:

Assignment.

15. Every trade-mark registered in the office of the Minister shall be assignable in law.

2. On the assignment being produced, and the fee by this Act prescribed therefor being paid, the Minister shall cause the name of the assignee, with the date of the assignment and such other details as he sees fit, to be entered in the margin of the register of trade-marks on the folio where such trade-mark is registered. R. S., ch. 63, sec. 16.

In England a trade-mark cannot be severed from and used independently of the good will of the business in connection with which it is used, *Leather Cloth Companies' Case*, 4 De. G. J. & S. 137. To permit this would lead to deception of the public.

The express terms of our statute with respect to assignment of trade-marks, and which does not refer to good will, has given our courts some difficulty. In *Smith v. Fair*, 14 O. R. 729, *Proudfoot, J.*, pointed out that there is no restriction in the Canadian Act preventing transmission of a trade-mark except in connection with good-will, although a sale of the good will of a business would carry the trade-mark with it.

The decision of *Proudfoot, J.*, in this case, that a trade-mark may be assigned apart from the good will of the business in connection with which it is used, has never been overruled, but on the other hand, there is the decision of *Lount, J.*, in *Gegg v. Bassett*, 2 O. L. R. 263, to the contrary. In that case the learned Judge said: "The right is assignable it is true, but only, I think, in connec-

tion with the good-will of the business, general or specific, in which the trade-mark has been used." See also *Thompson v. MacKinnon*, 21 L. C. J. 355, where it was held that the sale of a business with the good-will conveyed the exclusive right to use the trade name and trade-mark of the vendor. See also *Love v. Latimer*, 32 O. R. 231. It will be noted that in *Smith v. Fair*, these words were used: "It may readily be granted that it (the trade-mark) cannot exist in gross not attached to specific articles, and that by a sale of the good will of a business, a trade-mark would pass." If it cannot exist in gross, it is difficult to see how a trade-mark can be assigned in gross, nor is it reasonable to suppose that it can be revived again and applied to specific articles after it has been detached and assigned in gross. *Fry, L. J.*, in *Pinto v. Badman*, (1891) 8 R. P. C. 181, said: "It (a trade-mark) may be assigned if it is indicative of origin, where the origin is assigned with it. It cannot be assigned when it is divorced from its place of origin, or when in the hands of the transferee, it would indicate something different to what it indicated in the hands of the transferor."

The English rule is that a trade-mark is assignable and transmissible only in connection with the good-will of the business concerned with the goods or classes of goods to which it relates: *Patents Act, 1883, sec. 70*; *Hall v. Barrows*, (1863) 4 De. G. J. & S. 150; *Edwards v. Dennis*, (1885) 30 Ch. D. 454; *In re Welcome*, (1886) 32 Ch. D. 213.

This proposition was fully established before the first Registration Act was passed: *Hall v. Barrows* (supra); *Leather Cloth Company v. American Leather Cloth Company*, (1863) 4 De. G. J. & S. 137, per Lord Westbury, C. Sebastian, 5th Ed., at p. 116, says: "Even apart from the Act, there is no doubt that the trade-mark cannot be severed from and used independently of the good-will. If that could be done, the indicium might only serve to mislead."

That a trade-mark cannot exist in gross unattached to specific articles is established by many cases: *McAndrew v. Bassett*, (1863) 4 De. G. J. & S. 380; *Leather Cloth Com-*

pany v. American Leather Cloth Co., *ib.* 137, 11 H. L. C. 523; *Dixon v. Guggenheim*, (1870) 2 Brews. 321; *Wheeler v. Johnston*, (1879) 3 L. R. Ir. 284, the reason being that in such a case the mark might come to be a means of fraud instead of a guarantee of worth.

Upon the sale of a business and good will, the trade-mark, in the absence of anything indicated to the contrary, will pass as a matter of course: *In re Roger*, (1895) 12 R. P. C. 149; *Currie v. Currie*, (1897) 15 R. P. C. 339; *Shipwright v. Clements*, (1871) 19 W. R. 559. In this last case, *Malins, V. C.*, held that upon a sale of the good-will of a business, the trade-mark would pass, whether specially mentioned or not. This was, in effect, what was held in *Robin v. Hart*, 232, p. 316, where *Townsend, J.*, said: "I think there are expressions and words sufficiently distinct and comprehensive to include trade-marks. The operative words of the assignment are: 'Of and in all that concern or business carried on under the style or firm of Messieurs Robin & Co., as aforesaid, and all, etc., etc., merchandise, effects and premises, and all and whatsoever may appertain to or belong to the same or any part thereof.' When it is remembered that the assignment carries with it in terms the good-will of the business, it seems to me we can come to no other reasonable conclusion than that it was intended to and does include the exclusive right to use this trade-mark." And he referred to *Bury v. Bedford*, (1864) 4 De. G. J. & S. 352, where it was held that words no more definite in a creditor's deed covered a trade-mark used in connection with the assignor's business.

The right of property in a registered trade-mark is not saleable by itself under a writ of execution. (*Gegg v. Bassett*, 3 O. L. R. 263.)

A judicial abandonment of property assented to by an insolvent for the benefit of his creditors include a trade-mark of which the insolvent is registered proprietor. (*Lavard v. Vexina*, (1913) 20 R. L. N. S. 71.)

While there are at present no general bankruptcy laws in Canada, it seems clear from the English cases that under such laws the trustee or representative in bankrupt-

cy would have the power to deal with any trade-marks and the good-will of the business connected therewith. (*Hudson v. Osborne*, 39 L. J. Ch. 79.) In the case of a company, the same right will pass to the assignee or liquidator. (*In re Bolanche's Empire Chocolate Co.*, 89 L. T. (J) 273.)

In a partnership, the trade-marks in the absence of agreement, are part of the partnership assets. (*Bury v. Bedford*, 4 De. G. J. & S. 352.) Upon dissolution of the partnership the trade-mark follows the good-will of the business. (*Banks v. Gibson*, 34 Beav. 566.) If more than one partner continues to carry on the same business, then each is at liberty to use the same mark as before. (*Condy v. Mitchell*, 37 L. J. N. S. 268.)

In the event of death, the title to a trade-mark passes to the legal personal representative of the proprietor. (*Gilbert v. Read*, 9 Mod. 459.) The proprietor may, however, bequeath the business and trade-mark used therewith according to pleasure. (*Dent v. Turpin*, 2 J. & H. 139.)

It will be seen that through dissolution of partnership bequest, etc., it is possible for concurrent rights to be formed in a trade-mark. (*Hine v. Lart*, 10 Jur. 106.)

Any operative form of assignment will be accepted by the registrar, only one copy need be forwarded to him. It is the practice to record an abstract of the assignment in the register on the folio on which the certificate of registration is made. The assignment itself with a certificate of registration attached is returned to the party forwarding it for registration. The registration fee is two dollars for each trade-mark assigned.

CHAPTER VII.

RECTIFICATION AND ALTERATION OF REGISTER

Rectification and Alteration of Register.—Sole jurisdiction to rectify any entry made in the register of trade-marks, or in the register of industrial designs is now given to the Exchequer Court. Sections 42, 43 and 44 of the Trade-Mark and Design Act read:

Sections 42, 43 and 44.—42. The Exchequer Court of Canada may, on the information of the Attorney General, or at the suit of any person aggrieved by any omission, without sufficient cause, to make any entry in the register of trade-marks or in the register of industrial designs or by any entry made without sufficient cause in any such register, make such order for making, expunging or varying any entry in any such register as the Court thinks fit; or the Court may refuse the application.

2. In either case, the Court may make such order with respect to the costs of the proceedings as the Court thinks fit.

3. The Court may in any proceedings under this section decide any questions that may be necessary or expedient to decide for the rectification of any such register. 54-55 V., c. 35, s. 1.

43. The registered proprietor of any registered trade-mark or industrial design may apply to the Exchequer Court of Canada for leave to add to or alter any such trade-mark or industrial design in any particular not being an essential particular and the Court may refuse or grant leave on such terms as it may think fit.

2. Notice of any intended application to the Court under this section for leave to add to or alter any such trade-mark or industrial design shall be given to the Minister and he shall be entitled to be heard on the application. 54-55 V., c. 35, s. 1.

44. A certified copy of any order of the Court for the making, expunging or varying of any entry in the register of trade-marks or in the register of industrial designs, or for adding to or altering any registered trade-mark or registered industrial design, shall be transmitted to the Minister by the Registrar of the Court, and such register shall thereupon be rectified or altered in conformity with such order, or the purport of the order otherwise duly entered therein, as the case may be. R. S., c. 63, s. 34; 54-55 V., c. 35, s. 1.

Section 23. Exchequer Court Act.—Section 23 of the Exchequer Act reads:

The Exchequer Court shall have jurisdiction as well between subject and subject as otherwise:—

(a) in all cases of conflicting applications for any patent of invention, or for the registration of any copyright, trade-mark or industrial design;

(b) in all cases in which it is sought to impeach or annul any patent of invention, or to have any entry in any register of copyrights, trade-marks or industrial designs, made, expunged, varied or rectified; and,

(c) in all other cases in which a remedy is sought respecting the infringement of any patent of invention, copyright, trade-mark or industrial design. 54-55 V., c. 26, s. 4.

Trade-Mark Registration May Be Impeached in Action for Infringement.—While the jurisdiction of the Exchequer Court is exclusive as respects expunging or rectifying a registration, the foregoing sections are not to be taken as depriving the Provincial Court of Jurisdiction respecting the validity of a registered trade-mark. This point was disposed of in *Provident Chemical Works v. Canada Chemical Manufacturing Co.*, (1902) 4 O. L. R. 545, where Moss, J. A., delivering the judgment of the Court of Appeal, said:

Their first contention is that the learned Chief Justice erroneously held that it was open to the defendants to impeach in this action the plaintiff's title as registered proprietors of the trade-mark upon which they rely. It is contended on the plaintiffs' behalf that *Partlo v. Todd* (1886) 12 O. R. 175; (1887) 14 A. R. 444, and (1888) 17 S. C. R. 196, no longer governs, owing to subsequent legislation; and that the defendants are now entitled to attack, by way of defence, the plaintiffs' right to register or put forward as a trade-mark the letters or characters in question. It is argued that the effect of 54 and 55 Viet., c. 26, s. 4, and 54 and 55 Viet., c. 35, s. 1, amending R. S. C., c. 63, is to vest in the Exchequer Court of Canada the sole jurisdiction to adjudicate upon the validity of a trade-mark, and so the Provincial Courts have no longer jurisdiction to entertain, in an action for infringement of a registered trade-mark, a defence to the effect that the plaintiff is not the proprietor of the trade-mark, or that it is not one capable of registration. *Partlo v. Todd* was decided under 42 Viet., c. 22 (D), now R. S. C., c. 63. It was held that there was nothing in that Act to prevent a defendant in an action complaining of an infringement of a registered trade-mark from impeaching the validity of the trade-mark or the plaintiff's title thereto. It was there contended for the plaintiff that under the Canadian Act a defendant was not even in as advantageous position as a defendant in England, who under the Imperial Act, might question the alleged trade-mark provided five years or more had not elapsed since the reg-

istration. But it was pointed out that it was open to question whether a defendant in England might not impeach a registered mark by way of defence even after the lapse of five years from registration. And it was clearly determined upon the construction of the Canadian Act that the only action which it authorized to be brought as for an infringement of a trade-mark was an action by the proprietor of the trade-mark who had registered under the provisions of this Act; that the certificate of registration was only prima facie evidence of these facts, and that it was open to the defendants to shew that the plaintiff was not the proprietor of a trade-mark when he registered, and that what he had registered was not capable of registration as a trade-mark for the exclusive use of the party registering. In other words, that mere registration did not create a trade-mark, but that before registration the party seeking to register must have acquired the proprietorship of the mark, name, brand, label, package or other business device which he procured to be registered for his exclusive use; and that the register or certificate of registration was not conclusive, and did not preclude a defendant from impeaching a plaintiff's right or title. The first amendment of the law, after *Partlo v. Todd*, was by 53 Viet., c. 14 (D), which substituted a new section for section 11 of R. S. C., c. 63. The effect of it was to refer to the Exchequer Court of Canada the decision of any question arising where a person made application to register as his own trade-mark which had been already registered, and the Minister of Agriculture was not satisfied that such person was undoubtedly entitled to the exclusive use of such a trade-mark. This section only extended the jurisdiction of the Exchequer Court to that particular class of cases and it saved the jurisdiction "as to any question arising thereunder" which any other Court possessed.

By 54 and 55 Viet. c. 35 this Act was repealed and new sections were submitted for sections 11, 12 and 33 of R. S. C., c. 63. By section 11 the Minister of Agriculture is empowered to refuse to register in certain cases. He may, however, "if he thinks fit," refer the matter to the Exchequer Court, and in that event such court is to have jurisdiction to hear and determine the matter, and to make an order determining whether, and subject to what conditions, if any, registration is to be permitted. This is a limited jurisdiction and only to be exercised in case the Minister of Agriculture, instead of determining the question for himself, thinks fit to refer it. By section 12 the Exchequer Court is empowered on the information of the Attorney General, or at the suit of any person aggrieved by any omission without sufficient cause to make entry on the register of trade-marks, or by an entry made therein without sufficient cause, to make such order for making, expunging, or varying the entry as it thinks fit, and to "decide any question that may be necessary or expedient to decide for the rectification of such a register." The Court may also entertain an application by the registered proprietor of any registered trade-mark to add to or alter such mark in any non-essential particular

And the register is to be rectified or altered in conformity with any order of the Court pronounced under these powers. Nothing is added to the provisions of the Revised Statutes bearing on the effect of the register as rectified or altered.

By 54 and 55 Viet., c. 26 (D), entitled an Act further to amend the Exchequer Court Act, it is enacted (section 4) that the Exchequer Court shall have jurisdiction as well between subject and subject as otherwise, (a) in all cases of conflicting applications for a patent or invention or for the registration of any copyright, trade-mark or industrial design, (b) in all cases in which it is sought to have any entry in any register of copyright, trade-mark or industrial designs made, expunged, varied or rectified, (c) in all other cases in which a remedy is sought respecting the infringement of any patent of invention, copyright, trade-mark or industrial design.

The provisions of these two acts, while extending the jurisdiction of the Exchequer Court so as to enable it to deal with doubtful or conflicting applications to make, expunge, vary or rectify entries on the register, and even to entertain actions for injunctions or damages for infringement, do not extend or enlarge, or assume to extend or enlarge, the effect of registration or the certificate thereof.

The certificate is still only *prima facie* evidence of the facts stated therein, and there is nothing in the legislation depriving a defendant of the right to show that the facts were not truly stated, and that in truth there were no good or valid grounds for registering the alleged trade-mark. This may lead to the somewhat anomalous result that a Provincial Court, in an action for infringement, may decide as to the validity of a trade-mark in one way, while the Exchequer Court, on an application to expunge or rectify the register may decide the contrary. But if the proprietor chooses to invoke the aid of the Provincial Court, instead of resorting, as he may do, in the first instance to the Exchequer Court, the defendant is entitled to the judgment of the tribunal upon the question of the plaintiff's title if he desires to raise it. The Exchequer Court is not expressly given exclusive original jurisdiction in regard to the class of cases enumerated in section 4, but by section 5 it is given exclusive jurisdiction in cases of claims to public lands. I think that it was open to the defendants in this case to impeach the plaintiffs' right to the trade-mark which they put forward as the foundation of the action.

Any Person Aggrieved.—A suit for making, expunging or varying any entry in the register may be brought by "any person aggrieved" by any omission without sufficient cause—or by any entry made without sufficient cause. The wide interpretation given "any person aggrieved" in the English cases has been adopted in Canada. *De Kuyper v. Van Dulken*, 24 S. C. R. 114; following

Powell v. Birmingham Vinegar Co., (1894) A. C. 8; Re Auto Sales Gum & Chocolate Co., 14 Ex. C. R. 302, 14 D. L. R. 917. In the Supreme Court, in Re Vulcan Trade-Mark, 51 S. C. R. 411, 24 D. L. R. 621, affirming 15 Ex. C. R. 265, 22 D. L. R. 214, Davies, J., said: "The words 'any person aggrieved' embrace anyone who may possibly be injured by the continuance of the mark on the register in the form and to the extent it is so registered."

In Auto Sales Gum & Chocolate Co., 14 Ex. C. R. 302, 14 D. L. R. 917, it was alleged that certain registered trade-marks had been abandoned but no application was made on the part of the petitioner to have a similar trade-mark registered. In the judgment Cassels, J., said:

It is apparent, however, that the petitioner is aggrieved by permitting the entry of these trade-marks if they ought not properly be on the register—it is certainly embarrassing to say the least, and in my opinion the petitioner is a party entitled to make application.

It would appear that any person interested in the same trade and dealing in the same class of goods might properly petition to have a trade-mark removed if it ought not to be in the register. Lord Herschell, in Re Powell, (1895) A. C. 8, said:

Whenever it can be shown that the applicant is in the same trade as the persons who have registered the trade-mark, and wherever the trade-mark, if remaining in the register, would or might limit the legal rights of the applicant, so that, by reasons of the existence of the entry upon the register, he could not lawfully do that which, but, for the appearance of the mark upon the register he could lawfully do, it appears to me that he has a locus standi to be heard as a person aggrieved. *Rose v. Evans*, 48 L. J., Ch. 618; *In re Edge*, 8 R. P. C. 307; *In re Apollinaris Co.*, (1891) 2 Ch. 186; *In re Powell*, (1893) 2 Ch. 388.

Under the English cases the "person aggrieved" must be able to show that in some possible way he may be damaged or injured if the trade-mark is allowed to stand. (*In re Wright, Crossley & Co.*, 15 R. P. C. 131.) A mere sentimental grievance such as that of the Society of Friends with respect to the word "Quaker" is not sufficient. (*In re Ellis & Co.*, 21 R. P. C. 617.) A person sued for infringement of the trade-mark is obviously "aggrieved." *Thompson v. Montgomery*, 41 Ch. D. 35; *In re Ralph* 25 Ch. D. 194.

"Without Sufficient Cause."—A registration is made without sufficient cause if the Minister should have refused registration under Section 11 of the Trade-Mark and Design Act. The most frequent objection raised is that the registered proprietor is not the owner of the trade-mark and entitled to the exclusive right of use thereof (*The J. P. Bush Manufacturing Co. v. Hanson et al.*, 2 Ex. C. R. 559) or was not the first to use the trade-mark. *Groff v. The Snow Drift Baking Powder Co.*, 2 Ex. C. R. 568.

Abandoned Trade-Mark.—The question whether abandonment after registration was a ground for expunging was raised in *Auto Sales Gum & Chocolate Co.*, 14 Ex. C. R. 302, where Cassels, J., after referring to Section 42 of the Trade-Mark and Design Act, said:

"This section is practically identical with section 90 of the English Patents, Designs, and Trade-Marks Act of 1883. The section is to be found in Sebastian's Law of Trade-Marks, 5th Ed., p. 630.

The case generally referred to is that of *J. Batt & Co.*, (1898) 2 Ch. D. 432, 701, which came before Justice Romer.

That was a case in which an application was made to expunge certain trade-marks from the register. In that case an application was also made to have registered a trade-mark on behalf of the applicants.

In the case before me the only application is an application to rectify the register by having the two trade-marks referred to expunged. There is no application on the part of the petitioner to have a trade-mark similar to the registered trade-marks registered by them. It is apparent, however, that the petitioner is aggrieved by permitting the entry of these trade-marks if they are not properly to be on the register, it is certainly embarrassing to it to say the least, and in my opinion the petitioner is a party entitled to make application."

In the *Batt* case the ground of the decision in the court below was that at the date of registration there was no bona fide intention on the part of the firm to use the trade-marks. The *Batt* case was appealed. (1898) 2 Ch. D. 439; (1898) 15 Rep. Pat. Cas. 534.

The Court was composed of Lindley, M. R., and Chitty and Collins, L. J. J.

The Master of Rolls in giving judgment at page 441, puts a construction upon the statute as follows:

"It remains only to consider whether section 90 of the Act of 1883 (the rectification section) is applicable to this case. We are of the opinion that it is. The applicants are parties aggrieved; for the trade-

marks they desire to have registered is kept off the register by reason of the presence on it of the marks of J. Batt & Co. The entry of these marks is an entry made without sufficient cause in the register. We are not disposed to put a narrow construction of this expression, nor to read it as if the word "made" were all the word, and as if the words "made without sufficient cause" were "made without sufficient cause at the time of registration," so as to be confined to that precise time. If an entry is at any time on the register without sufficient cause, however it got there, it ought, in our opinion, be treated as covered by the words of the section. The continuance there can answer no legitimate purpose; its existence is purely baneful to trade, and in our opinion in the case supposed the Court has power to expunge or vary it."

This case was taken on appeal to the House of Lords (1899) A. C. 428. The Earl of Halsbury, L. C., in giving judgment says, *Id.*, p. 429:—

"My Lords, whatever may be the ultimate decision on the abstract proposition as to whether or not there can be a keeping for the time of a trade-mark which originally was bona fide intended to be used, but which from accident or some other cause has not been used, I purpose giving no other opinion upon it at present for this reason, that it does not arise in this case.

"The result is the statement approved of by the Judges in the Court of Appeal, Lindley, M. R., and Chitty and Collins, L. J., has not been disturbed (1899) 2 Ch. D. 439."

While it may be that it was not necessary to place a construction upon section 90 of the Act of 1883, as set out in that part of the judgment which I have quoted, nevertheless it is needless to say they are judgments of three well-known jurists which can carry great weight. Moreover, there is a great deal to be said in favour of such a construction.

The third sub-section of section 42 provides that the court may decide any question that may be expedient to decide for the rectification of the register.

It seems to me that under the circumstances alleged in this petition, if the facts are substantiated, it is very inexpedient if people are permitted to retain upon the register of trade-marks, marks that are embarrassing and baneful to the trade.

The case of *Re Smollens' Trade-Mark* to which I was referred in the Weekly Notes of 3d February, 1912, at p. 35, is reported in full in 29 Rep. Pat. Cas. at p. 158. I do not think that case furnishes any help in the case before me. It was an application made under the Trade-Mark Act, 1905. The statute has been altered by amending the old section 90 of the statute of 1883, and by inserting the words "or by any entry wrongly remaining on the register, which placed the question of jurisdiction beyond doubt. See section 35 Trade-Mark Act, 1905. Furthermore, the provisions of the English Trade-Mark Act,

1905, section 37 made the thing quite clear. There is no case in our courts that I know of which deals with the question.

As I have previously stated no application has been made on the part of the petitioner to register these words as its own trade-mark.

It was conceded before me that notwithstanding the prior user of the trade-mark, if such trade-marks have been abandoned and not used by others for a period of years, it would be no bar to the registration of the same words, assuming them to be the subject matter of a trade-mark, by another. I do not wish to pass upon the question as to whether or not a trade-mark could not be registered if in point of fact the party applying for registration could show that notwithstanding the prior registration such trade-mark had been abandoned for such a length of time as to entitle the other to adopt it as his own and have it placed upon the register. It may be that if the owner of the registered trade-mark had in point of fact abandoned it, in any action brought by him to enforce such trade-mark a defence could be set up by the abandonment; and it may be that such a case could be made on the application to register by the subsequent adopter of the trade-mark, assuming him to be entitled thereto. On this point, however, I pass no opinion as the case has not been argued before me. I think the legal objection must be overruled with costs of the applications to the petitioner in any event."

(See also *Re Vulcan Trade-Mark*, 15 Ex. C. R. 265; 51 S. C. R. 411, 24 D. L. R. 621.)

Grounds for Removal from Register.—A classification for the various grounds for removal which have been supported in the English cases, may be found on p. 635 of Sebastian on Trade-Marks, 5th Edition. The principal of these grounds are that:

- (1) The word or device used as a trade-mark is not distinctive, being in common use or descriptive.
- (2) The mark is not used in connection with the goods for which it is registered.
- ✓ (3) The trade-mark was abandoned or was never used.
- (4) The mark is too similar to earlier marks.
- (5) The mark is deceptive.
- (6) The registered proprietor is not owner nor entitled to the exclusive use of the mark.

Canadian Cases.—The Canadian cases on expunging have been mainly concerned with the question of ownership or priority.

Bush v. Hanson.—In the *P. J. Bush Mfg. Co. v. Hanson et al.*, (1889) 2 Ex. C. R. 559, the Deputy Minister of Agriculture who had jurisdiction under R. S. C. (1886) c. 23, s. 11, cancelled a registered trade-mark including the word "Bovinine" on proof that the applicants or plaintiffs had better title from the original owner of the trade-mark in the United States. The Deputy Minister appeared to be of the opinion of that a limitation as to place of use was improper in the transfer of a trade-mark. The pertinent part of his judgment reads:

"Upon this statement of facts it is important to define that a trade-mark is a simple and absolute property, the same as a signature, or the name and style of a firm, without any limitation as to country, and runs everywhere throughout the domain of commerce.

In other words, the essential characteristics of a legal trade-mark are: (a) Universality of right to its use, that is, it is good as a representation of, or substitute for, the owner's signature all the world over; and (b) exclusiveness of the right to use.

If the same trade-mark were to be used by different persons for the same species of merchandise, it would lead to inextricable confusion, it is true, and only legitimate purpose would be neutralized and destroyed, and it would lack the essential element of origin or ownership.

Tried by the test of these definitions the limitations in the transfer by which Hanson & McLaughlin hold their claim to the title of the trade-mark in question renders the registration invalid.

Groff v. The Snow Drift Company.—A similar case before the Deputy Minister of Agriculture was *Groff v. The Snow Drift Company of Brantford*, (1889) 2 Ex. C. R. 569, in which the registration was cancelled upon the proof of prior use in Canada of the word-symbol "Snow Flake" by the applicant. An attack was also made on the mark as descriptive, but the Deputy Minister was satisfied that the words were a "fanciful description."

De Kuyper v. Van Dulken.—In *De Kuyper v. Van Dulken*, (1894) 24 S. C. R. 114, the Supreme Court affirmed a decision of the Exchequer Court ordering the defendant's mark to be rectified to make it clear that the heart-shaped label formed no part of the registered trade-mark. The case on infringement was not sustained. The head notes in the report of the Supreme Court judgment are:

In the certificate of registration the plaintiffs' trade-mark was described as consisting of "the representation of an anchor, with the letters J. D. K. & Z." or the words "John DeKuyper & Son, Rotterdam," as per the annexed drawings and application. In the application the trade-mark was claimed to consist of a device or representation of an anchor inclined from the right to the left in combination with the letters "J. D. & K. & Z." or the words "John DeKuyper, &c., Rotterdam," which it was stated, might be branded or stamped upon barrels, kegs, cases, boxes, capsules, casks, labels and other packages containing geneva sold by plaintiffs. It was also stated in the application that on bottles was to be affixed a printed label, a copy or facsimile of which was attached to the application, but there was no express claim of the label itself as a trade-mark. This label was white and in the shape of a heart with an ornamental border of the same shape, and on the label was printed the device or representation of the anchor with the letters "J. D. K. & Z." and the words "John DeKuyper & Son, Rotterdam," and also the words "Genuine Hollands Geneva, & Son, Rotterdam," which were admitted were common to the trade.

The defendants' trade-mark was, in the certificate of registration, described as consisting of an eagle having at the feet "V. D. W. & Co.," above the eagle being written the words "Finest Hollands Geneva"; on each side "Van Dulken, Welland & Co." and the word "Sctriedam," and lastly at the bottom the two faces of a third medal, the whole on a label in the shape of a heart (*le tout sur une etiquette en forme de coeur*). The colour of the label was white.

Held, affirming the judgment of the Exchequer Court, that the label did not form an essential feature of the plaintiffs' trade-mark as registered but that, in view of the plaintiff's prior use of the white heart shaped label in Canada, the defendants had no exclusive right to the use of the said label, and that the entry in the register of their trade-mark should be so rectified as to make it clear that the heart-shaped label formed no part of such trade-mark. Taseherau and Gwynne, J. J., dissenting on the ground that the white heart-shaped label with the scroll and its constituents, was the trade-mark which was protected by registration, and that the defendants' trade-mark was an infringement of such trade-mark.

Re Bucyrus Trade-Mark.—In *re Bucyrus Trade-Mark*, (1912) 14 Ex. C. R. 35, 8 D. L. R. 920, affirmed (47 S. C. R. 484, 10 D. L. R. 513) the question of title and of secondary meaning for a geographical term raised. The head notes to the reports of the case read:

Over thirty years before the petition filed, the petitioners' predecessors in the title set up business in the town of Bucyrus, in the State of Ohio, as iron founders and manufacturers. Subsequently the peti-

tioners became incorporated in that State under the title of Bucyrus Shovel and Dredge Company. In 1893 the petitioner took over the business, removed to South Milwaukee, in the State of Wisconsin, and became incorporated under the laws of the State of Wisconsin as the "Bucyrus Steam Shovel and Dredge Company." From that time on they made a specialty of the manufacture of railway wrecking cranes, steam shovels and railway pile drivers, and appliances connected therewith. The articles so manufactured were not protected by patents or trade-marks in the United States, but the word "Bucyrus" was applied to such articles either alone or in some combination, to distinguish the goods, and became well-known to the trade. In 1904, the respondent was appointed sole agent for Canada and Newfoundland for the manufacture and sale of the petitioners' goods, under a written agreement whereby the petitioners undertake to supply the respondents with blue prints, drawings and other sources of information concerning their goods, for the purpose of promoting the sale thereof in Newfoundland and in Canada. The agency under said agreement was terminated in 1909. Thereafter the respondent proceeded to manufacture in Canada goods similar to those made by petitioners with the designation "Canadian Bucyrus" attached to them, and in 1911 caused these words to be registered as a specific trade-mark at Ottawa.

Held, that the respondents' trade-mark was bad, and should be expunged from the register.

2. That the word "Bucyrus" had become identified with the goods manufactured by the petitioners and had so acquired a secondary meaning, and that the petitioners were entitled to register in Canada the word "Bucyrus" as a specific trade-mark to be applied to the sale of goods manufactured by them.

Re Vulcan Trade-Mark.—In re Vulcan Trade-Mark, (1914) 15 Ex. C. R. 465, 22 D. L. R. 214, related to a general trade-mark consisting of the word "Vulcan" registered on January 24, 1904, by a firm of wholesale grocers. The petitioners were manufacturers of matches, and sought to have trade-marks including the word "Vulcan" registered as a specific trade-mark as applied to matches. It was proved that the petitioner, a Swedish company, made shipments of matches bearing the trade-mark to Canada in 1882. There were no shipments between 1885 and 1895. The argument as to abandonment was not sustained by the court in view of extensive and continuous business carried on by the petitioners in other parts of the world. An order was made directing the general trade-mark registration

to be limited by excluding therefrom the use of the word "Vulcan" as applied to matches.

In the Supreme Court in the same case on the question of jurisdiction, it was that the Exchequer Court had jurisdiction under Sections 11, 12, 13 and 42 of the Trade-Mark and Design Act notwithstanding that the matter was not referred to the Court by the Minister. It does not appear that any cases have as yet been referred to the Exchequer Court under Section 12 of the Trade-Mark and Design Act.

Re Autosales Gum and Chocolate Co.—The decision in *Re Autosales Gum & Chocolate Co.*, (1913) 14 Ex. C. R. 302, 14 D. L. R. 917, held that the Exchequer Court has jurisdiction, on the application of any party aggrieved, to order the rectification of the register of a trade-mark by expunging therefrom a mark that, through non-use or abandonment, remains improperly thereon to the embarrassment of trade.

Mickelson Shapiro Co. v. Mickelson Drug & Chemical Co.—*Mickelson Shapiro Co. v. Mickelson Drug & Chemical Co.*, (1914) 15 Ex. C. R. 276, was an action for both infringement and to expunge. The action for infringement failed because the trade-mark as registered did not specify the words "Kill-Em-Quick" which were the principal infringement complained of. These words were shown on the drawings but not described in the application. The defendant's registration included the words as a prominent feature, and was ordered to be expunged because the evidence was clear that the words "Kill-Em-Quick" had been used by many persons before the plaintiff and further because the registration, in the face of assignments by the plaintiffs, was a fraud on the part of the defendant's predecessor in title.

Bowker Fertilizer Co. v. Gunns, Limited.—In the recent case of *Bowker Fertilizer Company v. Gunns, Limited.*,—27 D. L. R. 469, Ex. C. R.—the words "Shur-Crop" were expunged from the registration of Gunns, Limited, upon evidence that the petitioner had for many years sold fertil-

izer in a large way under the name "Bowker's Sure Crop Fertilizer." Registration of the words "Sure Crop" alone was, however, refused on the grounds that the words were descriptive, and in any event had not been used alone.

Procedure on Action to Expunge.—An action to expunge or vary, is started by a petition filed in the Exchequer Court. It must be printed and a certified copy served on the registered owner of the trade-mark sought to be expunged. A statement of objection or reply may then be filed by the owner of the trade-mark, and further pleading then, if necessary, be filed according to the rules of the court. The usual practice applies as to Discovery, Production of Documents and other incidental proceedings.

The following revised general rules and orders of the Exchequer Court were promulgated September 24th, 1913:

Rule 34.—In the case of any proceeding for the registration of any copyright, trade-mark or industrial design, a notice of the filing of the petition, giving the object of the application and stating that any person desiring to oppose it must, within fourteen days after the last insertion of the notice in the Canada Gazette, file a statement of his objections with the Registrar of the Court and serve a copy thereof upon the petitioner, shall be published in four successive issues of the Canada Gazette. The notice of the filing of the petition in the case of any proceeding for the registration of any copyright, trade-mark or industrial design, may be in the form published in Schedule "A" hereto. In the case of any proceeding to have an entry in any register expunged, varied or rectified, it shall not be necessary to publish any notice of the filing of the petition.

Rule 35.—In the case of any proceeding for the registration of any copyright, trade-mark or industrial design, a copy of the petition and notice above mentioned shall be served upon the Minister of Agriculture and upon any person known to the petitioner to be interested and to be opposed to the application.

In the case of any proceeding to have an entry in any register of copyrights, trade-marks or industrial designs expunged, varied or rectified, it shall not be necessary to serve a copy of the petition upon the Minister of Agriculture, and it shall suffice, if such petition be served upon any person known to the petitioner to be interested in and to be opposed to the registration.

Rule 37.—In the case of any proceeding for the registration of any copyright, trade-mark or industrial design, if any person appears to oppose the application he shall, within fourteen days after the last

publication of the said notice in the Canada Gazette, file with the Registrar and serve upon the petitioner a statement of his objections to the application.

Rule 49.—Notice of trial in any proceeding for the registration of any copyright, trade-mark or industrial design, shall be given to the Minister of Agriculture and to the opposite party if the application to register be opposed. But in the case of any proceeding to have an entry in any register of copyrights, trade-marks or industrial designs expunged, varied or rectified, notice of trial shall be given to the opposite party only.

SCHEDULE "A."

Notice.

IN THE EXCHEQUER COURT OF CANADA.

In the matter of the petition of

A. B. of

the City of

and

Manufacturer, or as the case may be.

In the matter of

The Trade-Mark consisting of

Notice is hereby given that, on the _____ day of _____ 19____, there was filed, in the Exchequer Court of Canada, a petition of A. B., of the City of, etc., that a certain trade-mark described in the said petition, as consisting of (here give description) be registered as a trade-mark in the Register of Trade-Marks and in the Department of Agriculture at Ottawa.

Any person desiring to oppose the said petition must, within fourteen days after the last insertion of the present notice in the Canada Gazette (the date of the last insertion being the day of _____ 19____), file a statement of his objections with the Registrar of the Exchequer Court of Canada at Ottawa, and serve a copy thereof upon the petitioner or his solicitor.

Dated this _____ day of _____ 19____.
 C. D. (Petitioner in person)
 or E. F.
 No. _____ Street, Ottawa,
 Solicitor for Petitioner.

It will be noted that where the petition seeks only to expunge or vary a registered trade-mark it is not necessary either to serve the Minister of Agriculture, or to advertise in the Canada Gazette.

Where the petitioner is not within the jurisdiction se-

curity will, on application of the objecting party or defendant, be ordered in the usual amount—four hundred dollars. An order for security will not, however, be ordered against the defendant whose trade-mark the petitioner seeks to expunge. *Wright, Crossley & Co. v. The Royal Baking Powder Co.*, (1898) 6 Ex. C. R. 143.

If the petition does not give sufficient information, particulars may be ordered. It is usual to order the plaintiff to give particulars of date and place of first use of the trade-mark.

After issue has been joined in the pleadings, either party may move to have the case set down for trial. The trial is held in open Court, and evidence given by *viva voce* testimony. Where a witness resides outside the jurisdiction and it is not possible to produce him, a commission may be issued to a suitable commissioner to take the testimony, either on written interrogative or *viva voce* examination. The evidence taken under the Commission may be read at the trial.

Actions to expunge or vary are usually tried at Ottawa. The rules would permit the venue being changed, however, to any locality, according to the balance of convenience.

From a judgment of the Exchequer Court an appeal, by leave of a Supreme Court Judge, lies to the Supreme Court of Canada.

Costs are in the discretion of the Court and are generally awarded to the successful party. If success is divided each party pays his own costs.

An action for infringement may be joined with an action to expunge or vary.

CHAPTER VIII.

ACTIONS FOR INFRINGEMENT

General Statement.—In an action for infringement of a registered trade-mark the complaint is that the defendant has infringed the plaintiff's mark by taking it wholly or some essential part thereof, and the claim is based on the plaintiff's exclusive right given by statute.

Rights of Aliens.—An alien, not an enemy, if he is the owner of a trade-mark which exists as such in this country, may properly sue in Canada in respect of infringements therein. *Collins Co. v. Brown*, (1857) 3 K. & J. 423; *Collins Co. v. Reeves*, (1858) 28 L. J. Ch. 56. But the alien must comply with Section 20 of the Trade-Mark and Design Act, requiring registration of the mark before action.

Liability of Agent.—As the action is one of tort, every infringer is liable to be sued, whether he acted on his own behalf or as agent.

Assignment Need Not Be Registered.—Though it is necessary to register the mark before action, and to prove registration; yet, where the claimant is assignee of the original owner, the assignment of the mark need not be registered. *Carey v. Goss*, 11 O. R. 619.

Certificate Prima Facie Evidence.—The certificate of registration given by the Minister of Agriculture is prima facie evidence of due compliance with the requirements of the Act and of the facts alleged therein. *Partlo v. Todd*, 17 S. C. R. 1906.

An action for infringement cannot be maintained by a person claiming under a sale of the infringed trade-mark made under an execution. *Gegg v. Bassett*, 3 O. L. R. 203.

What Constitutes Infringement.—Infringement is the use by the defendant for trading purposes in connection

with goods of the kind for which the plaintiff's right to exclusive use exists, (i. e., goods for which his mark is registered and used), not being the goods of the plaintiff, of a mark identical with the plaintiff's mark, or comprising some essential features, or colourably resembling it, so as to be calculated to cause the goods to be taken by ordinary purchasers for the goods of the plaintiff.

The essential ingredients for constituting an infringement of that right would probably be found to be no other than these: first, that the mark has been applied by the plaintiffs properly (that is to say), that they have not copied other person's mark, and that the mark does not involve any false representation; secondly, that the article so marked is actually a vendible article in the market; and, thirdly, that the defendants, knowing that to be so, have imitated the mark for the purpose of passing in the market other articles of a similar description. Per Lord Westbury, in *McAndrew v. Bassett*, (1863) 4 De. G. J. & S. 380.

Proof of Single Act Generally Sufficient.—Single acts of infringement have in a few cases been held out not to be sufficient. *Henessy v. Kennett*, (1877) Seb. Dig. 331; *Leahy, Kelly & Leahy v. Glover*, (1893) 10 R. P. C. 141; *Rutter v. Smith*, (1901) 18 R. P. C. 49. But the first case was a "trap" case, and the second and third were passing off cases. In general, proof of a single act of infringement by the defendant is sufficient. *American Tobacco Co. v. Guest*, (1892) 1 Ch. 630; *Dunlop Pneumatic Tire Co. v. Neal*, (1899) 1 Ch. 807.

Defendant must be shewn to use or to be intending to use, the spuriously marked goods for trade purposes, and the possession of such goods by a trader in goods of the kind in large quantities, is strong evidence against him. *Levy v. Walker*, (1879) 10 Ch. D. 436; *Richards v. Butcher*, (1890) 7 R. P. C. 288; *Upmann v. Forester*, (1883) 24 Ch. D. 231.

Infringement Must Take Place within This Country.—The infringement must take place within this country. *Badische Fabrik v. Basle Chemical Works*, (1898) A. C. 200; *Morocco Syndicate v. Harris*, (1895) 1 Ch. 534; *Joseph Rodgers v. Rottgen*, (1889), 5 R. T. L. 678; *Tm. of*

the Societe, etc., des Verreries de l'Etoile, (1894) 1 Ch. 61; 2 Ch. 26. It is sufficient if any goods are spuriously marked in this country for export. *Orr-Ewing v. Johnston*, (1882) 13 Ch. D. 434; 7 App. Cas. 219.

Must Be Same Class of Goods.—The use must be in connection with the goods for which the plaintiff's right exists. *Templeton v. Wallace*, 4 Terr. L. R. 340; *Hall v. Barrows*, (1863) 4 De G. J. & S. 150.

And Spurious Goods.—The infringement must be in respect of spurious goods, for anyone may use the plaintiff's mark on the plaintiff's goods. *Farina v. Silverlock*, (1855) 1 K. & J. 508; *Condy v. Taylor*, (1887) 56 L. T. 891; *Siegert v. Findlater*, (1878) 7 Ch. D. 801; *Richards v. Williamson*, (1874) 30 L. T. N. S. 746.

Plaintiff Must Have Used and Adopted.—The plaintiff must have used and adopted the mark. Mere user by the public of the mark to indicate plaintiff's goods will not confer any right in the mark or name. *Robinson v. Bogle*, 18 O. R. 387.

Infringing Mark Need Not Be Actually Affixed.—The infringing mark need not be actually affixed to the goods, provided it is so used in connection therewith as to be calculated to cause them to be taken for the plaintiff's goods. *Jay v. Ladler*, (1888) 40 Ch. D. 649; *Chamelon Patents, Etc. Co. v. Marshalls*, (1900) 17 R. P. C. 527; *Guinness v. Ullmer*, (1847) 10 L. T. O. S. 127; *Jameson & Sons, Ltd. v. Johnston & Co., Ltd.*, (1901) 18 R. P. C. 517; *Rose v. Henley*, (1877) 47 L. J. Ch. 577; *Barnett v. Leuchars*, (1865) 13 L. T. N. S. 405.

A trader must not use a registered trade-mark even in its ordinary English sense, if such use could mislead or deceive the public in presuming that the word referred to the commodity of the person complaining. *Vineberg v. Vineberg's, Limited*, (1913) 43 Que. S. C. 406 affirmed 16 D. L. R. 195, 23 Que. K. B. 256 Re Trade-Mark "Progress" as applied to Clothing.

Must Be Actual or Substantial Copy.—The infringing mark may be an actual or substantial copy of the plaintiff's mark. This was the case in *Provident Chemical Works v. Canada Chemical Mfg. Co.*, 4 O. L. R. 545 ("C. A. P."); *Robin v. Hart*, 23 N. S. 316 ("C. R. C."); In re *Melchers and De Kuyper*, 6 Ex. C. R. 82 (heart-shaped labels). In these cases actual deception of purchasers need not be shown (*Wilson v. Lyman*, 25 A. R. 303) or even that the use is calculated to deceive. *Edwards v. Dennis*, (1885) 30 Ch. D. 454. The plaintiff relies on the statute: his registration being conclusive evidence of his right to the exclusive use of the trade-mark.

Essential Feature Taken.—Where the essential feature is taken a case of infringement may be made out, for, though the plaintiff's right is to the trade-mark as a whole, the use of an essential feature may be so calculated to mislead purchasers as to be an infringement in effect. *Crawford v. Shuttock*, 13 Gr. 149; *Davis v. Kennedy*, 13 Gr. 53; *Barsalou v. Darling*, 9 S. C. R. 677; *Spilling v. Ryall*, 8 Ex. C. R. 195.

In *Partlo v. Todd*, 12 O. R. 171; 14 A. R. 444; 17 S. C. R. 196, *Proudfoot, J.*, said:

To constitute an infringement it is not necessary that every part be copied; it is sufficient if enough be copied to have a tendency to deceive the public. Cf. per *Moss, C. J. O.*, in *Wilson v. Lyman*, 25 A. R. 303.

What Resemblances Are Calculated to Deceive?—Lord *Cranworth*, in *Seixo v. Provezende*, (1865) L. R. 1 Ch. at p. 196, says:

It is obvious that questions of considerable nicety arise as to whether the mark adopted by one trader is or is not the same as that used by another trader complaining of its illegal use, and it is hardly necessary to say, that, in order to entitle a party to relief it is by no means necessary that there should be absolute identity. What degree of resemblance is necessary, from the nature of things, is a matter incapable of definition a priori. All that courts of justice can do is to say that no trader can adopt a trade-mark so resembling that of a rival as that ordinary purchasers, purchasing with ordinary caution, are likely to be misled.

Rules of Comparison.—The following is a short statement of the general rules of comparison which have been adopted on this question:

1. **The "Idea of the Trade-Mark" Is to Be Regarded.**

—In considering the principles of comparison which should control either the Minister of Agriculture or the Court in considering whether one trade-mark so resembles another as to be calculated to deceive or mislead the public, the language used in the report by Lord Herschell's Committee on Trade-Marks, given at length in Kerly on Trade-Marks, 2nd Ed., p. 227, is of value. It is here said:

Two marks when placed side by side may exhibit many and various differences, yet the main idea left on the mind by both may be the same; so that a man acquainted with the first mark registered, and not having the two side by side for comparison might well be deceived if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with the goods which bore the same mark as that with which he was acquainted. Take, for example, a mark representing a game of football; another mark may show players in a different dress, and in very different positions, and yet the idea conveyed by each might be simply a game of football (Compare *Barker's Tm.*, (1885) 53 L. T. 23, per Kay, J.). It would be too much to expect that persons dealing with trade-marked goods, and relying as they frequently do, upon marks should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing.

The leading cases bear out the remarks just noted.

In *Johnston v. Orr-Ewing*, 7 App. Cas. 219, where both the plaintiff's and the defendant's marks consisted of tickets bearing pictures of two elephants with a banner between them, the figures being different, Lord Selborne, L. C. (at p. 225), used the following language:

Although the mere appearance of these tickets could not lead anyone to mistake one of them for another, it might easily happen that they might be taken by natives of Aden or India, unable to read and understand the English language, as equally symbolical of the plaintiffs' goods. To such persons, or at least to many of them, even if they took notice of the differences between the two labels, it might probably appear that these were only the differences of ornamentation, posture and other accessories, leaving the distinctive and characteristic symbol unchanged.

In the *Taendstikker Case*, (1886) 3 R. P. C. 54 (C. A.), there was a question of the resemblance between two labels. The appellant's label as registered consisted of a black oblong bearing the word *taendstikker* printed at the bottom, and the word *nitedales* at the top, and a small geometrical device having two over-lapping medals on each side of it in the middle. The rival label was of a similar appearance, with the word *medals* instead of *nitedales*, two black spaces having the same outline as the medals, and a cross instead of the device, the blanks and cross corresponding in size and shape with the medals and devices. It was shown that in practice the respondents printed representations of medals over the blanks.

Lord Esher said:

The trade-mark is the whole thing—the whole picture on each. You have therefore to consider the whole. Mr. Justice Chitty has looked at the distinguishing features. He, I think, only looked to see whether, with that distinction, the whole was like or unlike. That is what he did, but the argument raised by Mr. Romer . . . was this: the moment there is not any distinction in any part, the things are at once alike. That is his point. . . . It seems to me that he has fallen into this fallacy—he takes each thing by itself, and says either it is common or it's the same, and leaves out altogether the mode in which the things are put together in the two pictures. Lindley, L. J., said: "The difference here, looking at the boxes, is simply this that the word *medals* is used instead of *nitedales*, all the rest being, according to the evidence common. Now I do not think that this is a dissimilarity which is sufficient in this case. . . . The question is, What is the effect of the use or introduction of that distinguishing character (the name at the top or bottom of the label) on the whole? When you look at the whole, then it appears to me, I confess, that the dissimilarity is not enough to make the whole dissimilar."

See *Abbott v. Bakers', Etc., Association*, (1872) W. N. 31 per Lord Chancellor Hatherly: "Though no one particular mark was exactly imitated, the combination was very similar and likely to deceive." *Farrow's Case*, (1890) 63 L. T. 233.

But where the resemblances are common parts alone and nothing distinguishing to the one has been taken by the owner of the other, there is no infringement. *Jamieson v. Jamieson*, (1898) 15 R. P. C. 169; *Payton & Co., Ltd. v.*

Snelling, Lampard & Co., Ltd., (1900) 17 R. P. C. 49, affirmed by H. of L. 628; Payton & Co., Ltd. v. Titus, Ward & Co., Ltd., (1900) 17 R. P. C. 58. In this last case Lindley, M. R., said:

When what is called the plaintiff's get-up consists of two totally different things combined, namely, a get-up common to the trade and a distinctive feature affixed or added to the common features, then what you have to consider is not whether the defendants' get-up is like the plaintiffs' as regards the common features, but whether that which specially distinguishes the plaintiffs' has been taken by the defendants'. A defendant may take it more or less. It is seldom that he copies it. Of course he does not do that, but if he so nearly takes it that when you look at it as a whole you can say that the defendants' goods are calculated to be taken for the plaintiffs' goods when properly looked at—if you can say that—then the plaintiff is entitled to succeed.

See also Currie & Co.'s Application, (1896) 13 R. P. C. 681, Kerwick, J., ("Cock o' the North" Label).

2. The Marks Are to Be Compared as Used in Business from Day to Day, and Not to Be Merely Viewed Side by Side as in Samples Presented to the Court or the Minister.
—The standpoint of comparison must be that of the unwary or incautious purchaser. *Seixo v. Provezende*, (1886) L. R. Ch. 192; *Wilkinson v. Griffith*, (1891) 8 R. P. C. 370; *Rosing's Application*, (1878) 54 L. J. Ch. 975n; *Lyndon's Tm.*, (1885) 32 Ch. D. 109; *Lambert's Tm.*, (1889) 61 L. T. 344; *Davis v. Reid*, 17 Grant. 69; *Partlo v. Todd*, 17 S. C. R. 196; *Re Jelly*, (1875) 51 L. J. Ch. 639n. Moreover, the Court should consider the mark as actually used and lawfully altered by the owner. *Worthington's Case*, (1879) 14 Ch. D. 8; *Smith v. Fair*, 14 O. R. 729 ("seal" cases); *Melachrino v. The Melachrino Egyptian Cigarette Co.*, (1887) 4 R. P. C. 215; *Rowland v. Mitchell*, (1897) 14 R. P. C. 37. "I agree," said Fry, L. J., in *Re Lyndon's Trade-Mark* at p. 122, "with what was said by the Master of the Rolls in *Re Rosing's Application*, that you must have regard to size, and I think you must also have regard to the material upon which the mark is to be impressed and also to the natural imperfections of the impressions."

3. **The Court Must Have Regard to the Market or Trade in Which the Goods are to Be Trafficed.**—It must consider whether it is a home or foreign market; what other similar trade-marks are extant in those markets; what are the customs and usages of the trade. In the report of Lord Herschell's Committee, above referred to it was said. "One chief complaint has been that the usages of the trade and character of the markets where the marks are intended to serve their purposes have not been sufficiently kept in view." Compare the remarks of Lord Selborne in *Johnston v. Orr-Ewing*, 13 Ch. D. 464; 7 App. Cas. 230 "Although the mere appearance of these tickets could not lead anyone to mistake one of them for the other, it might easily happen that they might both be taken by the natives of Aden or India, unable to read and understand the English language, as equally symbolical of the plaintiff's goods.

If there are numerous marks of the same kind on the register, a similar mark, though to be applied to a different class of the same kind of goods, may be rejected. *Hargreaves' Case*, (1897) 11 Ch. D. 669; *Thewlis and Blakey's Tm.*, and *Hughes and Young's Tm.*, (1893) 10 R. P. C. 369; *Orr-Ewing v. The Registrar of Tms.*, (1879) 4 App. Cas. 479; *Konig v. Ebhardt's Tm.*, (1896) 2 Ch. 236.

4. **Known by Name of Mark.**—Where a trader's goods are known by a name suggested by the mark, rival marks could not fail to lead purchasers to attribute the goods marked with such marks the same name as that under which the trader's goods were known, will not be sanctioned. *Seixo v. Provezende*, (1866) L. R. 1 Ch. D. 454; *Speer's Tm.*, (1887) 55 L. T. 880; *Swiss Condensed Milk Co. v. Metcalf*, (1886) 31 Ch. D. 454; *Baschiera's Tm.*, (1889) 5 T. L. R. 54; *Dewhurst's Application*, (1896) 2 Ch. 137; *Currie & Co.'s Application*, (1896) 13 R. P. C. 681.

Not Infringement to Take Non-essentials.—It is not an infringement to take non-essentials from the mark, *Lino-leum Mfg. Co. v. Nairn*, (1878) 7 Ch. D. 834; *Watt v.*

O'Hanlon, (1886) 59 L. T. 820; Native Guano Co. v. Sewage Manure Co., (1888) 8 R. P. C. 125; Rugby Cement Co. v. Rugby & Newbold Co., (1891) 9 R.P.C. 46; Wilson v. Lyman, 1 C. L. R. 434; Kerry v. Les Soeurs, 26 L. C. J. 51; Watson v. Westlake, 12 O. R. 449.

"Colourable Imitation."—The cases most frequently met with are those of colourable imitation. The test, here, as well as where an essential feature has been copied, is whether or not the defendant's mark is calculated to have his goods to be taken by the public for the goods of the plaintiff. Barsalou v. Darling, 9 S. C. R. 677; Davis v. Reade, 17 Gr. 69; Kerry v. Les Soeurs, 26 L. C. J. 51; Canada Publishing Co. v. Gage, 6 O. R., 68, 11 A. R. 402, 11 S. C. R. 306; Wilson v. Lyman, 25 A. R. 303; Partlo v. Todd, 12 O. R. 171, 14 A. R. 444, 17 S. C. R. 196. This was the law before the Registration Acts. Mitchell v. Henry, (1880) 15 Ch. D. 181; Singer Mfg. Co. v. Loog, (1870) 8 App. Cas. 15; Edward's v. Dennis, (1885) 30 Ch. D. 454.

Actual Deception Need Not Be Proved.—Actual deception is not required to be proved, especially where the imitation is marked and decided, yet it is an important circumstance in a case where the essence of the plaintiff's case is that the mark is so connected with the plaintiff's goods as to denote them and no other. Per Moss, C. J. O., in Wilson v. Lyman, 25 A. R. 303. So where no one is shown to have been deceived, the Court may look at the marks in order to judge whether or not the public could be deceived. Watson v. Westlake, 12 O. R. 449. But the plaintiff is not bound, it has been said, to wait to see whether his customers will, in fact, be deceived, for, "the very life of a trade-mark depends upon the promptitude with which it is vindicated." Johnston v. Orr-Ewing, (1880) 13 Ch. 54.

In one Canadian case it was said by Burbridge, J., that it was the duty of the Minister of Agriculture to refuse to register a trade-mark where it was clear that deception might not result. In Re Melchers and De Kuyper, 6 Ex.

C. R. 82. The courts have not, however, considered how the mark will appear when used in an ordinary way of business, bearing in mind its size. *Davis v. Read*, 17 Gr. 69, imperfections in its impression, and indistinctness resulting therefrom: *ibid*; *Barsalou v. Darling*, 9 S. C. R. 677; the circumstances under which the mark was adopted: *ibid*; *Canada Publishing Co. v. Gage*, 6 O. R. 58, 11 A. R. 402, 11 S. C. R. 306; *In re Melchers and De Kuyper*, 6 Ex. C. R. 82; *Provident Chemical Works v. Canada Chemical Mfg. Co.*, 4 O. L. R. 545.

Examples of "Colourable Imitation" in Canada.—The following are instances in Canada where it was held that there was an infringement either by taking the mark in its entirety, or in some substantial part, or by colourably imitating it:

"Imperial Family Soap," plus a star infringed by "Imperial Bibasic Soap Co.," plus a star. *Crawford v. Shuttock*, 13 Gr. 149.

"Horse Head," substantially imitated by a "Unicorn's Head," the only distinguishing mark being a horn placed on the forehead of the unicorn, which in practice, was not clearly brought out. *Barsalou v. Darling*, 9 S. C. R. 677.

"Beatty's New and Improved Headline Copy-book," held to be a colourable imitation of "Beatty's Headline Copy-Book." *Canada Publishing Co. v. Gage*, 6 O. R. 68, 11 A. R. 402, 11 S. C. R. 306.

"The Commercial Travellers' Journal," known as "Commercial Traveller," or "Traveller," infringed by the "Traveller." *Cary v. Goss*, 11 O. R. 619.

A monogram "R. S.," with the words "real seal" infringed by a monogram "A. F. seal." *Smith v. Fair*, 14 O. R. 729.

"C. R. C.," imitated by "C. R. C." (the defence here was that the plaintiff had not title). *Robin v. Hart*, 23 N. S. 316.

Letter "B" stamped on buttons of braces infringed by letter "D" on similar buttons the possibility of comparison to the ear as well as visual resemblance being considered. *Doran v. Hogadore*, 11 O. L. R. "My Valet" in-

fringed by "My New Valet." My Valet, Limited, (1912) 27 O. L. R. 286, 9 D. L. R. 306.

"The Boston Rubber Shoe Co.," infringed by the "Boston Rubber Company of Montreal." Boston R. S. Co. v. Boston R. Co. of M., 1 C. L. R. 217 and 317.

"C. A. P." ("Cream Acid Phosphates"), infringed by "C. A. P." (Calcium Acid Phosphates). Provident Chemical Works v. Canada Chemical Mfg. Co., 4 O. L. R. 545.

Vignette of King Edward with "Our King" above and "King Edward VII." below, infringed by a fac simile of the Royal Arms surmounted by "King Edward." Spilling v. Ryall, 8 Ex. C. R. 195.

See also devices in Davis v. Reid, 17 Gr. 69.

Probability of Deception, a Question of Fact.—Probability of deception being, of course, a question of fact, decided cases are of no assistance in determining new questions of fact raised under new circumstances, except in so far as they establish a general principle of comparison. "How can observations of Judges upon other and quite different facts bear upon the present case, in which the only question is what is the result of the evidence?" Lord Westbury asked in Johnston v. Orr-Ewing, (1882) 7 App. Cas. 219.

Defences.—It may be shewn that the mark is not a valid mark, and should not have been registered at all. Smith v. Fair, 4 O. R. 729; Partlo v. Todd, 12 L. R. 171, 14 A. R. 444, 17 S. C. R. 196; as where the words are in common use or are deceptive: Ibid; Gillet v. Lumsden, 8 O. L. R. 300; Watson v. Westlake, 12 O. R. 449, Wilson v. Lyman, 25 A. R. 303. Prior user for a different class of goods forms no bar. In Templeton v. Wallace, 4 Terr. L. R. 340, the words "Simpson's Kidney Pills" were held a good trade-mark, although "Simpson's" had been used as a name of pills for other complaints. The fact that the name was fictitious was immaterial. It may also be shown that the trade-mark was used by the defendant and others prior to the plaintiff's use. Farfard v. Ferland, 9 Que. P. R.

119. In *Gorham Manufacturing Co. v. Ellis & Co.*, 8 Ex. C. R. 401, the plaintiffs brought action for infringement of a trade-mark which so resembled the Birmingham Hall Mark or a hall mark, as to be calculated to deceive or mislead the public, and it appeared that the goods bearing the Birmingham Hall Mark were also on the market here. It was held that the plaintiff could not, under the circumstances, acquire the exclusive right to the use as a trade-mark of the mark that he had been using.

In *Partlo v. Todd* it was said that where the statute prescribes no means of rectification of an improperly registered trade-mark, the Court may afford relief by way of defence. It is apprehended that this is true even now, when the statute does afford a means of rectification. *Asbestos v. Sclater*, Q. R. 10, Q. B. 165.

It may be shewn that the requirements of the statute have not been complied with. *Davis v. Kennedy*, 13 Gr. 523; *Davis v. Reid*, 17 Gr. 69.

Or that there has been no infringement. *Kerry v. Les Soeurs*, 26 L. C. R. 51.

Or that the plaintiff is not entitled to bring the action: as where the plaintiff claimed under a sale to him by the sheriff. *Gegg v. Bassett*, 3 O. L. R. 262.

Under the English law the defendant may shew an independent or concurrent right to use the mark complained of. *Jackson v. Napper*, (1886) 35 Ch. D. 162; *Mouson v. Boehm*, (1884) 26 Ch. D. 398; *Edge v. Gallon*, (1900) 16 R. P. C. 509; *Meaby v. Trictitine*, (1897) 15 R. P. C. 1. As the Canadian statute extends exclusive protection throughout the whole of Canada it is doubtful whether this law will apply here.

Absence of fraudulent intent is not a defence. *Rose v. MacLean*, 24 A. R. 240, per Boyd, C.

Estoppel.—The plaintiff may be shewn to be debarred from suing the defendant for all or part of the relief he seeks, by (a) an agreement; (b) acquiescence or license; (c) delay; (d) because the mark is deceptive or his trade-mark is fraudulent. (a) *Grezier v. Autram*, (1896) 13 R. P. C. 1; *Oldham v. James*, (1862) 13 Ir. Ch. 393; 14 Ir. 81;

(b) *Mouson v. Boehm*, (1884) 26 Ch. D. P. 406; *Eldon v. Dicks*, (1878) 10 Ch. D. 247; *Re Farina*, (1879) 27 W. R. 456; *Kinahan v. Bolton*, (1863) 15 Ir. Ch. 75. The failure of the owner of the trade-mark "listerine" to complain of or proceed against a party using the word "listerated" in the United States, for a number of years creates a presumption that he suffered no injury therefrom, and in the absence of the proof of special damage he is estopped from taking proceedings subsequently in Canada, for infringement. *Lambert Pharmacel Co. v. Palmer*, (1912) 2 D. L. R. 358 (annotated), 21 Que. K. B. 451; (c) delay not sufficient to call the Statute of Limitations into operation does not bar the right of action, but may modify the relief granted: *Provident Chemical Works v. Canada Chemical Mfg. Co.*, 4 O. L. R. 545; *Fullwood v. Fullwood*, (1878) 9 Ch. D. 178; *Harrison v. Taylor*, (1865) 12 L. T. N. S. 339; *Beard v. Turner*, (1865) 13 L. T. N. S. 746; it may amount to abandonment if long continued: *Hyde's Tm.*, (1878) 7 Ch. D. 724; *National Starch Mfg. Co. v. Munns & Co.*, (1894) A. C. 275; *Ripley v. Baudey*, (1897) 14 R. C. 591. (d) *Leather Cloth Co. v. American Leather Cloth Co.*, (1863) 4 De. J. & S. 137; *Ford v. Foster*, (1872) L. R. 7 Ch. 611; *Templeton v. Wallace*, 4 Terr. L. R. 340; *Davis v. Kennedy*, 13 Gr. 523; it is only where the trade-mark itself contains misrepresentations that the plaintiff will be non-suited. See cases just cited and *Wood v. Lambart*, (1886) 32 Ch. D. 247; *Cheavin v. Walker*, (1877) 5 Ch. D. 862; the *Apollinaris Case*, (1891) 2 Ch. 186, decided that it is fatal to indorse upon a trade-mark anything which is calculated to mislead the public as to what is the mark of which the proprietor claims the exclusive use. See also *Hammond v. Bruncker*, (1892) 9 R. C. P. 301. Defendant in answer to conclusions demanding that he be ordered to cease the use of a trade-mark may plead that he has ceased to use it before the institution of the action. *Fafard v. Ferland*, 6 Que. P. R. 119.

The Relief Granted.—The plaintiff may obtain an order for: (1) An injunction restraining fur-

ther infringements of his rights; (2) the delivery up for destruction, or for the erasure of the mark of any goods already marked with the spurious mark, and in the possession or control of the defendant, or for the destruction of any labels in existence shewing the spurious mark; (3) and damages in respect of the past infringement, or, in lieu of damages, an account of profits, or for some one or more of these remedies.

Injunction.—The grant of an injunction in trade-mark cases is governed by the general rules governing it when other rights are concerned. There must be some threat or probability that the infringement will be commenced, continued, or repeated. But one act of infringement is sufficient: it need not be repeated for “the life of a trade-mark depends upon the promptitude with which it is vindicated.” *Johnson v. Orr-Ewing* (1882) 7 App. Cas. 219; *Upman v. Forrester*, (1883) 24 Ch. D. 231. An injunction will be granted even though the defendant has discontinued the use of the labels complained of and offered to undertake not to use them any longer. *Guinness v. Heap*, (1878) Seb. Dig. 377; and though no actual infringement has occurred. *Emperor of Austria v. Day & Kossuth*, (1861) 3 De. G. F. & J. 217; *Upman v. Elkan*, (1871) L. R. 12 Eq. 140.

The form of injunction used in *Metzler v. Wood*, (1877) L. R. 9 Ch. D. 606, was adopted in *Canada Publishing Co. v. Gage* 6 O. L. R. 68, 11 A. R. 412, 11 S. C. R. 306. Other forms are given in the following cases: *Carey v. Goss*, 11 O. R. 619; *Davis v. Reid*, 17 Gr. 69; *Singer v. Charlebois*, Q. R. 16 S. C. 167.

Interim Injunction.—An interim injunction is usually obtained as soon as the action is commenced to restrain the defendant from continuing the acts complained of until the hearing or further order. *Wilkinson v. Griffith*, (1891) 8. R. P. C. 370; *Cowie v. Herbert*, (1897) 14 R. P. C. 436. It may be obtained *ex parte* in special cases, but is usually after notice of motion. When there is some likely or plausible defence offered at the hearing of the interloc-

utory motion, the Court is guided principally by the balance of the convenience, that is by the relative amounts of damage likely to result if the injunction is granted and the plaintiff ultimately fails, or, if it is refused, and he ultimately succeeds. *Read v. Richardson*, (1881) 45 L. T. 54; *Radde v. Norman*, (1872) L. R. 4 Eq. 348. Delay on the part of the plaintiff may be ground for refusing. *North British Rubber Co. v. Gormully Co.*, (1894) 12 R. P. C. 17; *Apollinaris Co. v. Heffeldt*, (1887) 4 T. L. R. 9. An interim injunction is limited as closely as possible and is granted only on terms of an undertaking as to damages. *Ibid*; *Mansell v. British Linen Co. Bank*, (1892) 3 Ch. 159.

Delivery Up.—Delivery up of the marked articles for destruction has never been used in a Canadian case, but the practice is established in England in cases where the false marks cannot be erased. *Farina v. Silverlock*, (1858) 4 K. & J. 650; *Slazenger v. Feltham*, (1889) 5 T. L. R. 365. In *Davis v. Kennedy*, the destruction of labels bearing the infringing mark was ordered. Under the Criminal Code of Canada, Section 450, every chattel, article, instrument or thing by means of which any trade-mark has been falsely applied or forged (which offences include applying to any goods a trade-mark or any other mark so nearly resembling a trade-mark as to be calculated to deceive) shall be forfeited.

Damages or Profits.—Damages or an account of profits, or both, may accompany the injunction. Damages were awarded in *Barsalou v. Darling*, 9 S. C. R. 677; *Rose v. McLean*, "24 A. R." 240; *Vive Camera Co. v. Hogg*, Q. R. 18 S. C. 1; *Provident Chemical Works v. Canada Chemical Mfg. Co.*, 4 O. L. R. 545. But where the defendant did not in any way seek to put off his goods for those manufactured by the plaintiff, or in any to gain any trade advantage, only an injunction was granted. *Spilling v. Ryall*, 8 Ex. C. R. 159. The onus for shewing substantial damage lies, of course, on the plaintiff. *Leather Cloth Co. v. Atlas Metal Co.*, (1896) L. R. 1 Eq. 299; *Magnolia Metal Co. v. Atlas Metal Co.*, (1896) 14 R. P. C. 389. The modern Eng-

lish rule is that both damages and account of profits will not be granted, though such combination was formerly allowed. *Lever v. Goodwin*, (1887) 36 Ch. D. 1; *Neilson v. Betts*, (1871) L. R. 5 H. L. 1. This is apparently not so in Ontario. In one case both were asked for, and, though, only a reference as to damages was granted, this was because it had not been shewn that any profits had accrued: nothing was said as to the two being inconsistent, or that, by the taking of account, the infringement was condoned. *Provident Chemical Works v. Canada Chemical Mfg. Co.*, 4 O. L. R. 545. In *Smith v. Fair*, 14 O. R. 729, the account of profits it was held, should not be limited to the time subsequent to the registration of the mark, especially so where the infringement prior to the registration has been fraudulent. Damages can only be recovered, and profits to be included in the account can only be reckoned, in respect of infringement occurring within six years from the issue of the writ. Per Lord Mellish in *Ford v. Foster*, (1872) L. R. 7 Ch. 633. An account of profits has been refused where the plaintiff has been dilatory or has acquiesced for a time in the infringement. *Harrison v. Taylor*, 11 Jur. N. S. 408; 12 L. T. N. D. 339; *Beard v. Turner*, (1865) 13 L. T. N. S. 746; *Cave v. Myers*, (1868) Seb. Dig. 181; *Lee v. Haley*, (1869) L. R. 5 Ch. 155. In a recent American case, *Hamilton-Brown Shoe Company v. The Wolf Brothers & Co.*, (1916) 225 O. G. 1441, the Supreme Court held that where there is no means of ascertaining what proportion of the infringer's profit is due to the trade-mark and what to the intrinsic value of the commodity, the owner of the trade mark should be awarded the whole profit.

Until the result of the references as to the damages or account is known, the costs of the references should be reserved. *Stark v. Midland Rail Co.*, (1880) 16 C. D. 81; *Provident Chemical Works v. Canada Chemical Mfg. Co.*, 4 O. L. R. 545.

Costs.—The costs, as the costs of any other action, are in the discretion of the Judge. The unsuccessful party is

usually ordered to pay the costs, but the Court has deprived a successful party of his costs on account of unmeritorious conduct. *Robinson v. Bogle*, 18 O. R. 387; *Rose v. McLean*, 24 A. R. 240; *Leather Cloth Co. v. American Leather Cloth Co.*, (1863) 11 H. L. C. 523; *Rodgers v. Rodgers*, (1874) 31 L. T. N. S. 285; *Estcourt v. Estcourt*, (1874) 31 L. T. N. S. 567; *Meaby & Co. v. Tricitrine*, (1898) 15 R. P. C. 1.

And where the plaintiff failed to prove his title to the mark in question as a trade-mark, and so failed in the main point involved, but proved that the defendant was "passing off" his wares in a manner to deceive the public, costs were given to him and the Court refused to make any division thereof. *Canada Publishing Co. v. Gage*, 6 O. R. 68, 11 A. R. 402, 11 S. C. R. 306; cf. *Ainsworth v. Walmsley*, (1886) L. R. 1 Eq. 518; *Brown v. Freeman*, (1864) 12 W. R. 305; *Lever v. Bidingfield*, (1898) 15 R. P. C. 453.

So where the plaintiffs alleged fraud, which charge proved unfounded the costs of the issues of fraud found in favour of the defendants were allowed them. *Robin v. Hart*, 23 N. S. 316; *Humphries v. Taylor Drug Co.*, (1888) 59 L. T. 820; *Hargreaves v. Freeman*, (1891) 3 Ch. 39; *Standish v. Whitwell*, (1866) 14 W. R. 512; *Saxlehner v. Apollinaris*, (1897) 1 Ch. 893.

In *De Kuyper v. Van Dulken*, 24 S. C. R. 114, the plaintiff claimed for a declaration that his mark was essentially a heart-shaped label; that the defendant's heart-shaped label was an infringement of his mark, and for other relief. The Exchequer Court which was affirmed by the Supreme Court of Canada, refused to make such a declaration, but at the same time denied the defendant's right to register a label in the shape of a heart, and ordered rectification of the register. The defendants were ordered to pay the general costs of the action and of the particular issue concerning the heart-shape of the defendant's trade-mark, while as to the other issues of fact, each party having succeeded in part, no costs were given.

Where the infringer offers complete redress before action or redress and costs incurred if an action has been

begun, he may escape liability for subsequent costs. *Burgess v. Hills*, (1858) 26 Beav. 244; *McAndrew v. Bassett*, (1864) 4 De. G. J. & D. 380; *Fennessy v. Day*, (1886) 56 L. T. 161; *Millington v. Fox*, (1838) 3 My. & Cr. 338; *Molt v. Couston*, (1864) 33 Beav. 578; *Clark v. Hudson*, (1901) 18 R. P. C. 310.

Where only nominal damages are recovered, costs follow because the defendant disputed the validity of the trade-mark. *Carey v. Goss*, 11 O. R. 619; *Templeton v. Wallace*, 4 Terr. L. R. 340.

Pleadings.—In an action for infringement it is sufficient allegation that the mark by the defendant is the registered mark of the plaintiff, to plead that the registered mark of the plaintiff and the mark used by the defendant are in their essential features the same. *Boston Rubber Shoe Co. v. Boston Rubber Co.*, 7 Ex. C. R. 9.

It is unnecessary to plead that the imitation is fraudulent. *Ibid.*

Nor to charge intention to deceive.

The defendant may, without asking to have the plaintiff's registered mark annulled, plead prior user, or that the mark was improperly registered. *Asbestos, Etc. Co. v. Selater*, Q. R. 18 S. C. 324.

Particulars.—In an action under Section 19 particulars were ordered of the date of the first user of the mark in question, and the names of the places other than England, where it had been used, together with the dates of the user in such places. *Wright Crossley v. Ryall Baking Powder Co.*, 6 Ex. C. R. 143.

Security for Costs.—On an application by the plaintiff's to expunge the defendant's mark from the register, resident out of the jurisdiction, applied for and obtained an order for security against the plaintiffs, also out of the jurisdiction; plaintiffs thereupon applied for a similar order on the ground that the defendants were resident out of the jurisdiction, but the order was refused. *Wright, Crossley & Co. v. Royal Baking Powder Co.*, 6 Ex. C. R. 143.

Common Law Action.—Despite the provisions of Section 20, a trader may maintain an action for damages for the fraudulent imitation of his mark. *Vive Camera Co. v. Hogg*, Q. R. 18 S. C. 1; *Davis v. Kenney*, 13 Gr. 523; *Davis v. Reid*, 17 Gr. 69; *Rose v. McLean*, 24 A. R. 240; *Pabst v. Elkers*, Q. R. 20 S. C. 20. See chapter on passing-off.

Second Action.—An action before registration, and so abortive, is no bar to a fresh action after registration, But this only applied where the mark has been innocently used and actions may be instituted for a fraudulent marking of goods, even in the absence of registration. Per *Proudfoot, J.*, in *Smith v. Fair*, 14 O. R. 729.

CHAPTER IX.

PASSING OFF ACTIONS

(a) **Principles Governing.**—Kay, L. J., in *Powell v. Birmingham Vinegar Co.*, (1896) 2 Ch. at p. 19, summarizes the principles governing passing off actions as follows

“The law relating to this subject may be stated in a few propositions: (1) It is unlawful for a trader to pass off his goods as the goods of another. (2) Even if this is done innocently it will be restrained (*Millington v. Fox*, 3 My. & Cr. 338). (3) A fortiori if done designedly for that is a fraud. (4) Although the first purchaser is not deceived if the article is so delivered to him as to be calculated to deceive a purchaser from him, that is illegal (*Sykes v. Sykes*, 3 B. & C. 541). (5) One apparent exception is that where a man has been describing his goods by his own name, another man having the same name cannot be prevented from using it, though this may have the effect of deceiving purchasers (*Burgess v. Burgess*, 3 DeG. M. & G. 896; *Turton v. Turton*, 42 Ch. D. 128). (6) But this exception does not go far. A man may so use his own name as to infringe the rule of the law. “It is a question of evidence in each case whether there is a false representation or not” (Per Turner, J. J., in *Burgess v. Burgess*, 3 DeG. M. & G. 905). So he may be restrained if he associates another man with him, so that under their joint names he may pass off his goods as the goods of another person (*Croft v. Day*, 7 Beav. 84; *Clayton v. Day*, 26 Sol. Jour. 43; *Melachrino v. The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215). (7) Another apparent exception is where a man trading under a patent had a monopoly for fourteen years, and had given the article a descriptive name, he cannot, when the patent has expired, prevent another from selling it under the same name (*Young v. MacRae*, 9 Jur. N. S. 322; *Linoleum Co. v. Nairn*, L. R. 7 Ch. D. 834). (8) I am not sure if that would be so if the name used were the name of the patentee or even a purely fancy name not descriptive. (9) Certainly where there has not been a patent, and an article has been made and sold under a fanciful name not deceptive, so that the article as made by one person has acquired a reputation under that name, another trader will not be permitted to use the name for a similar article made by him (*Brahm v. Bustard*, L. K. & M. 417; *Cochrane v. McNish*, 13 R. P. C. 100). (10) In the last proposition there is a gain, a limitation. If the first maker

has slept upon his rights or allowed the name to be used by others until it has become *publici juris*, this Court will not interfere."

It is necessary to distinguish "Passing Off Actions" from Actions of Infringement.

"The cases which have come before the Court may, I think, be conveniently divided into two classes: the first class, which is the more numerous one, consists of cases where the goods manufactured are distinguished by some descriptive or device in some way or other affixed to the article sold. It may be, as I said before, description, that is, it may consist of a name or names, or a lengthy description consisting of names with super-added words and that description may be either affixed to or impressed upon the goods themselves, by means of a stamp or adhesive label, or it may be made to accompany the goods by being impressed or made to adhere to an envelope or case containing the goods. Now, as to this case it is quite immaterial that the maker of the goods to which—what I will call for the sake of shortness—the trade-mark is affixed did not know that it was a trade-mark and had not the slightest intention of defrauding anybody. The second class of cases are of a totally different character: they are always cases of fraud. They are cases where the defendant without putting any trade-mark at all upon his goods, has represented the goods as manufactured by the plaintiff. . . . What the defendant has said or done must amount to representation that the goods to be sold are the goods of the plaintiff, or that they are manufactured by the plaintiff. What amount of representation will be sufficient for that purpose must again depend, of course, on the facts of each particular case." Per Sir Geo. Jessel, M. R., in the *Singer Mfg. Co. v. Wilson*, (1874) 2 Ch. D. 434 and 443.

The limitation in the second class, of redress of cases where the defendant has been guilty of fraudulent intention, is not, however, the now accepted doctrine. See *Ib.*, 3 App. Cas., p. 389, per Lord Cairns, who said:

"It may well be that if an imitated trade-mark is attached to the article manufactured, there will from that circumstance, be the certainty that it will pass into every hand into which the article passes, and thus be a continuing and ever-present representation with regard to it; but a representation made by advertisements that the articles sold at a particular shop are articles manufactured by A. B., must, in my opinion, be as injurious in principles . . . as the same representation made upon the articles themselves."

In *Singer Manufacturing Co. v. Loog*, (1879) 18 Ch., p. 395; (1882) 8 App. Cas. 15, the same was under the dis-

cussion, and several of the judgments contained passages which are in accordance with the view of Lord Cairns.

"It was contended that the acts of the defendant enabled his wholesale customers to show these documents to their retail customers for the purpose of passing off the goods bought from the defendant as the plaintiffs' manufacture. The answer is that unless the documents were fabricated with a view to such a fraudulent use of them, or unless they were in themselves of such a nature as to suggest or readily and easily lend themselves to fraud, . . . the supposed consequence is too remote, speculative and improbable to be imputed to the defendant, or to be a ground for the interference of a Court of justice with the course of a defendant's business."

See also Per James, L. J., *Ib.*, 18 Ch. D., p. 412. And in a very recent case it was held that to entitle a plaintiff to succeed in a passing off case, he need not prove fraud, or give evidence that one single person was deceived: In *re Bourne's Tm.*, (1903) 1 Ch. 211.

In actions for infringement the complaint is that the defendant has taken the plaintiff's trade-mark, wholly or in part, or has colourably imitated it, and the claim for redress is based on the plaintiff's exclusive right to use the mark in question for a specified class of goods; in an action for passing off the plaintiff accuses the defendant of using means to pass off or of selling his goods in a way calculated to lead to the belief in the minds of the purchasers that the goods so sold are manufactured by the plaintiff and the means of selling may or may not comprise or consist of an infringement of a trade-mark to which the plaintiff has a title.

Again, in a trade-mark actions proper, registration of the mark is a condition precedent to action. *R. S. C.*, 1906, c. 71, s. 20.

Trade-marks actions proper are but a specialized variety of "passing-off" actions. Every case of infringement would be a case of passing-off but for the fact that where the actual mark is taken, or an obvious imitation is made, the Court will not trouble to inquire whether deception is likely to result in view of the plaintiff's exclusive statute-given right.

It is also necessary to call attention to the distinction

between passing off actions and common law actions for deceit. This was brought in the judgment of Lord Westbury in *Edelsten v. Edelsten*, (1863) 1 D. J. & S. 185—a passing off case, where he says at p. 199:

“At law the proper remedy is by an action for the case on deceit, and proof of fraud on the part of the defendant is off the essence of the action; but this Court will act on the principles for protecting property alone, and it is not necessary for the injunction to prove fraud in the defendant, or that the credit of the plaintiff is injured by the sale of an inferior article. The injury done to the plaintiff in his trade by loss of custom is sufficient to support his title relief. Neither will the plaintiff be deprived of remedy in equity, even if it be shewn by the defendant that all the persons who bought from him goods bearing the plaintiff's trade-mark were all aware that they were not the plaintiff's manufacture. If the goods were so supplied by the defendant for the purpose of being sold again in the market, the injury to the plaintiff is sufficient. Again, it is necessary for relief in equity, that proof should be given of persons being actually deceived, and having bought goods with the defendants' mark, under the belief that they were the manufacture of the plaintiff, provided that the Court be satisfied that the resemblance is such as would be likely to cause the one mark to be mistaken for the other.” See also *Per Lord Blackburn in Singer Mfg. Co. v. Loog*, (1882) 8 App. Cas., p. 29.

(c) **Canadian Cases.**—There are a few cases in Canada which are strictly passing-off cases, but in some of the true trade-mark cases observations are met with illustrating the principles applicable to the former.

In *Davis v. Kennedy*, 13 Gr. 523, the action was brought under the Trade-Mark Act (1861), (Can.), and also upon the common law—which is the safer method in proceeding in the event of an infringement action not succeeding through defect in title, etc., *Spragge, V.-C.*, while doubting the plaintiff's right to proceed under the Act in view of the fact that the declaration of ownership produced upon the application to register was not made by the proprietor but by an agent, upheld the plaintiff's action at common law for passing off, and granted an injunction as prayed.

From the similarity of the two stamps . . . I have no doubt that the defendants copied their stamp from the plaintiff's and that whether they had or not any intention of misleading purchasers—a point which is for the present purpose quite immaterial—their mark

is well calculated to have that effect. . . . Nor is it necessary that the resemblance should be so close as to deceive, notwithstanding close examination. If even ordinary purchasers may be deceived, or 'incautious purchasers' . . . and injunction will be granted."

The next case in point of time is *McCall v. Theal*, 28 Grant 48, which was a purely common law action. The plaintiff sought to refrain the defendant from using the name "Bazaar Patterns" in such a manner as to induce the public to believe they were purchasing the plaintiff's patterns. *Blake, V. C.*, adopting the principles laid down in *Perry v. Truefitt*, (1842) 6 Beav. 66, held that although there was no right in the plaintiff to the exclusive use of the word "bazaar"—it having become *publici juris*—yet the plaintiff was entitled to an injunction restraining the defendant from representing that his goods were the goods of the plaintiff. Cf. *Singer Mfg. v. Charlebois*, Q. R. 16 S. C. 167, where similar relief was given. See also *Camera Co., Ltd. v. Hogg*, Q. R. 183 C. 1.

In *Rose v. MacLean*, 24 A. R. 240, the plaintiffs obtained an injunction restraining the defendants from using the word "Canada" or "Canadian" in conjunction with the word "Bookseller," as being too close to the title of the plaintiff's journal, "The Canadian Bookseller and Library Journal," commonly known as "The Canadian Bookseller," *MacMahon, J.*, said: "There is every probability of the plaintiff being injured by the public being deceived." *Burton, J. A.*, said:

The defendant shall not be allowed to assume a name for their journal which is practically the same as the plaintiff's, and thereby probably obtain advertisements which were intended for his. "For the purpose of the present case," said *Ferguson*, sitting with the Court of Appeal, "I think (the law) may be stated thus: To entitle the plaintiff to the interposition of the Court, the name of his journal may be used in such a way as to be calculated to deceive or mislead the public . . . and to induce them to suppose that the journal published by the defendants is the same as that which was previously being published by the plaintiff."

See also *Pabst v. Ekers*, Q. R. 21 S. C. 545, where it was held that a trader has a common law right to protection against a competitor using his trade-mark only upon

proof of fraud or deception as regards such use and damage resulting therefrom.

In *Gillette v. Lumsden Bros.*, 8 O. L. R. 168, C. A., the plaintiffs owners of a trade-mark including the representation of a woman's head and the words "Cream Yeast," suing both in a registered trade-mark and for passing off, were unsuccessful in restraining the defendants from selling yeast in packages labelled "Jersey Cream" yeast cake with the representation of two Jersey cows and a milkmaid between. It was found on evidence that the defendants were not guilty of passing off their goods in such a manner as to induce the belief that they were goods manufactured by the plaintiff.

In *Russia Cement Co. v. Le Page*, 14 B. C. R., referring to the name "Le Page" as applied to glue, it was held that where a particular article had been manufactured and sold for many years under a particular name, other persons fraudulently taking advantage of such name would be restrained.

Long continued use of a trade-mark "The Cleaners," which in its primary meaning is descriptive, was held sufficient in *Matthews v. O'Mansky*, (1912) 25 W. L. R. 603, to warrant an injunction against the use of a similar name, "The Fort Rouge Cleaners." Following *Cellular Clothing Co. v. Maxton*, (1899) A. C. 326; *Lee v. Haley*, L. R. 5 Ch. 155; *Hendricks v. Montague*, 17 Ch. D. 637; *Taylor v. Taylor*, 23 L. J. Ch. 255; *Knott v. Morgan*, 48 Eng. Rep. 610.

In "*My Valet*," Ltd. v. *Winters*, (1912) 9 D. L. R. 306, 27 O. L. R. 286, the plaintiff had used the words "My Valet" for many years in a business of cleaning and pressing clothes. He was held entitled to restrain the use of the words "My New Valet," or any other similar name only colourably different from his name—the evidence shewing a deliberate and in part successful attempt on the part of the defendant to trade unfairly and deceive the public into believing his business to be the plaintiff's. *Levy v. Walker*, (1879) 10 Ch. D. 436, 447, and *Standard Paint Co. v. Trin-*

idad Asphalt Mfg. Co., (1911) 220 U. S. 446, followed,—British Vacuum Cleaner Co. v. New Vacuum Cleaner Co., (1907) 2 Ch. 312 distinguished.

In *Gramm Motor Truck Co. v. Fisher Motor Co.*, (1913) 30 O. L. R. 1, 17 D. L. R. 745, the plaintiff company assembled parts and sold "Gramm" Motor Trucks under arrangement with an American company in which Gramm, the designer of the trucks, was interested. The defendant used the words "Gramm-Bernstein" and attempted to justify under an arrangement with an American company of that name. It was held that the defendants had no right (by reason of connection with the man of that name) to use the name "Gramm" as against the plaintiff company, and they were enjoined from using the same in labelling and selling their motors. See also *Grand Trunk Co. v. James*, (1915), 22 D. L. R. 915, 31 W. L. R. 716, (affirmed, 29 D. L. R. 352.)

(d) The Exchequer Court has no jurisdiction in passing off cases. *Mickelson & Shapiro Co. v. Mickelson Drug & Chemical Co.*, (1914) 15 Ex. C. R. 276.

(e) **The Relief Granted.**—This corresponds to that granted in an action for infringement, and includes an injunction; and order for the delivery up of any goods marked with the deceptive mark, and in the possession or under the control of the defendant; damages for the past infringement of the plaintiff's right; or an account of profits made by the defendant by the sale of the goods under the deceptive mark, or some one or more or of these. See *Davis v. Kennedy*, 13 Gr. 523; *Rose v. McLean*, 24 A. R. 240; *McCall v. Theal*, 28 Gr. 48; *Davis v. Reid*, 17 Gr. 69; *Kerley*, 2nd Ed., pp. 513 et seq.

CHAPTER X.

CRIMINAL PROSECUTION

The following Sections of the Criminal Code apply to the forgery of Trade-Marks and Fraudulent Marking of Merchandise:

486. Everyone is deemed to forge a trade-mark who either:—

(a) Without the assent of the proprietor of the trade-mark makes that trade-mark or a mark so nearly resembling it as to be calculated to deceive; or,

(b) falsifies any genuine trade-mark, whether by alteration, addition or effacement or otherwise.

(2) Any trade-mark or mark so made or so falsified is, in this Part referred to as a forged trade-mark. 55-56 V., c. 29, s. 445.

487. Every person is deemed to apply a trade-mark, or mark, or trade description to goods who:—

(a) Applies to the goods themselves; or,

(b) applies it to any covering, label, reel or other thing in or which the goods are sold or exposed or had in possession for any purpose of sale, trade or manufacture; or,

(c) places, incloses or annexes any goods which are sold or exposed in possession for any purpose of sale, trade or manufacture, with or to any covering, label, reel or other thing in which a trade mark or mark or trade description has been applied; or,

(d) uses a trade-mark or mark or trade description in any manner calculated to lead to the belief that the goods in connection with which it is used are designated or described by that trade-mark or mark or trade description.

(2) A trade-mark or mark or trade description is deemed to be applied whether it is woven, impressed or otherwise worked into, or annexed or affixed to, the goods or to any covering, label, reel or other thing.

(3) Everyone is deemed to falsely apply to goods a trade-mark who, without the assent of the proprietor of the trade-mark, applies such trade-mark, or a mark so nearly resembling it as to be calculated to deceive. 55-56 V., c. 29, s. 446.

488. Everyone is guilty of an indictable offence, who with intent to defraud:—

(a) forges any trade-mark; or,

(b) falsely applies to any goods a trade-mark, or any mark so nearly resembling a trade-mark as to be calculated to deceive; or,

- (c) makes any die, block machine or other instrument for the purpose of forging, or being used for forging a trade-mark; or,
- (d) applies any false description to goods; or,
- (e) disposes of, or has in his possession any die, block, machine, or other instrument for the purpose of forging a trade-mark; or,
- (f) causes any of such things to be done.

2. On any prosecution for forging a trade-mark the burden of proof of the assent of the proprietor shall lie on the defendant. 55-56 V., c. 29, ss. 447 and 710.

489. Everyone is guilty of an indictable offence who sells or exposes, or has in his possession, for sale, or any purpose of trade or manufacture, or any goods or things to which any forged trade-mark or false trade description is applied, or to which any trade-mark or mark so nearly resembling a trade-mark as to be calculated to deceive, is falsely applied, as the case may be, unless he proves:—

(a) That having taken all reasonable precaution against the committing such an offence he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the trade-mark, mark or trade description; and,

(b) that on demand made by or on behalf of the prosecutor he gave all the information in his power with respect to the persons from whom he obtained such goods or things; and,

(c) that otherwise he had acted innocently. 55-56 V., c. 29, s. 448.

490. Everyone is guilty of an indictable offence who:—

(a) Wilfully defaces, conceals or removes the trade-mark duly registered, or name of another person upon any cask, keg, bottle, siphon, vessel, can, case or other package has been purchased from such other person, if the same shall have been so defaced, concealed or removed without the consent of, and with intention to defraud such other person;

(b) being a manufacturer, dealer, or trader or bottler, trades or traffics in any bottle or siphon which has upon it the trade-mark duly registered or name of another person, without the written consent of such person, or without such consent fills such bottle or siphon with any beverage for the purpose of sale or traffic.

2. The using by any manufacturer, dealer or trader or bottler, other than such person, of any bottle or siphon for the sale therein of any beverage, or the having by any such manufacturer, dealer, trader or bottler upon any bottle or siphon such trade-mark or name of such person, or the buying, selling or trafficking in any such bottle or siphon without such written consent of such other person, or the fact that any junk-dealer has in his possession any bottle or siphon having upon it such a trade-mark or name without such written consent, shall be prima facie evidence of trading or trafficking within the meaning of the paragraph (1b) of this section. 63-64 V., c. 46, s. 3.

491. Everyone guilty of an offence defined in this Part in respect to trade-marks, names, or in respect to trade descriptions or false

trade descriptions for which no penalty is in this Part otherwise provided, is liable:—

(a) On conviction on indictment, to two years' imprisonment with or without hard labour, or to a fine, or to both imprisonment and a fine; and,

(b) on summary conviction, to four months' imprisonment, with or without hard labour, or to a fine not exceeding one hundred dollars; and in case of a second or subsequent conviction to six months' imprisonment, with or without hard labour, or to a fine not exceeding two hundred and fifty dollars.

2. In any case every chattel, article, instrument or thing by means of, or in relation to which the offence has been committed shall be forfeited. 55-56 V., c. 29, s. 450.

492. Everyone is guilty of an offence and liable on summary conviction to a penalty not exceeding one hundred dollars, who falsely represents that any goods are made by a person holding a royal warrant, or for the service of His Majesty or any of the royal family, or any government department of the United Kingdom or of Canada. 55-56 V., c. 29, s. 451.

493. Everyone is guilty of an offence and is liable, on summary conviction, to a penalty of not more than five hundred dollars nor less than two hundred dollars who imports or attempts to import any goods, which if sold would be forfeited under the provisions of this Part, or any goods manufactured in any foreign state or country which bear any name or trade-mark which is or purports to be the name or trade-mark of any manufacturer, dealer or trader in the United Kingdom or in Canada, unless such name or trade-mark is accompanied by a definite indication of the foreign state or country in which the goods were made or produced; and such goods shall be forfeited. 55-56 V., c. 29, s. 452.

494. Anyone who is charged with making any die, block, machine or other instrument for the purpose of forging, or being used for forging a trade-mark, or with falsely applying to goods any trade-mark, or any mark so nearly resembling a trade-mark as to be calculated to deceive, or with applying to, goods any false trade description, or causing any of the things in this section mentioned to be done, and proves:—

(a) That in the ordinary course of his business he is employed, on behalf of other persons, to make dies, blocks, machines or other instruments for making or being used in making trade-marks, or, as the case may be, to apply marks or descriptions to goods, and in that case which is the subject of the charge he was so employed by some person resident in Canada, and was not interested in the goods by way of profit or commission dependent on the sale of such goods; and,

(b) that he took reasonable precaution against the committing of the offence charged; and,

(c) that he had, at the time of the commission of the alleged

offence, no reason to suspect the genuineness of his trade-mark, mark, or trade description; and,

(d) that he gave the prosecutor all the information in his power with respect to the person by or on whose behalf the trade-mark or mark of description was applied; shall be discharged from the prosecution but is liable to pay the costs incurred by the prosecutor, unless he has given due notice to him that he rely on the above defence. 55-56 V., c. 29, s. 453.

495. No servant of a master resident in Canada, who bona fide acts in obedience to the instructions of such master, and on demand made by or on behalf of the prosecutor, gives full information as to his master, is liable to any prosecution or punishment for any defence defined in this Part. 55-56 V., c. 29, s. 454.

Sections 21 and 36 of the Trade-Mark and Design Act also provide a remedy by criminal action:

21. Every person other than the proprietor of any trade-mark who, with intent to deceive and to induce any person to believe that any article of any description whatever was manufactured, produced, compounded, packed or sold by the proprietor of such trade-mark:—

(a) Marks any such article with any trade-mark registered under the provisions of this Act, or with any part of such trade-mark, whether by applying such trade-mark or any part thereof to the article itself or to any package or thing containing such article, or by using any package or thing so marked which has been used by the proprietor of such trade-mark; or,

(b) knowingly sells or offers any such article for sale marked with such trade-mark or with any part thereof; is guilty of an indictable offence and liable for each offence to a fine not exceeding one hundred dollars and not less than twenty dollars.

2. Such fine shall be paid to the proprietor of such trade-mark, together with the costs incurred in enforcing and recovering the same.

3. Every complaint under this section shall be made by the proprietor of such trade-mark, or by someone acting on his behalf and thereto duly authorized. R. S., c. 63, s. 17.

36. Every person, who in violation of the provisions of this Part, during the existence of the exclusive right acquired for any industrial design by the registration of the same under this Part, whether the entire or partial use of such design, without the licensing in writing of the registered proprietor, or, if assigned to his assignee:—

(a) For the purpose of sale, applies or attaches such design or a fraudulent imitation thereof to the ornamenting of any article of manufacture to which an industrial design may be applied or attached to; or,

(b) publishes, sells or exposes for sale or for use, any article of manufacture or any other article to which an industrial design may be applied or attached; shall forfeit a sum not exceeding one hun-

dred dollars and not less than twenty dollars to the proprietor of the design so applied.

2. The sum shall be recoverable with costs on summary conviction under Part XV. of the Criminal Code by the registered proprietor or assignee. R. S., c. 63, s. 31.

By Section 335 of the Criminal Code "Trade-Mark" means a trade-mark or industrial design registered in accordance with the Trade-Mark and Design Act and the registration where of is in force under the provisions of the said Act and includes any trade-mark which, either, with or without registration, is protected by law in any British possession or foreign State to which the provisions of Section 103 of the Act of the United Kingdom, known as the Patents, Designs and Trade-Marks Act, 1883, are in accordance with the provisions of the said Act, for the time being applicable.

A trade description is also defined by Section 335 of the Criminal Code, as follows:

335:—

(t) "A trade description" means any description, statement or other indication, direct or indirect:—

(1) as the number, quantity, measure, gauge or weight of any goods,

(2) as the place or country in which any goods are made or produced,

(3) as to the mode of manufacturing or producing any goods,

(4) as to the material of which any goods are composed,

(5) as to the goods being the subject of an existing patent, privilege or copyright.

A false trade description is defined as follows:

335:—

(j) "False document" means:—

(1) a document, the whole or some material part of which purports to be made by or on behalf of any person who did not make or authorize the making thereof, or which though made by it, or by the authority of, the person who purports to make it, is falsely dated as to time or place of making, where either is material; or,

(2) a document, the whole or some material part of which purports to be made by or on behalf of some person who did not in fact exist; or,

(3) a document which is made in the name of an existing person, either by that person or by his authority, with the fraudulent inten-

tion that the document should pass as being made by some person, real or fictitious, other than the person who makes or authorizes it.

At Common Law the imitation of a trade-mark is not a forgery. *R. v. Closs* D. & B. 460; 7 Cox 494. The foregoing sections afford the same remedy against forgery as corresponding Merchandise Marks Acts in Great Britain: (25 and 26 Vict., c. 88; 50 and 51 Vict., c. 28; 54 and 55 Vict., c. 15; 57 and 58 Vict., c. 19).

Any prosecutions under the foregoing sections must be within three years from the time of the commission of the offence. Section 1140 (a) of Criminal Code.

Importing Goods with Fraudulent Mark.—The following special provisions with regard to imported goods are found in Section 992 of the Criminal Code:

992. In any prosecution proceeding or trial for any offence under Part VII. relating to fraudulent marks on merchandise, if the evidence relates to imported goods evidence of the part of shipment shall be prima facie of the place or country in which the goods were made or produced. 55-56 V., c. 29, s. 710.

There have been few prosecutions in Canada under the foregoing sections.

In *R. V. Authier*, (1897) Q. R. 6 Q. B. 146, a conviction under Section 448 of the Criminal Code was sustained. The case related to the use of a heart-shaped label on gin similar to that of *John De Kuyper & Son*, and which formed the subject of litigation in the Exchequer Court, (sub) *Mon. J. Melchers v. John De Kuyper & Son*, 6 Ex. C. R. 82;—S. C. E.

Wurtle, J., delivering the judgment of the Court of Queen's Bench, said:

The plaintiffs' label is a white heart-shaped piece of paper upon which is printed the word "Geneva" in large letters, and other matter in smaller characters. The defendant's label is also upon white paper and is shaped so as to have a resemblance to a peg top, or more accurately speaking to the section of a peg top. It also bears on it the word "Geneva" and other matter in smaller characters, but in size and general effect it resembles the other label. It is obvious that any person of ordinary intelligence comparing the two side by side would detect the points of difference between them, but these are not the persons whom the law desires to protect. The object of the legis-

lation in this country, I take to be to protect the owners of trade-marks so as to secure to them the benefit of the money and time which they have expended in building up a market for their own goods, and to do this the Legislature must protect them with respect not to the intelligent and wary purchaser, but to the unwary one. Per Lord Kingsdown, in *Leather Co. v. American Leather Co.*, (1865) 11 H. L. C. 539. Lord Chelmsford, in *Wotherspoon v. Currie*, (1872) L. R. 5 E. & L. App. 519. In my opinion there is a sufficient resemblance between the two labels used in the way they are to justify me in saying that the defendant's label is calculated to deceive.

In *Seixo v. Provezende*, (1865) L. R. Ch. p. 196, Lord Cranworth, L. C., said: "It would be a mistake to suppose that the resemblance must be such as would deceive persons who would see the marks placed side by side." The rule so restricted would be of no practical use.

It appears by the evidence of Mr. Ethier, examined on behalf of the defendant, that Mr. Authier consulted him before using this label, told him of his previous trouble with Messrs. Hope Co. with regard to the label he had been using, and then asked Mr. Ethier's opinion as to whether he would get into trouble by using the label he proposed to adopt, and thereupon Mr. Ethier expressed his opinion in the negative; at the same time, however, he advised him to submit the label to Messrs. Hope & Co. before he used it, but this Mr. Authier said he would not do and does not appear to have done.

As regards the want of proof as to any persons having been actually deceived I would refer to *Johnston v. Orr Ewing*, (1882) 7 App. Cas. 219, where Lord Blackburn quotes with approval the words of Lord Justice James: "The very life of a trade-mark depends on the promptitude with which it can be vindicated," and lays it down that where there is a similarity calculated to deceive the use may be restrained although the evidence does not shew that any purchaser had actually been misled. *Edelston v. Vick*, (1854) 18 Jur., p. 7; *Farina v. Silverlock*, (1855) 24 L. J. Ch. 632.

Some authorities have been cited with regard to the interpretation of the statute, which are really only applicable to the modern French law. I do not feel that I am called upon to compare our respective systems of trade-mark legislation. The provisions in this respect of our Criminal Code are taken from the law of England, and the part relating to the fraudulent marking of merchandise is taken almost verbatim from English statutes. It is, moreover, the universal law of Canada, applying in all of the provinces, all of which except Quebec are governed by laws derived from those of England and by English decisions for their interpretation. I could not, therefore, in interpreting a statute copied from an English one, consider myself bound by French authorities, where they differ from the English authorities on the same matter. Under the English law, as I have already stated, the question to be decided is whether an incautious or unwary purchaser would be deceived.

In *R. v. T. Eaton Co.*, (1899) 31 O. R. 296, the Divisional Court sustained a conviction for applying a false trade description, "Quadruple Plate," contrary to the provisions of the Criminal Code. The description was given verbally and was published in a newspaper advertisement. A verbal description might not be sufficient to bring the case within the Act. *Copper v. Moore* (No. 1), (1898) L. R. 2 Q. B. 300.

In *R. v. Cruttenden*, (1905) 10 O. L. R. 80, the defendant was charged with forging the trade-mark "Glyco-Thymoline" and falsely applying it to goods contrary to the Criminal Code. The defendant made a solution containing glycerine and thymol which he named "Glyco-Thymol." It was held that the defendant was entitled to plead the invalidity of the trade-mark, and that as a matter of fact the words "Glyco-Thymol" were descriptive merely and not properly the subject of a trade-mark.

Under Section 490 of the Criminal Code, referring to unlawful trading in bottles having a trade-mark thereon, it was held not necessary to the offence that the trade-mark should be registered. *R. v. Irvine*, 9 O. L. R. 389. A soda water manufacturer who fills for purposes of sale, bottles having the name of another manufacturer permanently placed thereon, is guilty of the offence unless a written consent has been obtained (*Ibid.*). The rule requiring a criminal intent does not apply to this offence. *R. v. Coulombe*, 6 D. L. R. 99.

Customs Act.—The Customs Tariff Act (R. S. 1906, c. 49) by Section 16 prohibits the importation of any goods which, if sold would be forfeited under the provisions of Part VII. of the Criminal Code. This section reads:

16. The importation of any goods:—

(a) which if sold, would be forfeited under the provisions of Part VII. of the Criminal Code; or,

(b) manufactured in any foreign state or country which bears any name or trade-mark which is or purports to be the name or trade-mark of any manufacturer, dealer or trader in the United Kingdom or in Canada, unless such trade-mark or name is accompanied by a definite indication of the foreign state or country in which the goods were made or produced, is prohibited.

(2) For the purpose of this section, if there is on any goods a name which is identical with a colourable imitation of the name of the place in the United Kingdom or Canada, such name unless it is accompanied by the name of the state or country in which it is situate, shall unless the Minister decides that the attaching of such name is not calculated to deceive, (of which matter the Minister shall be the sole judge) be treated as if it were the name of a place in the United Kingdom or in Canada.

3. The Governor in Council may, whenever he deems it expedient in the public interest, declare that the provisions of two subsections last preceding shall apply to any city or place in any foreign state or country; and after the publication in the Canada Gazette of the order in council made in that behalf, such provisions shall apply to such city or place in like manner as they apply to any places in the United Kingdom or in Canada, and may be enforced accordingly.

4. The Governor in Council may, from time to time, make regulations either general or special, respecting the detention and seizure of goods, the importation of which is prohibited by this section, and the conditions if any, to be fulfilled before such detention and seizure; and may by such regulations determine the information, notice and security to be given, and the evidence necessary for any of the purposes of this section and the mode of verification of such evidence.

5. The regulations may provide for the reimbursing by the informant to the Minister of all expenses and damages incurred in respect of any detention made on his information, and of any proceedings consequent upon such detention.

6. The regulations may apply to all goods the importation of which is prohibited by this section, or different classes of such goods or offences in relation to such goods.

7. All such regulations shall be published in the Canadian Gazette and shall have force and effect from the date of such publication. 51 V., c. 41 s. 22; 55-56 V., c. 29, Appendix.

Adulteration Act.—Sections 21, 22 and 39 of the Adulteration Act, R. S. 1906, c. 133, providing penalties for falsely marking and illegally selling articles which are impure or adulterated, read:

21. No person shall mark, brand, or label any article or any package containing any article mentioned in the first column of the fourth schedule to this Act, with the word Pure, Genuine, or any word equivalent thereto, or sell, or offer, or expose for sale, any such article or package so marked, branded, stamped or labelled, unless such article or the contents of such package or article are pure within the meaning of the second column of the said schedule. 57-58 V., c. 37, s. 1.

22. No person shall sell, offer or expose for sale, any article or any substance for domestic use under the name or designation con-

tained in the first column of the fifth schedule to this Act, unless such article or substance is free from adulteration or admixture of foreign matter and unless it possesses the composition and distinguishing characteristic stated in the second column of the said schedule. 57-58 V., c. 37, s. 2.

39. Every person who sells, offers, or exposes for sale any article or any substance for domestic use under the name or designation contained in the first column of the fifth schedule to this Act, unless such article or substance is free from adulteration or mixture of foreign substances and unless it possess the composition and distinguishing characteristics stated in the second column of the said schedule shall, for every violation, be liable to a penalty not exceeding one hundred dollars.

2. A moiety of such penalty shall belong to the prosecutor and the other moiety to the Crown. 57-58 V., c. 37, ss. 2 and 3.

Gold and Silver Marking Act 1908.— This Act requires that any article of gold or silver or their alloys, if marked at all, should bear in addition to the quality mark, a trade-mark registered in accordance with the Trade-Mark and Design Act. Goods marked with certain British and Foreign hall marks are exempted.

CHAPTER XI.

TRADE NAMES.

General Principles.—Actions to restrain imitations of trade names used as such, and not as trade-marks on goods, differ from trade-mark cases proper. A trader has much the same right in respect of his trade name as he has to his trade-mark, or to his get-up and other distinctive badges. The representation made is, usually, that a certain firm or undertaking is a certain other firm or undertaking with a view to the one firm obtaining the custom of the other.

The principle upon which the Court acts in protecting a trade name was stated by James, L. J., in *Levy v. Walker*, (1879) 10 Ch. D., p. 447:

“It should never be forgotten that in those cases the sole right to restrain anybody from using any name he likes in the course of any business he chooses to carry on is a right in the nature of a trade-mark, that is to say a man has a right to say: ‘You must not use a name—whether fictitious or real—you must not use a description, whether true or not, which is to represent or calculated to represent, to the world that your business is my business, and so by a fraudulent misstatement deprive me of the profits of the business which otherwise come to me.’ An individual plaintiff can only proceed on the ground that having established a business reputation under a particular name, he has a right to restrain anyone else from injuring his business by using that name.”

No Right to Name Apart from Business.—There can be no absolute right in a trade name apart from a trade or business. The right to the exclusive use of a name in connection with a trade or business is recognized, and an invasion of that right by another is good ground for an action for an injunction. But the name must have been actually adopted and used by the plaintiff. *Du Boulay v. Du Boulay*, (1869) L. R. 2P. C. 441; *Beazley v. Soares*, (1882) 22 Ch. D. 660; and *Canadian Cases: Robinson v. Bogle*, (18 O. R. 387); *Love v. Latimer*, (32 O. R. 231); *Carey v. Goss*, (11 O. R. 619).

Trade Name as Applied to Goods.—Another kind of a trade name is that which is applied to the goods themselves, instances of which are to be found in the Canadian cases of *Pabst v. Ekers*, (Q. R. 20 S. C. 20); *Boston Rubber Shoe Co. v. Boston Rubber Co.*, (7 Ex. C. R. 9), (1 C. L. R. 217 and 317); and *Thompson v. McKinnon*, (21 L. C. J. 355). Dealing with this class, Lord Blackburn, in *Singer Mfg. Co. v. Loog*, (1882) 8 App. Cas., said:

“There is another way in which goods not the plaintiff’s may be sold as and for the plaintiff’s. A name may be so appropriated by user as to come to mean the goods of the plaintiff, though it is not, and never was, impressed on the goods . . . so as to be a trade-mark properly so-called. Where it is established that such a trade name bears that meaning, I think the use of that name or one so nearly resembling it as to be likely to deceive, may be the means of passing off those goods as and for the plaintiff’s. . . . And I think it is settled by a series of cases that both trade-marks and trade names are in a certain sense property, and the right to use them passes with the good will of the business to the successors of the firm which originally established them, even though the name of that firm be changed so that they are no longer strictly correct.” Cf. *Robin v. Hart*, (23 N. S. 316); *Reddaway v. Banham*, (1896) A. C. 199.

In *Pabst v. Ekers*, above referred to, it was held, by the Superior Court for Quebec, reversing the decision of Davidson, J., that protection would be granted against a competitor using the same or some similar name only upon proof either of fraud or deception as regards such use and of prejudice resulting therefrom. It may be doubted in view of the authorities cited below whether this is good law. In the Court below, Davidson, J., granted an injunction on the ground that a rival has no right to use a similar name in such a way as is calculated to mislead purchasers into the belief that his goods are another’s. This appears to us to be the correct view of the law. Fraud need not be proved. Cf. *Reddaway v. Banham* (ante); *Powell v. Birmingham, etc., Co.*, (1896) 2 Ch. 54; (1897) A. C. 710. The Superior Court’s decision could, however, be supported on another ground, that the plaintiffs had no right to the trade name in question as it was a name *publici juris* when adopted by them

Deception Must Be Probable.—Though fraud need not be shewn, it is however, necessary that deception of the public is probable before relief will be granted. *Goodfellow v. Prince*, (1887) 35 Ch. D. 9; *California Fig Syrup Co. v. Taylor*, (1897) 14 R. P. C. 564. Moreover, where the goods are clearly so alike as to be calculated to deceive “no evidence is required to prove the intention to deceive. . . . The sound rule is that a man must be taken to have intended the reasonable and natural consequences of his acts and no more is wanted. If, on the other hand, a mere comparison of the goods, having regard to the surrounding circumstances, is not sufficient, then it is allowable to prove from other sources that what is or may be apparent innocence was really intended to deceive.” *Saxlehner v. Apollinaris Co.*, (1897) 1 Ch. 893, per Kekewich, J.; cf. *Watson v. Westlake*, (12 O. R. 449).

Name of Company.—As to cases where the name imitated is that of a company, it is laid down that very clear evidence of probability of deception will be required. *London Assurance Co. v. London and Westminster Assurance Co.*, (1863) 32 L. J. Ch. 664; *Lee v. Haley*, (1869) L. R. 5 Ch. 155; *Colonial Life Assurance Co. v. Home & Colonial Assurance Co.*, (1864) 33 Beav. 548. In British Columbia it has been decided that the name “British Columbia Permanent Loan & Savings Company” is not so similar to “The Canada Permanent Loan and Savings Company” as to be calculated to deceive the public. *Canada Permanent v. B. C. Permanent*, (1898) 6 B. C. R. 377.

The various companies Acts in Canada contain various regulations regarding the use of similar names. In Ontario, the Company Act, R. S. O., 1914, ch. 178, sec. 37, provides that the proposed name shall not be identical with that of any known company, or so nearly resembling the same as to deceive, and similar provisions are to be found in the Acts of the Dominion, and other Provinces. Section 39 of the Ontario Act provides for changing the name of any company incorporated under the Act if it is made to appear that such name is the same as, or so similar to any existing company, partnership, or any name under

which any existing business is being carried on, as to deceive. A similar power exists in Quebec. Art. 6015 et seq.

Titles of Periodicals.—Another instance of trade names is found in the title of periodicals.

In *Clement v. Maddick*, (1859) 3 Giff. 98, referred to in the case under consideration, the owners of *Bell's Life* obtained an injunction restraining the defendants from publishing any newspaper under the name of *Penny Bell's Life* and *Sporting News*, or under any name of which the name *Bell's Life* should form a part. In this Vice-Chancellor Stuart followed *Millington v. Fox*, (1838) 3 My. & Cr. 338, in holding that the absence of a fraudulent intention is no defence against a plaintiff whose property has been injured. And in *Prowett v. Mortimer*, (1855) 4 W. R. 519, a case in which the facts were very similar to those in *Carey V. Goss*, the same learned Judge restrained the defendant from publishing any newspaper under the designation *True Britannia*, *Britannia* being the name of the plaintiff's paper. In the first case, Stuart, V.-C., said:

"The defendants' whole case appears to rest on the fact that they intended to commit no fraud, that they had no fraudulent intention in adopting the words '*Bell's Life*,' and thought that by prefixing the word '*Penny*' to the title they had sufficiently warned the public that they were not purchasing the plaintiff's paper. But the absence of fraudulent intention is no defence against an application to the Court for an injunction by the person whose property has been injured."

There is a diversity of opinion as to whether the jurisdiction of the Court is founded on a right of property or not. In *Clement v. Maddick* (*supra*), Stuart, V.-C., thought it was; but the Court of Appeal, in *Walter v. Emnot*, (1885) 54 L. J. Ch. 1059, considered that the right and duty of the Court to prevent damage being done to the business of a person who is lawfully conducting his business, by acts, conduct or representations calculated to deceive the public, was the reason of the Court's interference.

For a collection of the cases in which injunctions have been granted, see *Sebastian*, 5th Ed., p. 328.

Canadian Cases on Trade Names.—In Canada, there are several decisions on this point. In *Canada Publishing Co. v. Gage*, (6 O. R. 68, 11 A. R. 402, 11 S. C. R. 306), an injunction was granted restraining the defendants from using the name *Beatty's New and Improved Headline Copy Book*, which was considered to be an imitation of *Beatty's Headline Copy Book* calculated to deceive the public.

In *Rose v. McLean*, (24 A. R. 240), the name "The Canadian Bookseller and Stationer" was condemned as an infringement of "The Canadian Bookseller and Library Journal," commonly known as "The Canadian Bookseller," and the plaintiff was granted an injunction restraining the defendants from using the word "Canada" or "Canadian" conjointly with the word "Bookseller," as a title to their journal.

In the *Montreal Lithographing Company v. Sabiston*, 3 Rev. de Jur. 403, affirmed, (1889) A. C. 610, the plaintiffs were refused an injunction restraining the defendant from carrying on business under the name *Sabiston Lithographing and Publishing Company*. They were the transferees of the assets and good will of the dissolved *Sabiston Lithographic and Publishing Company* and claimed that the name adopted by the defendants was a colourable imitation of their trade name, and calculated to prejudice the rights of the plaintiffs. The Court of Queen's Bench for Quebec held that the appellants (plaintiffs) did not derive by purchase from the dissolved company any right to use its corporate name (a right which could only be granted by the Crown) or to continue its business. They were incorporated and registered, and had since done business under a quite different name and did not allege any intention of using, and had no right to use the old company's name as their trade or firm name. But the respondent, their Lordships held, had no right to represent himself as the successor in business to the dissolved company. This was as far as they would go.

Surname as Trade Names.—The use of a surname as a trade-mark is objectionable because "No person can ac-

quire the right to use his surname as a trade-mark or trade name, to the exclusion of others bearing the same surname." (Matteson, J., in *Harson v. Halkyard*, 22 R. I. 102.)

Where a surname has enjoyed extended and exclusive use, for a long period of time, a secondary meaning may be acquired by it, the benefit of which will be supported by Courts of Equity. Lord Parker, in *Registrar v. Du Cros, Ltd.*, 83 L. J. Ch. 1, said:

"Independent of any trade-mark legislation, whenever a person uses upon or in connection with his goods some mark which has become generally known to the trade or to the public as his mark and thus operates to distinguish his goods from the goods of other persons, he is entitled in equity to an injunction against the user of the same or any colorable imitation of the same which is in any manner calculated to deceive the trade or the public. Equity has never imposed any limitation on the kind of word entitled to this protection, but in every case it has to be proved that the mark has by user become in fact distinctive of the plaintiff's goods." (See, *infra* p. 14 as to registrability of surname as trade-marks.)

In some instances, as where a secondary meaning has been acquired by a surname, the use of it, even by one of the same name would deceive and would be restrained by court of equity. (*Burgess v. Burgess*, 3 De G. M. & G. 896; *Holloway v. Holloway*, 13 Beav. 209; *Tussaud v. Tussaud*, 44 Ch. D. 678; *Christie v. Christie*, L. R. 8 Ch. 422.)

The mere fact that confusion is likely to result is not sufficient. "If all that a man does is to carry on the same business (as another trader), and to state how he is carrying it on that statement being the simple truth, and he does nothing more with regard to the respective names he is doing no wrong. He is doing what he has an absolute right by the law of England to do and you cannot restrain a man from doing that which he has an absolute right by the law of England to do." (Per Lord Esher, M. R., in *Turton & Sons, Ltd., v. Turton*, 42 Ch. D. 128.) In the same case, Cotton, L. J., said:

"The Court cannot stop a man from carrying on his own business in his own name, although it may be the name of a better-known manufacturer, when he does nothing at all in any way to try and represent that he is that better known and successful manufacturer."

Form of Injunction.—Even where an injunction is justified, it more frequently does not absolutely debar the trader from the trading in his own name, but only from doing it in some particular way. (*J. & J. Cash, Ltd. v. Cash*, 19 R. P. C. 181.)

Acquiescence in Use of Name by Another.—Where, however, a person has allowed another to use his name, and acquire a reputation under it, he will not afterwards be allowed to himself use his name so as to deceive, nor to empower others to use it so as to produce that result. *John Palmer Co., Ltd. v. Palmer-McLellan Shoepack Co.*; * *Birmingham Vinegar Brewing Co., Ltd. v. Liverpool Vinegar Co., Ltd.*, 4 T. L. R. 613.

McLeod, C. J., in *John Palmer Co., Ltd. v. Palmer-McLellan Shoepack Co., Ltd.*, applied the law as follows:

“It was claimed on behalf of the defendant company that John Palmer had a right to use his own name in connection with these shoe packs or rather the right to call them ‘Palmer’s Shoe Packs.’ But John Palmer was not manufacturing the goods himself, the defendant company was manufacturing the goods and if the words ‘Palmer’s Shoe Packs’ had become so associated with the make of the plaintiff company’s goods that persons purchasing goods manufactured by the plaintiff company, then the defendant company, although John Palmer was its managing director, could not appropriate the use of his name for the defendant’s goods.

“In the present case the defendant company must have some reason for placing the word ‘Palmer’ on its trade-mark. It didn’t use its corporate name but simply took the word ‘Palmer,’ and when we have in connection with that the fact that it advertised its goods as ‘Palmer’s Shoe Packs,’ a name which it knew applied to the plaintiff’s goods, we must come to the conclusion that it was done with a view of deceiving the public and with a view of inducing the public to believe that the goods it was manufacturing were the goods that had formerly been known as ‘Palmer’s Shoe Packs.’

“The name ‘Palmer’ had been for years associated with the shoe packs manufactured and sold by the plaintiff company, so that when a purchaser asked for ‘Palmer’s Shoe Packs’ he expected to get the shoe packs made by the plaintiff company, knowing the high reputation in the market they had.

“The order will be that the defendant company be restrained from using the name ‘Palmer’ as a trade-mark or art of a trade-mark upon any of its shoe packs, moccasins, larrigans or other oiled tanned footwear similar to those manufactured by the plaintiff company and from publishing or advertising any statements alleging that the de-

*This case is not reported yet.

endants are the exclusive owners of the processes of manufacture formerly owned by John Palmer and from advertising their goods in any way as 'Palmer's Shoe Packs,' or 'Palmer's make of goods.' "

Right of Vendor of Business to Use Name.—The vendor of a business and good will when there is no convention to the contrary, may establish a similar business in the neighborhood and may deal with his former customers, although he may be enjoined from soliciting business from them. (*Leggatt v. Barret*, (1880) L. R. 15 Ch. 306; *Cutwell v. Lye*, (1910) 17 Vesey 346.)

Labouchere v. Dawson, (1872) L. R. 13 Eq. 322. In *Thompson v. McKinnon* (21 L. C. J. 355), a biscuit manufacturer was held to have conveyed with the sale of the business and goodwill, the exclusive right to use the name "McKinnons" as well as the device of a boar's head grasping in its jaws a bone, and he was restrained from subsequently making use of the name and device. The Court of Review in this case referred with approval to the rule laid down by the foregoing English cases.

Loan of Name for Purposes of Deception.—It is not permissible for a man to lend his name to a third person and induce that third person to start in business in opposition to someone else who is using that name and has one established business under it. (*Rendle v. Rendle & Co.*, 63 L. T. N. S. 94; *Brinsmead v. Brinsmead*, 12 T. L. R. 631; *Mappin & Webb v. Leapman*, 22 R. P. C. 398.)

The use of a partnership name gotten up for the purpose of fraud will not be permitted. (*Croft v. Day*, 2 Beav. 84; *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Lubricant Co.*, 16 R. P. C. 12.)

In *Melachrino v. Melachrino Egyptian Cigarette Co.* (4 R. P. C. 45) the defendant took a brother of the plaintiff into his service under an agreement by which the defendant was to have the right to use the brother's name. The defendant then opened a business close to the plaintiffs under the name "The Melachrino Egyptian Cigarette Co." and used the name "Melachrino" in various ways calculated to deceive. An injunction was granted.

Rights to Name on Dissolution of Partnership.—Upon dissolution of a partnership of the whole business and good will is sold the trade name goes with them. (Banks v. Gibson, 33 Beav. 566.) If the partnership assets are merely divided without stipulation as to the partnership name then each partner is free to use the name. (Clark v. Leach, 22 Beav. 141; Condy v. Mitchell, 37 L. T. N. S. 268, 766; Levy v. Walker, 10 Ch. D. 436.)

Employer and Employee.—A person who has been a member or employe of a firm, and later sets up in business for himself may derive what benefit he may from a fair statement of the fact of his former employment as by the use of the phrase "late of" followed by the name of his former employer or firm. (Leather Cloth Co. v. American Leather Cloth Co., 1 H. & M. 271; Clark v. Leach, 32 Beav. 14; Cunday v. Lerwill, 99 L. T. N. S. 273.) Such statement must, however, not be made in such a way as to induce the belief that the former employe is selling the goods of his former employer. (Worcester Royal Porcelain Co., Ltd. v. Locke & Co., 19 R. P. C. 479, 490; Jefferson, Dodd & Co. v. Dodd's Drug Stores, 25 R. P. C. 16.)

Name of Establishment.—The name of an establishment or place of business if sufficiently distinctive may be protected, (e. g., "The Carriage Bazaar," Boulnois v. Peake, B. Ch. D. 513; "The Bodega," Bodega Co., Ltd. v. Owens, 7 R. P. C. 31.)

In Walker v. Alley, (13 Grant 366) it was found that the name and sign of "The Golden Lion" was so connected with the plaintiff's dry goods business that it could not be taken by another trader. The Chancellor in his judgment said:

"Where it is clear to the Court that the defendant himself intended an advantage by the use of a particular sign or mark in use by another, and believes he has obtained it, or, in other words, that the defendant himself thought the use of it was calculated to advertise him at the expense of the plaintiff, and this was his object in using it, and where such has been the effect of the user, I think the Court should say to him: 'Remove that sign; its use by you may, as you intend damage the plaintiff. It cannot be necessary or valuable to you for

any other purpose, you have your choice of many signs which, as a mere attraction or to give your store a marked designation must answer a fair business purpose equally well.' ”

Name of Building.—The right to the name of a building passes with it, and cannot be dealt with apart from it, (e. g., “Booth’s Theatre,” Booth v. Larrett, 52 How. Pr. 169; Mason v. Queen, 23 Scot L. R. 641.)

Name of Author.—An author is entitled to protection for the name under which his books are published. (Lord Byron v. Johnston, 2 Mer. 29; “Mark Twain,” Clemens v. Such Dig., 429 Archbold v. Sweet, 1 M. & Rob. 162.)

Trade Libel.—Sometimes the misuse of a man’s name may amount to a libel, or disparaging statements may be made sufficiently damaging to sustain a suit for libel. The law in such cases is far from clear, and must be considered in connection with the general law of libel, a subject beyond the scope of the present work. As illustrative cases, see Fleming v. Newton, 1 H. L. C. 376; Gee v. Pritchard, 2 Swanst. 413; Martin v. Wright, 6 Sim. 297; Clark v. Freeman, 11 Beav. 112; Thorley’s Cattle Food Co. v. Massam, 6 Ch. D. 582; Halsey v. Brotherhood, 15 Ch. D. 514; Colley v. Hart, 6 R. P. C. 17; Dunlop Pneumatic Tyre Co. v. Maison Talbot, 52 W. R. 254; Lee v. Gibbings, 67 L. T. N. S. 263.)

CHAPTER XII.

DESIGNS.

Statutes.—The first Canadian Statute, an Act of the Province of Canada in 1861 (24 Vic., c. 21) adopted the definition of Designs contained in the British Act of 1842, in the following terms:

11. And whereas it is advisable to make provision for the copy-righting, protecting and registering of new and original designs, whether such designs be applicable to the ornamenting of any article of manufacture, or of any substance, artificial or natural, or partly artificial and partly natural, and that whether such design be so applicable for the pattern, or for the shape, or for the configuration, or for the ornament thereof, or for any two or more such purposes, and by whatever means such design may be so applicable, whether by printing or by painting, or by embroidery, or by weaving, or by sewing, or by modeling, or by casting, or by embossing, or by engraving, or by staining, or by any other means, whatsoever, manual, mechanical, or chemical, separate or combined. . . .

This statute required the owner of the design should be a resident within Canada, and that the design should be applied to subject matter manufactured within Canada and be registered before publication. These restrictions still remain in force in the present Act.

The first Dominion Act, in 1868, after confederation (31 Vic., c. 55) followed the Provisional Act of 1861, but omitted the definition of Designs, and made a uniform term of five years for all classes.

The Act of 1879 (24 Vic., c. 22) made the term of five years renewable for a further period of five years.

Case Law.—There is practically no case law on Designs in Canada, only one case having been reported. In this case, *Findlay v. The Ottawa Furnace and Foundry Company*, (1902) 7 Ex. C. R. 338) the only question raised was that of infringement and the Court found the defendant's design of stove, an obvious imitation of the plaintiff's registered

Design. An injunction was granted, as well as an order that the registration of the defendant's Design should be expunged from the register. The leading English cases were referred to and cited in the judgment.

Registrants Must Be Residents in Canada.—The limitation of the benefits of the Act to residents of Canada, causes considerable inconvenience to many foreign manufacturers. This limitation now appears in the following terms in Section 3 of the Act:

Part II applies only to industrial designs, but does not apply to any design, the proprietor of which is not a person resident within Canada, nor to any design which is not applied to a subject matter manufactured in Canada.

It is sometimes sought to evade this limitation by making a person in Canada, temporarily, the proprietor for the purposes of registration. This is done by taking out the design registration in the name of some resident of Canada, and then later filing an assignment to the foreign owner. The validity of this method of procedure may be questioned.

Definition and Nature of Design.—The question of what constitutes a design under the present Act, cannot be definitely stated. It is probable that our courts will refer to the definition found in the present British Act—(Section 93 of the Patents and Designs Act (1907).

“Design” means any design (not being a design for a sculpture or other thing within the protection of the Sculpture Copyright Act, 1814) applicable to any article whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined.”

Various definitions are referred to on page 18 of Edmunds and Bentwich on Designs (second edition).

There is no distinction in Canadian law between ornamental and useful designs. Usefulness as apart from originality in shape and configuration or pattern is immaterial. In *re Bayer's Design*, (1907) 24 R. P. C. 65; *Hecla Foundry v. Walker*, (1889) 6 R. P. C. 554.

The mechanical construction or method of manufacture of an article does not form part of the design, and cannot be protected as such. *Werner's Motors v. Gamages, Ltd.*, (1904) 21 R. P. C. 137, 621; *Moody v. Tree*, (1892) 9 R. P. C. 333; *Re Rollason's Design*, (1887) 14 R. P. C. 909. Color may form part of a design. *Grafton v. Watson*, (1884) 50 L. T. (N. S.) 420.

A design may consist in the shape or configuration of a part or portion of an article (*Walker v. Falkirk Iron Co.*, (1887) 4 R. P. C. 390), or in the whole combination, or in both (*Norton v. Nicholls*, 28 L. J. Q. B. 225).

Novelty.—Novelty in a design is not expressly required but it is implied by the requirement in Section 34, that it shall be registered before publication. Novelty is to be considered not merely in the design itself but also in the application. "The copy or imitation of the figure, which itself may be common to the world, in such a manner as to render it applicable to an article of manufacture." *Saunders v. Wiel*, (1892) 9 R. P. C. 467; 10 R. P. C. 29. It is necessary, of course, that a design should be substantially different from what has been produced before. There must be, not merely a mere novelty of outline, but a substantial novelty in the design having regard to the nature of the article. *Lemay v. Welch*, (1884) 28 Ch. Div. 24. The novelty may reside in the combination of known elements or designs. *Harrison v. Taylor*, (1859) 29 L. J. Ex. 3; *Sherwood v. Decorative Art Tile Co.*, (1887) 4 R. P. C. 207.

The ultimate test of novelty in design is the appeal to the eye. *Re Hecla Foundry v. Walker*, (1889) 6 R. P. C. 554; *Re Bayer's Design*, (1907) 24 R. P. C. 65.

Publication.—"Publication" as referred to in Section 34 is not limited to Canada. Under a somewhat similar

section in the Patent Act it has been held that to obtain a valid patent in Canada, the inventor must be the first inventor the world over. *Smith v. Goldie*, (1883) 9 S. C. R. 46; *The Barnet-McQueen Co. v. The Canadian Stewart Co.*, (1910) 13 Ex. C. R. 186.

Prior use of a trade-mark by another in a foreign country does not affect the title of the first person to use the mark in Canada. *Smith v. Fair*, 14 Ont. R. 729; *Re Vulcan Trade-Mark*, 15 Ex. C. R. 265, 22 D. L. R. 214. In the absence of authority, it is thought that prior publication to invalidate a design registration must be publication in Canada. For a discussion as to what constitutes publication reference may be made to Chapter IV. of *Edmunds & Bentwich on Designs* (2d Edition).

Procedure for Registration.—The applicant for design registration must submit a drawing and description in duplicate, together with a declaration that the design is not in use to his knowledge by any other person than himself at the time of his adoption thereof. R. S. C. 71, s. 24. The drawing is preferably a tracing and the duplicate may be a blue-print or like fac-simile thereof. A declaration signed by the applicant's attorney may be accepted. The declaration and description are embodied together in the prescribed form, and should be executed in duplicate.

An examination is made prior to registration and registration will be made if the design "is not identical with or does not so closely resemble any other design registered as to be confounded therewith," or if it appears to the Minister to be within the provisions of the Act and not to be "contrary to public morality or order." If registration is refused the fee, less two dollars, is returned.

It is open for an applicant to whom registration has been refused to adduce arguments before the Registrar, and if aggrieved by the final omission to register, to appeal to the Exchequer Court of Canada, as provided for in Section 42 of the Act. The procedure with respect to In-

dustrial Designs is the same as that with respect to Trade-Marks.

Upon registration being made, a duplicate of the drawing and description is returned to the applicant, with a certificate signed by the Minister or the Deputy Minister of Agriculture to the effect that the design has been duly registered in accordance with the Act. This certificate is prima facie evidence of "the originality of the design, of the name of the proprietor, of the person named as proprietor being proprietor, of the commencement and term of registry, and of compliance with the provisions of this Act." R. S. c. 71, s. 27.

Term.—The registration gives the proprietor the exclusive right to the industrial design for a term of five years, which may be renewed for a further period of five years or less upon payment of the prescribed fee.

Marking of Registered Designs.—After registration, in order that any design may be protected, Section 34 provides, "the name of the proprietor shall appear upon the article to which his design applies by being marked, if the manufacture is a woven fabric on one end thereof, together with the letters Rd., and if the manufacture is of any other substance, with the letters Rd., and the year of registration at the edge or upon any convenient part thereof." Failure to mark in the manner prescribed may cause all rights in the design to be lost. (*Pierce v. Worth*, (1888) L. T. N. S. 810; *Wooley v. Broad*, (1892) 9 R. P. C. 429; *Wittman v. Oppenheim*, (1884) 54 L. J. Ch. 56; *Johnson v. Bailey*, (1893) 11 R. P. C. 213; *Re Rollason's Design*, (1897) 14 R. P. C. 893.)

Assignment.—A design may be assigned before or after registration. Section 28 provides: "If the author of the design shall, for a good and valuable consideration, have executed the same for some other person, such other person shall alone be entitled to register it." After registration the design may be assigned in whole or in part by an instrument in writing. Licenses of the right to "make, use and vend"

the design within and throughout Canada may be granted by the proprietor. Both assignments and licenses must be recorded in the office of the Minister of Agriculture. No special forms are prescribed for these documents. Only an original copy of any instrument need be provided for record. The contents of such instrument is noted on the Register, and the instrument itself is then returned.

Action to Expunge.—Any entry made in the Register of Industrial Designs may be expunged or varied in the same manner, and by the same procedure as a trade-mark registration. (See Chapter VII, on Action to Expunge or Vary.)

Rights Secured by Registration.—The rights secured by registration of an industrial design are defined by the following Sections 29, 30, 31, 35 and 36 of the Trade-Mark and Design Act:

29. An exclusive right for an industrial design may be acquired by registration of the same under this Part. R. S., c. 63, s. 29.

30. Such exclusive right shall be valid for the term of five years, but may be renewed, at or before the expiration of the said term of five years, for a further period of five years or less on payment of the fee in this Act prescribed for extension of time: Provided that the whole duration of the exclusive right shall not exceed ten years in all. R. S., c. 63, s. 29.

31. During the existence of such exclusive right, whether of the entire or partial use of such design, no person shall without the license in writing of the registered proprietor, or, if assigned, of his assignee, apply for the purposes of sale such design or a fraudulent imitation thereof to the ornamenting of any article of manufacture or other article to which an industrial design may be applied or attached, or publish, sell or expose for sale or use, any such article as aforesaid to which such design or fraudulent imitation thereof has been applied. R. S., c. 63, s. 31.

35. If any person applies or imitates any design for the purpose of sale, being aware that the proprietor of such design has not given his consent to such application, an action may be maintained by the proprietor of such design, against such person for the damages such proprietor has sustained by reason of such application or imitation. R. S., c. 63, s. 35.

36. Every person who, in violation of the provisions of this Part, during the existence of the exclusive right acquired for any industrial design by the registration of the same under this Part, whether of the entire or partial use of such design, without the license in writing of the registered proprietor, or, if assigned, of his assignee,—

- (a) for the purposes of sales, applies or attaches such design or a fraudulent imitation thereof to the ornamenting of any article of manufacture or other article to which an industrial design may be applied or attached; or,
- (b) publishes, sells or exposes for sale or for use, any article of manufacture or other article to which an industrial design may be applied or attached and to which such design or fraudulent imitation thereof has been applied or attached;

shall forfeit a sum not exceeding one hundred and twenty dollars and not less than twenty dollars to the proprietor of the design so applied.

2. Such sum shall be recoverable with costs on summary conviction under Part XV. of the Criminal Code by the registered proprietor or assignee. R. S., c. 63, s. 31.

Infringement.—Infringement is a question of fact, and is generally determined by an appeal to the eye. *Hecla Foundry Co. v. Walker*, (1889) 6 R. P. C. 554; *Harper v. Wright & Butler*, (1895) 12 R. P. C. 483. In deciding whether or not any variations made are substantial enough to avoid infringement it is necessary to refer to the state of knowledge in the particular trade in which the design is used. *Holdsworth v. McCrea*, (1867) L. R. 2 H. L. 380, 386; *Barran v. Lomas*, (1880) 28 W. R. 973.

Penalties or Damages.—Section 36 provides a criminal remedy. Under the British cases the plaintiff may be called upon to elect whether he proceed for penalties or for damages. *Saunders v. Weil* (No. 1), (1892) 9 R. P. C. 459. The damages recoverable will be the profit which the proprietor of the design would have made if he had himself sold or granted a license for the sale of the copies improperly made and sold by the infringer. *Ingram & Kemp v. Edwards*, (1904) 21 R. P. C. 463. As an alternative to damages, an account of profits may be ordered. *Saccharin Corporation v. Chemicals and Drugs Co.*, (1900) 17 R. P. C. 612. An injunction may also be granted against actual or threatened infringement. *Wilkins v. Aikin*, 17 Ves. 425.

An application for interlocutory injunction, if the proprietor makes a prima facie case, will be granted or refused as the balance of convenience may warrant. *Smith*

v. Chatto, (1875) 31 L. T. N. S. 775; Hildesheimer v. Dunn, (1891) 64 L. T. N. S. 452.

Practice in Action for Infringement.—The pleadings on an action for infringement of a design registration may be similar to those in a patent action. The plaintiff pleads the registration, and his ownership thereof, the infringement and particulars thereof. The principal defences, apart from denial of infringement, are:

(1) The invalidity of the registration because (a) the design is not proper subject matter; (b) the design was published before registration; (c) the applicant for registration was not a resident of Canada; (d) the declaration accompanying the application for registration was false.

(2) That the plaintiff is not the proprietor of the design.

(3) That the articles to which the design has been applied have not been properly marked.

(4) Leave or license.

(5) Lapse of the registration through failure to renew at the end of five years.

(6) That the suit was not brought within twelve months from the cause of action. R. S., c. 71, s. 38.

(7) That the design was not applied to an article manufactured in Canada.

Penalty for False Marking.—Section 37 provides a penalty for falsely representing an article as having a registered design.

37. Every person who,—

- (a) places the word "Registered" or the letters "Rd." upon any article for which no design has been registered under this Part or upon any article for the design of which the exclusive right has expired; or,
- (b) advertises for sale as a registered article any article for which no design has been registered or for the design of which the exclusive right has expired; or,
- (c) unlawfully sells, publishes or exposes for sale any article for which no design has been registered, or for the design of which the exclusive right has expired, and on which the word "Registered" or the letters "Rd." have been placed, knowing the said article to have been fraud-

ulently marked or the exclusive right to such design to have expired;
shall for each offence be liable to a penalty not exceeding thirty dollars and not less than four dollars.

2. Such penalty shall be recoverable on summary conviction under Part XV. of the Criminal Code with costs by any person who sues for the same.

3. A moiety of such penalty shall belong to the prosecutor, and the other moiety to His Majesty for the public uses of Canada. R. S., c. 63, s. 32.

CHAPTER XIII.

TRADE-MARK AND DESIGN LEGISLATION IN CANADA.

The following is a synopsis of the Canadian Statutes respecting Trade-Marks and Designs:

1. The first Act respecting Trade-Marks was the Act of the Province of Canada passed in 1860.

Sec. (1). This section made a misdemeanor the use of the known and accustomed trade-mark, name, package, or device of any manufacturer with intent to deceive so as to induce the belief that the goods marked were manufactured by the owner of the mark.

Sec. (2). This section contained definition of "fraudulent use" of such trade-mark, name, package or device, as being a use identical with, or so closely resembling another's trade-mark, as to be calculated to be taken for the true trade-mark by ordinary purchasers.

Sec. (3). This section provided for actions, by the owner of an infringed mark, etc., for damages special or nominal.

II. Act of 1861 of Province of Canada. "An Act to amend the Act respecting Trade-Marks and to provide for the Registration of Trade-Marks."

PREAMBLE: Whereas it is expedient to make provision for the better ascertaining and determining the right of manufacturers or others, to enjoy the exclusive use within this Province (Canada) of trade-marks, claimed by them. Therefore Her Majesty, etc.

Sec. (1) Repealed Act of 1860.

Sec. (2) Defined trade-marks as follows:

All marks, names, brands, labels, packages or other business devices, adopted for the purpose of distinguishing any manufacture, etc., no matter how applied, shall be deemed trade-marks, and may be registered for the ex-

clusive use of the party registering the same, and thereafter he shall have the exclusive right to use the same.

Sec. (3) Provided for Trade-Mark Register to be kept by the Secretary of the Board of Registration and Statistics, for cases when the registration should be made, and for particulars of entry to be made.

Sec. (4) Provided for the cancellation of improper registration.

Sec. (5) Provided a penalty for using another person's trade-mark; similar to Sec. 1 of the Act of 1860.

Sec. (6) Provided a penalty for the registration of trade-mark of another person not resident in the Province and for cancellation in such a case.

Sec. (7) Provided a penalty for using trade-marks of persons not resident in this Province.

Sec. (8) Provided for the recovery of penalties provided for in Secs. 6 and 7.

Sec. (9) Improper use of the trade-mark defined; similar to Sec. 2 of the Act of 1860.

Sec. (10) The common law action for damages preserved.

Secs. (11 to 24.) Dealt with industrial designs.

Sec. (25) Copies of registered trade-marks, and the Register to be open to the public at the Board of Arts and Manufactures for Upper and Lower Canada.

III. 30 Vict. ch. 31 (N. B.) "An Act relating to Trade-Marks."

This Act was repealed by the Trade-Mark and Design Act of 1868, 31 Vict. ch. 54 (Dom.). It was the only Provincial Act respecting Trade-Marks outside of the Province of Canada.

Sec. (1) Provided for grants of the exclusive right to appropriate and use any trade-mark by the Governor under the Great Seal of the Province of New Brunswick.

Sec. (2) Provided for the manner of application, description, and drawing of declaration.

Sec. (3) Provided for place of filing petition and diagrams, Provincial Secretary's Office.

Sec. (4) Grants of trade-marks to be published in the Royal Gazette.

Sec. (5) Defined trade-marks. Identical with Sec. 4 of Dom. Act of 1868 (*vide infra*), except as to last clause in Dom. Act regarding timber, which is omitted in N. B. Act.

Sec. (6) Conflicting claims to trade-marks—how to be dealt with. Identical with Sec. 6 of Dom. Act, 1868, excluding the clause commencing "and similarly."

Sec. (7) Penalty for using another's trade-mark. Identical with Sec. 7 of the Dom. Act of 1868.

Sec. (8) Penalty of registering another's trade-mark as your own. Identical with Sec. 8 of the Act of 1868, necessary changes being made.

Sec. (9) Recovery of penalties. Identical with Sec. 10, Dom. Act of 1868.

Sec. (10) Definition of fraudulent user of a trade-mark. Identical with Sec. 11 of the Dom. Act, 1868.

Sec. (11) Fees.

Sec. (12) Common law action of damages reserved. Identical with Sec. 12 of the Act of 1868.

IV. The Dom. Act of 1868, 31 Vict. ch. 55. "The Trade-Mark and Design Act of 1868."

This was the first Dominion Act after Confederation.

Sec. (1) Minister of Agriculture to keep a Trade-Mark Register and to enter trade-mark therein under certain conditions.

Sec. (2) Minister may adopt forms and make rules and regulations.

Sec. (3) Defines Trade-Marks as follows:—All marks, names, brands, labels, packages or other business devices, which may be adapted for use by any person in his trade, business, occupation or calling for the purpose of distinguishing any manufacture, product or article, of any description by him manufactured, produced, compounded,

packed, or offered for sale, no matter how applied whether to such manufacture, product or article, or to any package, parcel, case, box or other vessel or receptacle of any description whatever containing the same, shall be considered and known as trade-marks, and may be registered for the exclusive use of the party registering the same in the manner hereinafter provided; and thereafter he shall have the exclusive right to use the same, to designate articles manufactured or sold by him; and for the purpose of this Act. Timber and lumber of any kind upon which labour has been expended by any person in his trade, business, occupation, or calling, shall be deemed a manufacture, product, or article.

Sec. (4) Trade-marks may be cancelled at the instance of the party registering same.

Sec. (5) Registered trade-marks assignable and assignment may be registered.

Sec. (6) In case of conflict between claims to a trade-mark, the procedure to be adopted before the minister.

Sec. (7) Penalty for using another person's trade-mark which use is made a misdemeanour.

Sec. (8) Penalty for registering another's trade-mark as your own.

Sec. (9) Penalty for counterfeiting or using trade-marks of any person not resident in Canada.

Sec. (10) Recovery of penalties.

Sec. (11) Use of a trade-mark defined.

Sec. (12) Action of damages reserved.

Secs. (13-23) Industrial designs.

Sec. (24) Inspection of register.

Sec. (27) Clerical errors in any instrument not to invalidate.

Sec.(28) Table of fees.

Sec. (29) Acts repealed: 24 Vict. ch. 21 (C); 30 Vict. ch. 31 (N. B.).

Sec. (30) Deputy Minister substituted for Secretary of Registration and Statistics under 24 Vict. ch. 21 (C.).

V. Act of 1879—An Act respecting Trade-Mark and Industrial Designs.

This Act is almost verbatim the Act R. S. C., 1886, ch. 63, "An Act respecting Trade-Marks and Industrial Designs," the only difference being slight immaterial changes in phraseology. Sec. 38 is omitted from the consolidated statute as obsolete, that section having detailed certain Acts, that were repealed, i. e., 31 Vict. ch. 35 (D.), and 39 Vict. ch. 55 (D.).

VI. R. S. C. 1886, chapter 63.

An Act respecting Trade-Marks and Industrial Designs HER MAJESTY, by and with the advice and consent of the Senate and House of Commons of Canada, enacts as follows:

SHORT TITLE.

1. Short Title.—This Act may be cited as "The Trade-Mark and Design Act." 42 V., ch. 22, sec. 40.

APPLICATION OF ACT.

2. Application of Act.—Sections three to twenty-one of this Act, both inclusive, apply only to trade-marks, and sections twenty-two to thirty-eight, both inclusive, apply only to industrial designs. 42 V., ch. 22, sec. 37.

TRADE-MARKS.

3. What Shall Be Deemed to Be Trade-Marks.—All marks, names, brands, labels, packages or other business devices, which are adopted for use by any person in his trade, business, occupation or calling, for the purpose of distinguishing any manufacture, product or article of any description manufactured, produced, compounded, packed, or offered for sale by him—applied in any manner whatever either to such manufacture, product or article, or to any package, parcel, case, box or other vessel or receptacle of any description whatsoever containing the same, shall, for the purposes of this Act, be considered and

known as trade-marks, and may be registered for the exclusive use of the person registering the same in the manner herein provided; and thereafter such person shall have the exclusive right to use the same to designate articles manufactured or sold by him:

(2) As to Timber or Lumber.—Timber or lumber of any kind upon which labor has been expended by any person in his trade, business, occupation or calling, shall, for the purposes of this Act, be deemed a manufacture, product or article. 42 V., ch. 22, sec. 8.

4. Classification.—A trade-mark may be general or specific, according to the use to which it is applied or intended to be applied by the proprietor thereof:

(a) General Trade-Mark.—A general trade-mark is one used in connection with the sale of various articles in which the proprietor deals in his trade, business, occupation or calling generally;

(b) Specific Trade-Mark.—A specific trade-mark is one used in connection with the sale of a class of merchandise of a particular description. 42 V., ch. 22, sec. 9.

5. Register to Be Kept.—A register of trade-marks shall be kept at the Department of Agriculture, in which any proprietor of a trade-mark may have the same registered, on complying with the provisions of this Act. 42 V., ch. 22, sec. 1.

6. Minister May Make Rules and Adopt Forms.—The Minister of Agriculture may, from time to time, subject to the approval of the Governor in Council, make rules and regulations and adopt forms for the purposes of this Act, as respects trade-marks; and such rules, regulations and forms circulated in print for the use of the public, shall be deemed to be correct for the purpose of this Act; and all documents executed according to the same and accepted by the Minister, shall be deemed to be valid so far as relates to official proceedings under this Act. 42 V., ch. 22, sec. 2.

7. Seal and Its Use.—The Minister of Agriculture may cause a seal to be made for the purposes of this Act, and

may cause to be sealed therewith trade-marks and other instruments, and copies of such trade-marks and other instruments, proceeding from his office in relation to trade-marks. 42 V., ch. 22, sec. 3.

8. How Registration May Be Effected.—The proprietor of a trade-mark may have it registered on forwarding to the Minister of Agriculture, together with the fee hereinafter mentioned, a drawing and description in duplicate of such trade-mark, and a declaration that the same was not in use to his knowledge by any other person than himself at the time of his adoption thereof. 42 V., ch. 22, sec. 6.

9. Nature of Trade-Mark to Be Specified.—Every proprietor of a trade-mark who applies for its registration shall state in his application whether the said trade-mark is intended to be used as a general trade-mark or as a specific trade-mark. 42 V., ch. 22, sec. 11.

10. Tariff of Fees.—Before any action is taken in relation to an application for registering a trade-mark, the following fees shall be paid to the Minister of Agriculture, that is to say:—

On every application to register a general trade-mark, including certificate	\$30 00
On every application to register a specific trade-mark, including certificate	25 00
On every application for the renewal of the registration of a specific trade-mark, including certificate	20 00
For copy of each certificate of registration, separate from the return of the duplicate	1 00
For the recording of an assignment	2 00
For office copies of documents, not above mentioned, for every hundred words for a fraction thereof	0 50
For each copy of any drawing or emblematic trade-mark, the reasonable expenses of preparing the same.	

Application.—And such fees shall be paid over by the Minister of Agriculture to the Minister of Finance and Receiver General:

(2) Return of Fee if Application Is Refused.—If the Minister of Agriculture refuses to register the trade-mark for which application is made, the fee shall be returned to the applicant or his agent, less the sum of five dollars, which shall be retained as compensation for office expenses. 42 V., ch. 22, sec. 12.

11. Decision of Doubtful Cases.—If any person makes application to register, as his own, any trade-mark which has been already registered, and the Minister of Agriculture is not satisfied that such person is undoubtedly entitled to the exclusive use of such trade-mark, the Minister shall cause all persons interested in the matter to be notified to appear, in person or by attorney, before him, with their witnesses, for the purpose of establishing which is the rightful owner of such trade-mark; and after having heard the said persons and their witnesses, the Minister shall order such entry or cancellation, or both, to be made as he deems just; and in the absence of the Minister, the deputy of the Minister of Agriculture may hear and determine the case and make such entry or cancellation or both, as he deems just:

(2) Correction of Errors.—Errors in registering trade-marks and oversights in respect of conflicting registrations of trade-marks may be corrected in a similar manner. 42 V., ch. 22, sec. 15.

12. When Minister May Object to Register a Trade-Mark.—The Minister of Agriculture may object to register any trade-mark in the following cases:—

(a) If the trade-mark proposed for registration is identical with or resembles a trade-mark already registered;

(b) If it appears that the trade-mark is calculated to deceive or mislead the public;

(c) If the trade-mark contains any immorality or scandalous figure;

(d) If the so-called trade-mark does not contain the es-

entials necessary to constitute a trade-mark, properly speaking. 42 V., ch. 22, sec. 5.

13. Mode of Registration and Certificate Thereof.—On compliance with the requirements of this Act and of the rules hereinbefore provided for, the Minister of Agriculture shall register the trade-mark of the proprietor so applying, and shall return to the said proprietor one copy of the drawing and description with a certificate signed by the Minister or the deputy of the Minister of Agriculture to the effect that the said trade-mark has been duly registered in accordance with the provisions of this Act; and the day, month and year of the entry of the trade-mark in the register shall also be set forth in such certificate; and every such certificate, purporting to be so signed, shall be received in all courts in Canada, as prima facie evidence of the facts therein alleged without proof of the signature. 42 V., ch. 22, sec. 7.

14. Duration of General Trade-Mark.—A general trade-mark once registered and destined to be the sign in trade of the proprietor thereof shall endure without limitation:

(2) And of Specific Trade-Mark.—A specific trade-mark, when registered, shall endure for the term of twenty-five years, but may be renewed before the expiration of the said term by the proprietor thereof, or by his legal representative, for another term of twenty-five years, and so on from time to time; but every such renewal shall be registered before the expiration of the current term of twenty-five years. 42 V., ch. 22, sec. 10.

15. Cancellation of Trade-Marks.—Any person who has registered a trade-mark may petition for the cancellation of the same, and the Minister of Agriculture may, on receiving such petition, cause the said trade-mark to be so cancelled; and the same shall, after such cancellation be considered as if it had never been registered under the name of the said person. 42 V., ch. 22, sec. 13.

16. Trade-Marks May Be Assigned.—Every trade-mark registered in the office of the Minister of Agricul-

ture, shall be assignable in law; and on the assignment being produced, and the fee hereinbefore prescribed being paid, the Minister shall cause the name of the assignee, with the date of the assignment and such other details as he sees fit, to be entered on the margin of the register of trade-marks on the folio where such trade-mark is registered. 42 V., ch. 22, sec. 14.

17. Penalty for Unlawful Use of Trade-Mark.—Every person, other than the person who has registered the trade-mark, who marks any goods or any article of any description whatsoever, with any trade-mark registered under the provisions of this Act, or with any part of such trade-mark, whether by applying such trade-mark or any part thereof to the article itself, or to any package or thing containing such article, or by using any package or thing so marked which has been used by the proprietors of such trade-mark, or who knowingly sells or offers for sale any article marked with such trade-mark, or with any part thereof, with intent to deceive and to induce any person to believe that such article was manufactured, produced, compounded, packed or sold by the proprietor of such trade-mark, is guilty of a misdemeanor, and liable, for each offense, to a fine not exceeding one hundred dollars and not less than twenty dollars, which fine shall be paid to the proprietor of such trade-mark, together with the cost incurred in enforcing and recovering the same:

(2) Complaint to Be Made by the Proprietor.—Every complaint under this section shall be made by the proprietor of such trade-mark, or by some one acting on his behalf and thereunto duly authorized. 42 V., ch. 22, sec. 16.

18. Suit May Be Maintained by Proprietor.—An action or suit may be maintained by any proprietor of a trade-mark against any person who uses his registered trade-mark, or any fraudulent imitation thereof, who sells any article bearing such trade-mark, or any such imitation thereof, or contained in any package being or purporting to be his, contrary to the provisions of this Act. 42 V., ch. 22, sec. 17.

19. No Suit Unless Trade-Mark Is Registered.—No person shall institute any proceeding to prevent the infringement of any trade-mark, unless such trade-mark is registered in pursuance of this Act. 42 V., ch. 22, sec. 4, part.

20. Register May Be Inspected.—Any person may be allowed to inspect the register of trade-marks; and the Minister of Agriculture may cause copies or representations of trade-marks to be delivered, on the applicant for the same paying the fee or fees hereinbefore prescribed. 42 V., ch. 22, sec. 18.

21. Clerical Errors Not to Invalidate.—Clerical errors which occur in the drawing up or copying of any instrument, under the preceding sections of this Act, shall not be construed as invalidating the same, and when discovered they may be corrected under the authority of the Minister of Agriculture. 42 V., ch. 22, sec. 19.

INDUSTRIAL DESIGNS.

22. Register of Industrial Designs to Be Kept.—The Minister of Agriculture shall cause to be kept a book to be called "The Register of Industrial Designs," in which any proprietor of a design may have the same registered on depositing with the Minister a drawing and description in duplicate of such design, together with a declaration that the same was not in use to his knowledge by any other person than himself at the time of his adoption thereof; and the Minister, on receipt of the fee hereinafter provided, shall cause such design to be examined to ascertain whether it resembles any other design already registered; and if he finds that such design already registered as to be confounded therewith he shall register the same, and shall return to the proprietor thereof one copy of the drawing and description, with a certificate signed by the Minister or the deputy of the Minister of Agriculture, to the effect that such design has been duly registered in accordance with the provisions of this Act; and such certificate shall also set forth the day, month and year of the

entry thereof in the proper register; and every such certificate purporting to be so signed, shall, without proof of the signature, be received in all courts in Canada, as prima facie evidence of the facts therein alleged. 42 V., ch. 22, sec. 20.

23. Minister May Make Rules and Adopt Forms.—The Minister of Agriculture may, from time to time, subject to the approval of the Governor in Council, make rules and regulations and adopt forms for the purposes of this Act, as respects industrial designs, and such rules, regulations and forms circulated in print for the use of the public, shall be deemed to be correct for the purposes of this Act; and all documents executed according to the same, and accepted by the Minister, shall be deemed to be valid so far as relates to official proceedings under this Act. 42 Vic., ch. 22, sec. 21.

24. Conditions of Registration.—Every design, in order to be protected, shall be registered before publication after registration, the name of the proprietor, who shall be a resident of Canada, shall appear upon the article to which his design applies, if the manufacture is a woven fabric, by being marked upon one end thereof, together with the letters "Rd.," and if the manufacture is any other substance, the letters "Rd.," with the year of the registration, shall be marked at the edge or upon any convenient part thereof:

(2) How Mark Shall Be Applied.—The mark may be put upon the manufacture by making it on the material itself, or by attaching thereto a label containing the proper marks. 42 V., ch. 22, sec. 23.

25. Who Shall Be Deemed the Proprietor.—The author of the design shall be considered the proprietor thereof, unless he has executed the design for another person, for a good or valuable consideration in which case, such other person shall be considered the proprietor, and shall alone be entitled to register it; but his right to the property shall only be co-extensive with the right which he has acquired. 42 V., ch. 22, sec. 24.

26. **Tariff of Fees.**—Before any action is taken in relation to an application for registering an industrial design, the following fees shall be paid to the Minister of Agriculture, that is to say:

On every application to register a design including certificate	\$5 00
On every application for an extension of time, including certificate, for each year of such extension	2 00
For a copy of each certificate of registration, separate from the return of the duplicate	1 00
For the recording of an assignment	2 00
For office copies of documents, not above mentioned, for every one hundred words or fraction thereof	0 50
For each copy of any drawn copy of an industrial design, the reasonable expense of preparing the same.	

Application.—And such fees shall be paid over by the Minister of Agriculture to the Minister of Finance and Receiver General:

(2) **Return of Fee if Application Is Refused.**—If the Minister of Agriculture refuses to register the industrial design in respect of which application is made, the fee shall be returned to the applicant or his agent, less the sum of two dollars, which shall be retained as compensation for office expenses. 42 V., ch. 22, sec. 36.

27. **When Minister May Refuse to Register.**—The Minister of Agriculture may refuse to register such designs as do not appear to him to be within the provisions of this Act, or any design which is contrary to public morality or order, subject to appeal to the Governor in Council. 42 V., ch. 22, sec. 34.

28. **Certificate to Be Given and Its Effect.**—On the copy returned to the person registering, a certificate shall be given, signed by the Minister of Agriculture or the deputy of the Minister of Agriculture, showing that the design has been registered, the date of registration, the name

of the registered proprietor, his address, the number of such design, and the number or letter employed to denote or correspond to the registration which said certificate, in the absence of proof to the contrary, shall be sufficient proof of the design, of the name of the proprietor, of the registration, of the commencement and term of registry, of the person named as proprietor being proprietor, of the originality of the design, and of compliance with the provisions of this Act; and generally the writing purporting to be so signed shall be received as prima facie evidence of the facts therein stated, without proof of the signature. 42 V., ch. 22, sec. 32.

29. Duration of Right.—The exclusive right acquired for an industrial design by the registration of the same as aforesaid shall be valid for the term of five years, but may be renewed at or before the expiration of the said term of five years, for a further period of five years or less, on payment of the fee hereinbefore prescribed, so as that the whole duration of the exclusive right shall not exceed ten years in all. 42 V., ch. 22, sec. 22.

30. Design to Be Assignable.—Every design shall be assignable in law, either as to the whole interest or any undivided part thereof, by an instrument in writing which shall be recorded in the office of the Minister of Agriculture, on payment of the fees hereinbefore provided and every proprietor of a design may grant and convey an exclusive right, under any copyright, to make, use and vend, and to grant to others the right to make, use and vend such design, within and throughout Canada, or any part thereof, for the unexpired term of its duration, or any part thereof, which exclusive grant and conveyance shall be called a license, and shall be recorded in the same manner and within the same delay as assignments. 42 V., ch. 22, sec. 25.

31. Exclusive Right to Use Design.—During the existence of the exclusive right (whether it is of the entire or partial use of such design), no person shall, without the license in writing of the registered proprietor, or of his assignee, as the case may be, apply such design, or a

fraudulent imitation thereof, to the ornamenting of any article of manufacture, or other article to which an industrial design may be applied or attached, for the purpose of sale, or shall publish, sell or expose for sale or use any such article as aforesaid, to which such design or fraudulent imitation thereof has been applied; and every one who violates the provisions of this section shall forfeit a sum not exceeding one hundred and twenty dollars, and not less than twenty dollars to the proprietor of the design, which shall be recoverable, with costs, on summary conviction, by the registered proprietor or his assignee. 42 V., ch. 22, sec. 26.

32. Penalty for Falsely Representing Article as Bearing Registered Design.—Every person who places the word "registered," or the letters "Rd." upon any article for which no design has been registered, or upon any article for the design of which the copyright has expired, or who advertises the same for sale as a registered article, or unlawfully sells, publishes or exposes for sale such article, knowing the same to have been fraudulently marked, or that the copyright therefor has expired, shall, for each offense, on summary conviction, be liable to a penalty not exceeding thirty dollars and not less than four dollars, which shall be recoverable, with costs, by any person who sues for the same; and a moiety of such penalty shall belong to the prosecutor, and the other moiety to Her Majesty, for the public uses of Canada. 42 V., ch. 22, sec. 27.

33. Proceedings in Case of Wrongful Registration.—If any person, who is not the lawful proprietor of a design, is registered as proprietor thereof, the rightful owner may institute an action in any superior court in any Province of Canada, or before a judge of the Supreme Court in the North-West Territories, as the case may be; and the court or judge having cognizance of such suit may, if it appears that the design has been registered in the name of a wrong person, either direct the registration to be cancelled or that the name of the lawful proprietor shall be substituted for the name in the register, with costs, in its or his discretion; and on application by the plaintiff, supported by

affidavit, any such court or judge may, pending such action or proceedings, under penalty of being held in contempt of such court or judge. 42 V., ch. 22, sec. 29; 49 V., ch. 25, sec. 30.

34. Consequent Alteration of Register.—The Minister of Agriculture shall, after due service of such order and payment of the fee hereinbefore provided, cause such alteration to be made in the register respecting industrial designs as is directed by the order made under the next preceding section. 42 V., ch. 22, sec. 30.

35. Suit May Be Maintained by the Proprietor. A suit may be maintained by the proprietor of any design for the damages he has sustained by the application or imitation of the design, for the purpose of sale, against any person so offending, if the offender was aware that the proprietor of the design had not given his consent to such application. 42 V., ch. 22, sec. 28.

36. Time for Suits Limited.—All proceedings under the preceding section of this Act, respecting industrial designs, shall be brought within twelve months from the commission of the offence, and not afterwards; and none of the provisions of the said sections shall apply to protect any design which does not belong to a person resident within Canada, and which is not applied to a subject matter manufactured in Canada. 42 V., ch. 22, sec. 31.

37. Register May Be Examined and Copies of Designs Obtained.—Any person may be allowed to inspect the register of industrial designs; and the Minister of Agriculture may cause copies or representation of industrial designs to be delivered, on the applicant for the same paying the fee which is deemed sufficient for the purpose of having the same copied or represented. 42 V., ch. 22, sec. 33.

38. Clerical Errors May Be Corrected.—Clerical errors which occur in the drawing up or copying of any instrument respecting an industrial design, shall not be construed as invalidating the same, but, when discovered, they may be corrected under the authority of the Minister of Agriculture. 42 V., ch. 22, sec. 35.

VII.—53 VICTORIA.

Chap. 14.

An Act to amend the Act Respecting Trade-Marks and Industrial Designs.

(Assented to 26th March, 1890.)

HER MAJESTY, By and with the advice and consent of the Senate and House of Commons of Canada, enacts as follows:

I. R. S. C., ch. 63, sec. 11, repealed; new section, Section eleven of "An Act respecting Trade-Marks and Industrial Designs," chapter sixty-three of the Revised Statutes, is hereby repealed, and the following substituted therefor:

11. Decision of doubtful cases. If any person makes application to register, as his own, any trade-mark which has already been registered, and the Minister of Agriculture is not satisfied that such person is undoubtedly entitled to the exclusive use of such trade mark, the Minister shall cause all persons interested in the matter to be notified that the question is one for decision by the Exchequer Court of Canada; no further proceeding shall be had or taken concerning such application until the rights of the parties have been declared and adjudged by the said court, or until the parties have agreed among themselves as to their respective rights."

2. Exchequer Court to have jurisdiction. Any question arising under the preceding section may be adjudicated upon by the Exchequer Court of Canada, and the said Court shall have jurisdiction, upon information in the name of the Attorney-General of Canada, and at the relation of any party interested as aforesaid, to declare the rights of the contesting claimants with respect to such trade-mark, and may make rules and orders to regulate the practice and procedure in cases arising under this Act:

(2) Action of Minister. The Minister shall be guided, in dealing with such trade-mark, by the decree, order or judgment of the said Court:

(3) Concurrent Jurisdiction. This section shall not be held to take away or affect the jurisdiction as to any question arising thereunder which any court other than the Exchequer Court of Canada possesses.

3. Correction of Errors. Errors in registering trade-marks and oversights in respect to conflicting registrations of trade-marks may be corrected by the Exchequer Court of Canada, upon proceedings instituted therein in the manner provided in section one of this Act.

VIII.—54-55 VICTORIA.

Chap. 35.

An Act further to amend the Act respecting Trade-Marks and Industrial Designs.

(Assented to 10th July, 1891.)

HER MAJESTY, By and with the advice and consent of the Senate and House of Commons of Canada, enacts as follows:

1. R. S. C., ch. 63, secs. 11, 12, and 33 repealed. Sections eleven, twelve, and thirty-three of "An Act respecting Trade-Marks and Industrial Designs," chapter sixty-three of the Revised Statutes are hereby repealed, and the following enacted in lieu thereof:—

"2. When Minister May Refuse to Register a Trade-mark. The Minister of Agriculture may refuse to register any trade-mark in the following cases:—

"(a) If he is not satisfied that the applicant is undoubtedly entitled to the exclusive use of such trade-mark;

"(b) If the trade-mark proposed for registration is identical with or resembles a trade-mark already registered;

"(c) If it appears that the trade-mark is calculated to deceive or mislead the public;

"(d) If the trade-mark contains any immorality or scandalous figure;

"(e) If the so-called trade-mark does not contain the

essentials necessary to constitute a trade-mark, properly speaking.

“(2) Reference to Exchequer Court—Jurisdiction of Court. The Minister of Agriculture may, however, if he thinks fit, refer the matter to the Exchequer Court of Canada, and in that event such court shall have jurisdiction to hear and determine the matter, and to make an order determining whether and subject to what conditions, if any, registration is to be permitted.

“12. Jurisdiction of Court as to Entries in Register—Costs. The Exchequer Court of Canada may, on the information of the Attorney-General, or at the suit of any person aggrieved by any omission, without sufficient cause, to make any entry in the register of trade-marks, or by an entry made therein without sufficient cause, make such order for making, expunging, or varying the entry as the court thinks fit, or the court may refuse the application, and in either case may make such order with respect to the costs of the proceedings as the court thinks fit:

“(2) Rectification of Register. The said court may, in any proceeding, under this section, decide any question that may be necessary or expedient to decide for the rectification of such register:

“(3) Alterations of Trade-Marks. The registered proprietor of any registered trade-mark may apply to the Exchequer Court of Canada for leave to add to or alter such mark in any particular not being an essential particular, and the court may refuse or grant leave on such terms as it may think fit:

“(4) Notice to Minister. Notice of any intended application to the court under the last preceding subsection of this section shall be given to the Minister of Agriculture, and he shall be entitled to be heard on the application:

“(5) Procedure on Orders of Court. A certified copy of every order of the court for the making, expunging, or varying of any entry in the register of trade-marks, or for adding to or altering any registered trade-mark shall be transmitted to the Minister of Agriculture by the registrar of the court, and such register shall thereupon be rec-

tified or altered in conformity with such order, or the purport thereof shall otherwise be duly entered in the register as the case may be.

“33. Jurisdiction of Court as to Industrial Designs. The Exchequer Court of Canada shall, in respect of the register of industrial designs, have jurisdiction in a like proceeding and manner as hereinbefore provided in respect of the register of trade-marks, to make orders for the making, expunging, or varying any entry in such register of industrial designs, or for adding to or altering any industrial design.”

2. 53 Vict., ch. 14, Repealed. The Act 53 Victoria, chapter 14, entitled “An Act to amend the Act respecting Trade-Marks and Industrial Designs,” is hereby repealed.

IX. The present Act R. S. 1906, ch. 71.

APPENDIX I.

TRADE-MARK AND DESIGNS ACT, R. S. 1906.

CHAPTER 71.

An Act respecting Trade-Marks and Industrial Designs.

SHORT TITLE.

1. This Act may be cited as the Trade-Mark ^{Short title.} and Design Act. R.S., ch. 63, sec. 1.

GENERAL INTERPRETATION.

2. In this Act, unless the context otherwise ^{Minister.} requires, 'Minister' means the Minister of Agriculture.

DIVISION OF ACT.

3. This Act is divided into three parts. Part ^{Division of Act.} I. applies only to Trade-Marks. Part II. applies only to Industrial Designs, but does not apply to any design the proprietor of which is not a person resident within Canada, nor to any design which is not applied to a subject-matter manufactured in Canada. Part III. is general and applies to both Trade-Marks and Industrial Designs. R.S., ch. 63, secs. 2, 24 and 36.

PART I.

TRADE-MARKS.

Interpretation.

4. In this Part, unless the context otherwise ^{Definitions.} requires,—

- (a) 'general trade-mark' means a trade-mark used in connection with the sale

of various articles in which a proprietor deals in his trade, business, occupation or calling generally;

- (b) 'specific trade-mark' means a trade mark used in connection with the sale of a class merchandise of a particular description. R.S., ch. 63, sec. 4.

What shall
be deemed
to be trade-
marks.

5. All marks, names, labels, brands, packages or other business devices, which are adopted for use by any person in his trade, business, occupation or calling, for the purpose of distinguishing any manufacture, product or article of any description manufactured, produced, compounded, packed or offered for sale by him, applied in any manner whatever either to such manufacture, product or article, or to any package, parcel, case, box or other vessel or receptacle of any description whatsoever containing the same, shall, for the purposes of this Act, be considered and known as trade-marks. R.S., ch. 63, sec. 3.

As to timber
or lumber.

6. Timber or lumber of any kind upon which labour has been expended by any person in his trade, business, occupation or calling, shall, for the purposes of this Act, be deemed a manufacture, product or article. R.S., ch. 63, sec. 3.

Seal.

Seal and
its use.

7. The Minister may cause a seal to be made for the purposes of this Part, and may cause to be sealed therewith trade-marks and other instruments, and copies of such trade-marks and other instruments, proceeding from his office in relation to trade-marks. R.S., ch. 63, sec. 7.

Registration.

Register to
be kept.

8. A register shall be kept at the Department of Agriculture for the registration of trade-marks. R.S., ch. 63, sec. 5.

9. Subject to the provisions of this Act, the Minister shall on application duly made in that behalf, register therein the trade-mark of any proprietor applying for such registration in manner as provided by this Act in that behalf and by the rules and regulations made thereunder. R.S., ch. 63, secs. 5 and 8.

10. Every proprietor of a trade-mark who applies for its registration shall state in his application whether the said trade-mark is intended to be used as a general trade-mark or as a specific trade-mark. R.S., ch. 63, sec. 9.

11. The Minister may refuse to register any trade-mark,—

- (a) if he is not satisfied that the applicant is undoubtedly entitled to the exclusive use of such trade-mark;
- (b) if the trade-mark proposed for registration is identical with or resembles a trade-mark already registered;
- (c) if it appears that the trade-mark is calculated to deceive or mislead the public;
- (d) if the trade-mark contains any immorality or scandalous figure;
- (e) if the so-called trade-mark does not contain the essentials necessary to constitute a trade-mark, properly speaking. 54-55 V., ch. 35, sec. 1.

12. The Minister may in any case in the last preceding section mentioned, if he thinks fit, refer the matter to the Exchequer Court of Canada, and, in that event, such court shall have jurisdiction to hear and determine the matter, and to make an order determining whether and subject to what conditions, if any, registration is to be permitted. 54-55 V., ch. 35, sec. 1.

How registration may be effected.

13. Subject to the foregoing provisions, the proprietor of a trade-mark may, on forwarding to the Minister a drawing and description in duplicate of such trade-mark, and a declaration that the same was not in use to his knowledge by any other person than himself at the time of his adoption thereof, together with the fee required by this Act in that behalf, and on otherwise complying with the provisions of this Act in relation to trade-marks and with the rules and regulations made thereunder, have such trade-mark registered for his own exclusive use.

Exclusive right to trade-mark.

2. Thereafter such proprietor shall have the exclusive right to use the trade-mark to designate articles manufactured or sold by him. R.S., ch. 63, secs. 3, 5, 8 and 13.

Certificate of registration.

14. Upon any trade-mark being registered under this Act, the Minister shall return to the proprietor registering the same one copy of the drawing and description forwarded to him with a certificate signed by the Minister to the effect that the said trade-mark has been duly registered in accordance with the provisions of this Act; and the day, month and year of the entry of the trade-mark in the register shall also set forth in such certificate. R.S., ch. 63, sec. 13.

Assignment.

Trade-marks may be assigned.

15. Every trade-mark registered in the office of the Minister shall be assignable in law.

Entry.

2. On the assignment being produced, and the fee by this Act prescribed therefor being paid, the Minister shall cause the name of the assignee, with the date of the assignment and such other details as he sees fit, to be entered in the margin of the register of trade-marks on the folio where such trade-mark is registered. R.S., ch. 63, sec. 16.

Time Limit.

16. A general trade-mark once registered and destined to be the sign in trade of the proprietor thereof shall endure without limitation. Duration of general trade-mark.
R.S., ch. 63, sec. 14.

17. A specific trade-mark, when registered, shall endure for the term of twenty-five years, but may be renewed before the expiration of the said term by the proprietor thereof, or by his legal representative, for another term of twenty-five years, and so on from time to time; but every such renewal shall be registered before the expiration of the current term of twenty-five years. And of specific trade-mark.
R.S., ch. 63, sec. 14.

Cancellation.

18. Any person who has registered a trade-mark may petition for the cancellation of the same, and the Minister may, on receiving such petition, cause the said trade-mark to be so cancelled. Cancellation of trade-mark.

2. Such trade-mark shall, after such cancellation, be considered as if it had never been registered under the name of the said person. Effect of cancellation.
R.S., ch. 63, sec. 15.

Right of Action.

19. An action or suit may be maintained by any proprietor of a trade-mark against any person who uses the registered trade-mark of such proprietor, or any fraudulent imitation thereof, or who sells any article bearing such trade-mark or any such imitation thereof, or contained in any package of such proprietor or purporting to be his, contrary to the provisions of this Act. Suit by proprietor.
R.S., ch. 63, sec. 18.

No suit
unless trade-
mark is
registered.

20. No person shall institute any proceeding to prevent the infringement of any trade-mark, unless such trade-mark is registered in pursuance of this Act. R.S., ch. 63, sec. 19.

Offences and Penalties.

Unlawful use
of trade-
mark.

21. Every person other than the proprietor of any trade-mark who, with intent to deceive and to induce any person to believe that any article of any description whatsoever was manufactured, produced, compounded, packed or sold by the proprietor of such trade-mark,—

(a) marks any such article with any trade-mark registered under the provisions of this Act, or with any part of such trade-mark, whether by applying such trade-mark or any part thereof to the article itself or to any package or thing containing such article, or by using any package or thing so marked which has been used by the proprietor of such trade-mark; or,

(b) knowingly sells or offers for sale any such article marked with such trade-mark or with any part thereof;

Penalty.

is guilty of an indictable offence and liable for each offence to a fine not exceeding one hundred dollars and not less than twenty dollars.

To whom
payable.

2. Such fine shall be paid to the proprietor of such trade-mark together with the costs incurred in enforcing and recovering the same.

Suit by pro-
priator or his
agent.

3. Every complaint under this section shall be made by the proprietor of such trade-mark, or by some one acting on his behalf and thereunto duly authorized. R.S., ch. 63, sec. 17.

Warranty Upon Sale.

22. Upon the sale or in the contract for the sale of any goods to which a trade-mark, or mark, or trade description has been applied, the vendor shall, unless the contrary is expressed in some writing, signed by or on behalf of the vendor, and delivered at the time of the sale or contract to and accepted by the vendee, be deemed to warrant that the mark is a genuine trade-mark and not forged or falsely applied, or that the trade description is not a false trade description within the meaning of Part VII. of the Criminal Code. 51 V., ch. 41, sec. 18.

Warranty
that trade
mark is
genuine.

PART II.

INDUSTRIAL DESIGNS.

Registration.

23. The Minister shall cause to be kept a book to be called the Register of Industrial Designs for the registration therein of industrial designs. R.S., ch. 63, sec. 22.

Register of
to be kept.

24. The proprietor applying for the registration of any design shall deposit with the Minister a drawing and description in duplicate of the same, together with a declaration that the same was not in use to his knowledge by any other person than himself at the time of his adoption thereof. R.S., ch. 63, sec. 22.

Drawing and
description
to be de-
posited.

25. On receipt of the fee prescribed by this Act in that behalf, the Minister shall cause any design for which the proprietor has made application for registry to be examined to ascertain whether it resembles any other design already registered. R.S., ch. 63, sec. 22.

Examination
prior to
registration.

- Registration of design. 26. The Minister shall register the design if he finds that it is not identical with or does not so closely resemble any other design already registered as to be confounded therewith; and he shall return to the proprietor thereof one copy of the drawing and description with the certificate required by this Part: Provided that he may refuse, subject to appeal to the Governor in Council, to register such designs as do not appear to him to be within the provisions of this Part or any design which is contrary to public morality or order. R.S., ch. 63, secs. 22 and 27.
- Proviso.
- Certificate of Minister. 27. On the copy of the drawing and description returned to the person registering, a certificate shall be given signed by the Minister or the Deputy Minister of Agriculture to the effect that such design has been duly registered in accordance with the provisions of this Act.
- Particulars thereof. 2. Such certificate shall show the date of registration including the day, month and year of the entry thereof in the proper register, the name and address of the registered proprietor, the number of such design and the number or letter employed to denote or correspond to the registration.
- Certificate to be evidence of contents. 3. The said certificate, in the absence of proof to the contrary, shall be sufficient evidence of the design, of the originality of the design, of the name of the proprietor, of the person named as proprietor being proprietor, of the commencement and term of registry, and of compliance with the provisions of this Act. R.S., ch. 63, secs. 22 and 28.
- Who may register. 28. If the author of any design shall, for a good and valuable consideration, have executed the same for some other person, such other person shall alone be entitled to register it. R.S., ch. 63, sec. 25.

Exclusive Right.

29. An exclusive right for an industrial design may be acquired by registration of the same under this Part. R.S., ch. 63, sec. 29. Registration gives exclusive right

30. Such exclusive right shall be valid for the term of five years, but may be renewed, at or before the expiration of the said term of five years, for a further period of five years or less on payment of the fee in this Act prescribed for extension of time: Provided that the whole duration of the exclusive right shall not exceed ten years in all. R.S., ch. 63, sec. 29. Duration of right. Renewal. Proviso.

31. During the existence of such exclusive right, whether of the entire or partial use of such design, no person shall without the license in writing of the registered proprietor, or, if assigned, of his assignee, apply for the purposes of sale such design or a fraudulent imitation thereof to the ornamenting of any article of manufacture or other article to which an industrial design may be applied or attached, or publish, sell or expose for sale or use, any such article as aforesaid to which such design or fraudulent imitation thereof has been applied. R.S., ch. 63, sec. 31. Using design without leave. Unlawful.

Proprietorship.

32. The author of any design shall be considered the proprietor thereof unless he has executed the design for another person for a good or valuable consideration, in which case such other person shall be considered the proprietor. Who shall be deemed proprietor.

2. The right of such other person to the property shall only be co-extensive with the right which he has acquired. R.S., ch. 63, sec. 25. Acquired right.

Assignments.

Design to be assignable. 33. Every design shall be assignable in law, either as to the whole interest or any undivided part thereof, by an instrument in writing which shall be recorded in the office of the Minister on payment of the fees prescribed by this Act in that behalf.

Right to use design. 2. Every proprietor of a design may grant and convey an exclusive right to make, use and vend and to grant to others the right to make, use and vend such design within and throughout Canada or any part thereof for the unexpired term of its duration or any part thereof.

License. 3. Such exclusive grant and conveyance shall be called a license, and shall be recorded in like manner and time as assignments. R.S., ch. 63, sec. 30.

Protection of Design.

Conditions of registration. 34. In order that any design may be protected, it shall be registered before publication, and, after registration, the name of the proprietor shall appear upon the article to which his design applies by being marked, if the manufacture is a woven fabric, on one end thereof, together with the letters Rd., and, if the manufacture is of any other substance, with the letters Rd., and the year of registration at the edge or upon any convenient part thereof.

How mark shall be applied. 2. The mark may be put upon the manufacture by making it on the material itself, or by attaching thereto a label with the proper marks thereon. R.S., ch. 63, sec. 24.

Right of Action.

Suit by proprietor. 35. If any person applies or imitates any design for the purpose of sale, being aware that the proprietor of such design has not given his

consent to such application, an action may be maintained by the proprietor of such design, against such person for the damages such proprietor has sustained by reason of such application or imitation. R.S., ch. 63, sec. 35.

Offences and Penalties.

36. Every person who, in violation of the provisions of this Part, during the existence of the exclusive right acquired for any industrial design by the registration of the same under this Part, whether of the entire or partial use of such design, without the license in writing of the registered proprietor, or, if assigned, of his assignee,—

- (a) for the purposes of sale, applies or attaches such design or a fraudulent imitation thereof to the ornamenting of any article of manufacture or other article to which an industrial design may be applied or attached; or,
- (b) publishes, sells or exposes for sale or for use, any article of manufacture or other article to which an industrial design may be applied or attached and to which such design or fraudulent imitation thereof has been applied or attached;

shall forfeit a sum not exceeding one hundred and twenty dollars and not less than twenty dollars to the proprietor of the design so applied.

2. Such sum shall be recoverable with costs on summary conviction under Part XV. of the Criminal Code by the registered proprietor or assignee. R.S., ch. 63, sec. 31.

37. Every person who,—

Falsely representing an article as having a registered design.

- (a) places the word Registered or the letters Rd. upon any article for which no design has been registered under this Part or upon any article for the design of which the exclusive right has expired; or,
- (b) advertises for sale as a registered article any article for which no design has been registered or for the design of which the exclusive right has expired; or,
- (c) unlawfully sells, publishes or exposes for sale any article for which no design has been registered, or for the design of which the exclusive right has expired, and on which the word Registered or the letters Rd. have been placed, knowing the said article to have been fraudulently marked or the exclusive right to such design to have expired;

Penalty. shall for each offence be liable to a penalty not exceeding thirty dollars and not less than four dollars.

Recovery. 2. Such penalty shall be recoverable on summary conviction under Part XV. of the Criminal Code with costs by any person who sues for the same.

Application. 3. A moiety of such penalty shall belong to the prosecutor, and the other moiety to His Majesty for the public uses of Canada. R.S., ch. 63, sec. 32.

Limitation of Actions.

Time. 38. All suits under this Part and all proceedings thereunder for offences, shall be brought within twelve months from the cause of action or commission of the offence and not afterwards. R.S., ch. 63, sec. 36.

PART III.

GENERAL.

Rules, Regulations and Forms.

39. The Minister may, from time to time, subject to the approval of the Governor in Council, make rules and regulations and adopt forms for the purposes of this Act respecting trade-marks and industrial designs; and such rules, regulations and forms circulated in print for the use of the public shall be deemed to be correct for the purposes of this Act.

2. All documents executed according to the said rules, regulations and forms, and accepted by the Minister, shall be deemed to be valid so far as relates to official proceedings under this Act. R.S., ch. 63, secs. 6 and 23.

Clerical Errors.

40. Clerical errors which occur in the drawing up or copying of any instrument under this Act respecting trade-marks or industrial designs shall not be construed as invalidating the same, but, when discovered, may be corrected under the authority of the Minister. R.S., ch. 63, secs. 21 and 38.

Inspection.

41. Any person may be allowed to inspect the register of trade-marks or the register of industrial designs.

2. The Minister may cause copies of representations of trade-marks or copies of representations of industrial designs to be delivered on the applicant for the same paying the fee or fees prescribed by this Act in that behalf. R.S., ch. 63, secs. 20 and 37.

Procedure as to Rectification and Alteration.

Exchequer
Court may
rectify
entries.

42. The Exchequer Court of Canada may, on the information of the Attorney General, or at the suit of any person aggrieved by any omission, without sufficient cause, to make any entry in the register of trade-marks or in the register of industrial designs, or by any entry made without sufficient cause in any such register, make such order for making, expunging or varying any entry in any such register as the Court thinks fit; or the Court may refuse the application.

Costs.

2. In either case, the Court may make such order with respect to the costs of the proceedings as the Court thinks fit.

Questions
to be
decided.

3. The Court may in any proceedings under this section, decide any question that may be necessary or expedient to decide for the rectification of any such register. 54-55 V., ch. 35, sec. 1.

Trade-mark
or design
may be cor-
rected by
the court.

43. The registered proprietor of any registered trade-mark or industrial design may apply to the Exchequer Court of Canada for leave to add to or alter any such trade-mark or industrial design in any particular not being an essential particular, and the Court may refuse or grant leave on such terms as it may think fit.

Notice to
Minister.

2. Notice of any intended application to the Court under this section for leave to add to or alter any such trade-mark or industrial design shall be given to the Minister, and he shall be entitled to be heard on the application. 54-55 V., ch. 35, sec. 1.

Consequent
rectification
of register.

44. A certified copy of any order of the Court for the making, expunging or varying of any entry in the register of trade-marks or in the register of industrial designs, or for adding to or al-

tering any registered trade-mark or registered industrial design, shall be transmitted to the Minister by the Registrar of the Court, and such register shall thereupon be rectified or altered in conformity with such order, or the purport of the order otherwise duly entered therein, as the case may be. R.S., ch. 63, sec. 34; 54-55 V., ch. 35, sec. 1.

Evidence.

45. Every certificate under this Act that any trade-mark or industrial design has been duly registered in accordance with the provisions of this Act, which purports to be signed by the Minister or the Deputy Minister of Agriculture shall, without proof of the signature, be received in all courts in Canada as prima facie evidence of the facts therein alleged. R.S., ch. 63, secs. 13, 22 and 28.

No proof of signature of certificate required.

Fees.

46. The following shall be the fees in respect to registration under this Act which shall be paid to the Minister in advance, that is to say:—

Table of fees.

On every application to register a general trade-mark, including certificate	30 00
On every application to register a specific trade-mark, including certificate	25 00
On every application for the renewal of the registration of a specific trade-mark, including certificate	20 00
On every application to register a design, including certificate	5 00
On every application as to a design for an extension of time, for each	

year of such extension, including certificate	2 00
For copy of every certificate of registration separate from the return of the duplicate	1 00
For the recording of every assignment	2 00
For copies of documents not above mentioned, for every hundred words or for every fraction thereof	0 50
For each copy of any drawing or emblematic trade-mark, and for each copy of any drawn copy of an industrial design,—the reasonable expense of preparing the same.	
R.S., ch. 63, secs. 10 and 26.	

Payable to
Minister of
Finance.

47. All fees received by the Minister, under this Act, shall be paid over by him to the Minister of Finance. R.S., ch. 63, secs. 10 and 26.

Return of
fees if
application
is refused.

48. In case any trade-mark or industrial design in respect of which application for registry is made under this Act shall not be registered, all fees paid the Minister for registration shall be returned to the applicant or his agent, less, in the case of trade-marks, the sum of five dollars, and in the case of industrial designs, the sum of two dollars, which shall be retained as compensation for office expenses. R.S., ch. 63, secs. 10 and 26.

APPENDIX II.

TIMBER MARKING ACT.

CHAPTER 72.

An Act respecting the Marking of Timber.

SHORT TITLE.

1. This Act may be cited as the Timber short title.
Marking Act.

MARKS AND REGISTRATION.

2. Every person engaged in the business of Persons engaged in lumbering or the getting out of timber, and of lumbering to the floating or rafting of the same on the inland select, regis- waters of Canada, within the Provinces of On- ter and use tario, Quebec and New Brunswick, shall, within proper marks. one month after he engages therein, select a mark or marks, and cause such mark or marks to be registered in the manner herein provided. R.S., ch. 64, sec. 1. 7-8 Edward VII., ch. 72, sec. 1.

3. The Minister of Agriculture shall keep at Minister of the Department of Agriculture a book to be Agriculture called the Timber Mark Register, in which any to register person engaged in the business of lumbering or marks and getting out timber as aforesaid, may have his deliver cer- timber mark registered upon depositing with the tificates. Minister a drawing or impression and description in duplicate of such timber mark, together with a declaration that the same is not and was not in use, to his knowledge, by any person other than himself at the time of his adoption thereof.

2. The Minister, on receipt of the fee herein- On certain after provided, shall cause the said timber mark conditions. to be examined, to ascertain whether it resembles any other mark already registered; and, if he finds that such mark is not identical with, or

does not so closely resemble any other timber mark already closely registered as to be confounded therewith, he shall register the same, and shall return to the proprietor thereof one copy of the drawing and description, with a certificate signed by the Minister or the Deputy Minister of Agriculture, to the effect that the said mark has been duly registered in accordance with the provisions of this Act; and such certificate shall further set forth the day, month and year of the entry thereof, in the proper register; and every such certificate shall be received in all courts in Canada as evidence of the facts therein alleged, without proof of the signature. R.S., ch. 64, sec. 2.

Certificates shall be evidence.

4. The person who registers such timber mark shall thereafter have the exclusive right to use the same, to designate the timber got out by him and floated or rafted as aforesaid; and he shall put the same in a conspicuous place on each log or piece of timber so floated or rafted. R.S., ch. 64, secs. 1 and 3.

Exclusive right to use registered mark.

5. Any person who has registered a timber mark may petition for the cancellation of the same, and the Minister may, on receiving such petition, cause the said mark to be cancelled; and the same shall, after such cancellation, be considered as if it had never been registered under the name of said person. R.S., ch. 64, sec. 4.

Marks may be cancelled.

6. Every timber mark registered at the Department of Agriculture shall be assignable in law; and, on the production of the assignment and the payment of the fee hereinafter mentioned, the Minister shall cause the name of the assignee, with the date of the assignment, and such other details as he sees fit, to be entered on the

Registered marks assignable and how.

margin of the register of timber marks on the folio where such mark is registered. R.S., ch. 64, sec. 5.

7. If any person makes application to register, as his own, any timber mark which is already registered, the Minister shall give notice of the fact to such person, who may then select some other mark and forward the same for registration. R.S., ch. 64, sec. 6.

8. No person, other than the person who has registered the same, shall mark any timber of any description with any mark registered under the provisions of this Act, or with any part of such mark. R.S., ch. 64, sec. 7.

Fees.

9. The following fees shall be payable, that is to say:—

On every application to register a timber mark, including certificate	\$2 00
For each certificate of registration not already provided for	0 50
For each copy of any drawing, the reasonable expenses of preparing the same.	
For recording any assignment	1 00

2. Such fees shall be paid over by the Minister of Agriculture to the Minister of Finance, and shall form part of the Consolidated Revenue Fund of Canada. R.S., ch. 64, sec. 8.

10. The Minister may, from time to time, subject to the approval of the Governor in Council, make rules and regulations and adopt forms. R.S., ch. 64, sec. 9.

Offences and Penalties.

Failing to
select, regis-
ter and use
proper
marks by
lumberman,
etc.

Penalty.

11. Every person engaged in the business of lumbering or getting out timber, and floating or rafting the same on the inland waters of Canada, within the Provinces of Ontario, Quebec and New Brunswick, who fails, within one month after he engages therein, to select a mark or marks, and cause such mark or marks to be registered in the manner hereinbefore provided, or to put the same in a conspicuous place on each log or piece of timber so floated or rafted, shall incur a penalty of fifty dollars. R.S., ch. 64, sec. 1. 7-8 Edward VII., ch. 72, sec. 2.

Marking
timber with
a mark
registered
by another.

Penalty.

12. Every person, other than the person who has registered the same, who marks any timber of any description with any mark registered under the provisions of this Act, or with any part of such mark, shall, on summary conviction before two justices of the peace, be liable, for each offence, to a penalty not exceeding one hundred dollars and not less than twenty dollars, which amount shall be paid to the proprietor of such mark, together with the costs incurred in enforcing and recovering the same.

Who may
complain.

2. Every complaint of violation of this section shall be made by the proprietor of such timber mark, or by some one acting on his behalf and thereunto duly authorized. R.S., ch. 64, sec. 7.

APPENDIX III.**RULES AND FORMS**

Of the Department of Agriculture under the Trade-Mark and Design Act, and the Timber Marking Act. Approved by the Governor in Council, on the 25th day of October, 1907.

RULES.**I.**

There is no necessity for any personal appearance at the Department of Agriculture, unless specially called for by order of the Minister or the Deputy, every transaction being carried on by writing.

II.

In every case the applicant or depositor of any paper is responsible for the merits of his allegations and for the validity of the instruments furnished by him or his agent.

III.

The correspondence is carried on with the applicant or his agent, but with one person only, and will be conveyed through the Canadian mails free of charge.

IV.

All papers are to be clearly and neatly written on foolscap paper, and every word of them is to be distinctly legible.

Drawings are not to exceed thirteen inches in length and eight inches in width.

V.

An application for registration shall be signed by the applicant or by an agent duly authorized.

A partner may sign for a firm. A director or secretary or other principal officer of a company may sign for the company.

VI.

All communications to be addressed in the following words:—To the Minister of Agriculture, (Trade-Mark and Copyright Branch), Ottawa.

VII.

As regards proceedings not specially provided for in the following forms, any form being conformable to the letter and spirit of the law will be accepted, and if not so conformable will be returned for correction.

VIII.

A copy of the Act and Rules with a particular section marked, sent to any person making an inquiry, is intended as a respectful answer by the office.

IX.

Information as to subsisting registrations will not be furnished by the office, the registers and the indexes being open for inspection free of charge.

FORMS.

Form I.

DOMINION OF CANADA.

The Trade-Mark and Design Act.

Application for registration of a General-Trade Mark.
(To be made in duplicate.)

I, [or we] of the
of in the of
hereby request you to register in the name of
a General Trade-Mark, which I [or we] verily believe is
mine [or ours], on account of having been the first to make

APPENDIX IV.

FORMS.

ASSIGNMENT.

WHEREAS of trading as at hereinafter called the said adopted during the year a certain trade-mark as applied to which has been duly registered in accordance with the Trade-Mark and Design Act, at Folio of Register No. of the Register of Trade-Marks in the Department of Agriculture, for the Dominion of Canada.

WHEREAS is desirous of acquiring the entire right, title and interest in said trade-mark and the good will of the business in which said trade-mark is used.

NOW, THEREFORE, In consideration of the sum of one dollar and other valuable considerations, paid by the said to the said the said hereby sells, assigns, transfers and sets over unto the said all its right, title and interest in and to said Trade-Mark and in and to the good will of the business in which said Trade-Mark has been used the same to be held and enjoyed by the said his executors, administrators, successors and assigns, as fully and entirely as the said assigned interest could have been held and enjoyed by the said if this assignment and sale had not been made.

IN WITNESS WHEREOF, the said has this day of affixed his hand and seal at .

Witnesses: _____

(STATEMENT OF CLAIM.)

IN THE EXCHEQUER COURT OF CANADA.

Between:

John Smith,

Plaintiff,

and

Thomas Brown,

Defendant.

Statement of Claim.

Filed day of , A. D.

1. The plaintiff is a manufacturer of tubs, carrying on business in the City of Ottawa, in the Province of Ontario.

2. The defendant is a manufacturer of tubs carrying on business in the City of Ottawa, in the Province of Ontario.
3. The plaintiff is the owner of a trade-mark which consists of the word "Victor" and which has been used by him for many years past in connection with the manufacture and sale of tubs throughout the Dominion of Canada and elsewhere, and which has been duly registered at Folio 17864 of Register No. 67 of the Register of Trade-Marks, in the Department of Agriculture, in accordance with the Trade-Mark and Design Act.
4. The defendant has infringed the plaintiff's said trade-mark in the manner following; that is to say, he has marked tubs not manufactured by the plaintiff with said trade-mark and sold them throughout the Province of Ontario, and elsewhere.
5. The defendant has made considerable profit by the use of the said trade-mark in the manner aforesaid.
6. The plaintiff has sustained considerable damage from the defendant's wrongful acts aforesaid.
7. The plaintiff claims:
 - (1) An injunction to restrain the defendant, his servants and agents, from infringing the plaintiff's said trade-mark, and in particular from selling or offering for sale tubs as Victor Tubs, or marked with the word "Victor," or using the word "Victor" in connection with the sale or offering for sale of tubs not manufactured by the plaintiff.
 - (2) An order for delivery up to the plaintiff on oath of all tubs which are in the possession or power or under the control of the defendant, and offend against any injunction to be granted herein.
 - (3) Damages or an account of profits.
 - (4) Costs.
 - (5) Such other relief as the nature of the case may warrant and the Court shall deem just.

Of Counsel for the Plaintiff.

(STATEMENT OF DEFENCE.)

IN THE EXCHEQUER COURT OF CANADA.

Between:
John Smith, Plaintiff,
and
Thomas Brown, Defendant.

Statement of Defence.
Filed day of .

1. The defendant admits the allegations of paragraphs 1 and 2 of the Statement of Claim, but denies those contained in the remaining paragraphs thereof.
2. The plaintiff is not the owner of the said alleged trade-mark.
3. The alleged trade-mark does not contain the essentials necessary to constitute a trade-mark.
4. The alleged trade-mark is a mere descriptive word having reference to the character and quality of the goods to which it is applied.
5. The defendant has never used the said trade-mark in connection with the manufacture and sale of tubs.
6. The said alleged trade-mark, if originally a valid trade-mark, which is not admitted but denied has been abandoned by the defendant and is now publici juris.

Of Counsel for the Defendant.

(PETITION TO EXPUNGE AND REGISTER.)

(Copy of petition used in case.)

IN THE EXCHEQUER COURT OF CANADA.

Filed.

In the matter of the Petition of Bowker Fertilizer Company, a Corporation duly organized under the Laws of the State of New Jersey, located in the City, County and State of New York, U. S. A., manufacturers, and

In the matter of a Specific Trade-Mark to be used in connection with the manufacture and sale of fertilizers.

To the Honourable, the Judge of the Exchequer Court of Canada; the Petition of Bowker Fertilizer Company, of the City, County and State of New York, United States of America, sheweth:

1. That your petitioners, Bowker Fertilizer Company, are a corporation duly organized under the laws of the State of New Jersey, and located and doing business in the City of New York, in the County and State of New York, United States of America.

2. That your petitioners carry on the business of manufacturers of fertilizers and have a large and extensive business in Canada and the United States in connection with fertilizers.

3. That in connection with their said business, your petitioners adopted and put into use in or about the year 1887, a trade-mark which consists of the words "Sure Crop" used in connection with the manufacture and sale of fertilizers, which said Trade-Mark has been used continuously in Canada, United States and other countries to distinguish the goods of your petitioners.

4. That your petitioners made application for registration of the said Trade-Mark to the Minister of Agriculture of the Dominion of

Canada in accordance with the provisions of the Trade-Mark and Design Act and said application was refused by reason of the existence on the register of a prior registration of the words "Shur-Crop" in favour of Messrs. Gunns, Limited, of the City of Toronto, Province of Ontario, Canada, said Trade-Mark of Gunns, Limited, having been registered on July 27th, 1912, on Folio No. 17329 of Register No. 71 in the Register of Trade-Marks, in the Department of Agriculture of the Dominion of Canada.

5. That as a matter of fact your petitioners were the first to make use of the words "Sure Crop" as a trade-mark applied to the manufacture and sale of fertilizers.

6. That there is a possibility of confusion between the trade-mark registered by the said Gunns, Limited, and your petitioners' trade-mark, your petitioner is aggrieved by the registration of the said Trade-Mark by Gunns, Limited, and the said registration was made without sufficient cause.

7. That in connection with your petitioner's business the words "Sure Crop" have acquired a secondary and trade-mark meaning and distinguish the fertilizer manufactured by your petitioners.

8. Your petitioners therefore pray:

(a) That an order may be made directing that the said Trade-Mark registered in Folio No. 17329 of Register No. 71 of the Register of Trade-Marks, be expunged.

(b) That an order may be made directing that your petitioners' Trade-Mark consisting of the words "Sure Crop" may be registered as a Specific Trade-Mark to be used in connection with the manufacture and sale of fertilizers.

(c) Costs.

(d) Such further and other relief as the nature of the case may require and the Court shall deem just.

Dated at Ottawa, this 7th day of September, A. D. 1915.

(Sgd.) RUSSEL S. SMART,
Of Counsel for the Petitioners.

(SUMMONS FOR ORDER FOR PARTICULARS.)

(Copy from case.)

IN THE EXCHEQUER COURT OF CANADA.

Before the Hon. Mr. Justice Cassels. In Chambers.

In the matter of the Petition of The Autosales Gum and Chocolate Company to expunge from the Trade-Mark Register No. 23, two trade-marks registered at Folios Nos. 5352 and 5353 respectively in the name of the Faultless Chemical Company.

SUMMONS.

Let the petitioners, their attorneys or agent attend before the Judge of this Court in Chambers in the City of Ottawa, on the 21st

day of June, 1912, at the hour of ten thirty o'clock in the forenoon, or so soon thereafter as Chambers may be held to show cause why an order should not be made directing the plaintiffs to, within thirty days from the service of the order, give security on their behalf to answer costs of the Faultless Chemical Company in this action, and that all proceedings in the meantime be stayed.

And also to show cause why an order should not be made extending the time for delivery of a statement of defence of the Faultless Chemical Company for a period of ten days from the date of giving such security.

Upon this application will be read the affidavit of George M. Harsh, this day filed.

This summons is returnable on the 21st day of June, 1912, by special leave.

Dated at Ottawa, this 20th day of June, 1912.

W. G. P. CASSELS,
Judge of the Exchequer Court.

(ORDER FOR PARTICULARS.)

(Copy from case.)

IN THE EXCHEQUER COURT OF CANADA.

Before the Hon. Mr. Justice Cassels. In Chambers.

In the matter of the petition of the Autosales Gum and Chocolate Company, to expunge from the Trade-Mark Register, Number 23, two trade-marks registered at folios Numbers 5352 and 5353, respectively, in the name of the Faultless Chemical Company.

ORDER.

Upon the application of the Faultless Chemical Company for particulars, upon hearing read the summons issued herein on the 5th day of November, A. D. 1912, the affidavit of Russell Sutherland Smart filed, and upon hearing what was alleged by Counsel for the Petitioner and the Faultless Chemical Company,

I do order that the Petitioner do forthwith furnish:—

1. Particulars as to the time when and the places where the Petitioner commenced to carry on the manufacture and sale in the United States and Canada of chewing gum in the form of discs, which it advertises by means of the words "Violet Chips," "Mint Chips" and "The Gum That's Round," referred to in Paragraph 1 of the petition.

2. Particulars giving the names and addresses of the persons who are alleged to have purchased the machinery of the Faultless Chemical Company, referred to in Paragraph 5 of the petition.

3. Particulars giving the place where and the time when the machinery used by the Faultless Chemical Company is alleged to have been sold and removed from the premises of said company, as referred to in Paragraph 5 of the petition.

And I do further order that the time for delivery of statement of objection or defence by the Faultless Chemical Company be extended for a period of one week after the delivery by the Petitioner of the said particulars.

And I do further order that the costs of this application be costs in the cause.

Dated at Ottawa this 11th day of November, A. D. 1912.

W. G. P. CASSELS,
J. E. C.

(DEFENCE TO ACTION TO EXPUNGE.)

(Copied from case.)

IN THE EXCHEQUER COURT OF CANADA.

In the matter of the petition of Bowker Fertilizer Company, a Corporation duly organized under the laws of the State of New Jersey, located in the City, County and State of New York, U. S. A., manufacturers, and

In the matter of a Specific Trade-Mark to be used in connection with the manufacture and sale of fertilizers.

Statement of defence of the respondents, Gunns, Limited.

1. With the exception of Paragraph 4 the Respondents deny all the allegations contained in the petition.

2. The Respondents specifically deny that the Petitioners carry on the business of manufacture of fertilizers in Canada and that they have a large and extensive business in Canada in connection with fertilizers.

3. The Respondents further deny that in or about the year 1887 the Petitioner adopted and put in use a trade-mark which consists of the words "Sure Crop" used in connection with the manufacture and sale of fertilizers, which said trade-mark has been used continuously in Canada or elsewhere to distinguish the goods of the Petitioners.

4. The Respondents further deny that the Petitioners were the first to make use of the words "Sure Crop" as a trade-mark applied to the manufacture and sale of fertilizers.

5. The Respondents further deny that there is any possibility of confusion between the trade-mark registered by them and the alleged trade-mark of the Petitioners or that the Petitioners are aggrieved by the registration by the Respondents of their said trade-mark or that such registration was made without sufficient cause.

6. The Respondents further deny that in connection with the Petitioners' business the words "Sure Crop" have acquired a secondary and trade-mark meaning and distinguish the fertilizer manufactured by the Petitioners.

7. The Respondents say that under and pursuant to The Trade-Mark and Design Act, and on the 27th day of July, 1912, the trade-

mark (specific) to be applied to the sale of all classes of fertilizers and which consists of a boy pressing the muzzle of a gun against a target in which appear the words "never misses," above the design being the name "Shur-Crop" as per the pattern and application was registered in the Trade-Mark Register No. 71, Folio 17329, by the Respondents and the Respondents crave leave to refer on the trial of the petition to such registration, to the certificate thereof and to said pattern and application.

8. The Respondents further say that they have continuously used the said specific trade-mark since the registration thereof.

9. The Respondents further say that the Petitioners who are foreigners have until recently made no objection whatever to the use of said specific trade-mark and that they are now seeking to take advantage of the business in connection with fertilizers established by the Respondents.

10. The Respondents further say that the Petitioners are not persons aggrieved by the entry or registration of the Respondents' trade-mark within the meaning of the Trade-Mark and Design Act and are not entitled to the relief asked for in their prayer.

11. The Respondents further say that the Petitioners have made no case for the relief asked for and that the said petition is bad in law and that the Petitioners have no status in this court.

12. The Respondents further say that the words "Sure Crop" are not capable of being registered as a specific trade-mark as claimed by the Petitioners and that the Petitioners are not entitled to the registration thereof and that they have made out no case for the order asked for by them directing such alleged trade-mark to be registered.

13. The Respondents submit that the said petition should be dismissed with costs.

Dated at Toronto this 26th day of October, 1915.

W. M. DOUGLAS,
Counsel for Respondents, Gunns, Limited.

(SUMMONS TO FIX TRIAL.)

(Copied from case.)

IN THE EXCHEQUER COURT OF CANADA.

Before the Honourable Mr. Justice Cassels. In Chambers.

In the matter of the petition of Bowker Fertilizer Company, a Corporation duly organized under the laws of the State of New Jersey, located in the City, County and State of New York, U. S. A., manufacturers, and

In the matter of a Specific Trade-Mark to be used in connection with the manufacture and sale of fertilizers, and
Gunns, Limited, objecting party.

SUMMONS TO FIX TRIAL, ETC.

Let the objecting party, Gunns, Limited, its attorney or agent attend before the Judge at Chambers in the City of Ottawa, on the 17th day of March, at eleven o'clock in the forenoon, or as soon thereafter as Chambers may be held, to show why the trial in this action should not be fixed to take place in the City of Ottawa, Province of Ontario, on the seventeenth day of April, A. D. 1916, or at such other time and place as to the said Judge may seem best; and why the said Judge should not also direct when and in what manner and upon whom notice of trial or hearing, together with a copy of the order to be made by the said Judge, is to be served.

Dated at Ottawa this 14th day of March, A. D. 1916.

W. G. P. CASSELS,
J. E. C.

(ORDER FIXING TRIAL.)

(Copied order made in case.)

IN THE EXCHEQUER COURT OF CANADA.

Before the Honourable Mr. Justice Cassels. In Chambers.

In the matter of the petition of Bowker Fertilizer Company, a Corporation organized under the laws of the State of New Jersey, located in the City, County and State of New York, U. S. A., manufacturers, and

In the matter of a Specific Trade-Mark to be used in connection with the manufacture and sale of fertilizers, and
Gunns' Limited, objecting party.

ORDER FOR FIXING TRIAL, ETC.

Upon reading the Summons granted herein and upon hearing counsel for the Petitioner, and upon hearing read a letter from the solicitor for the objecting party consenting thereto.

I do order that the trial or hearing in this matter do take place before this Court at the Supreme Court Building in the City of Ottawa on the seventeenth day of April, A. D. 1916, at eleven o'clock in the forenoon;

And I do further order that notice of trial at the time and place aforesaid, together with a copy of this order be within five days from the date hereof served upon the solicitor for the objecting party. This order to be without prejudice to any application that may be made to the presiding judge at the trial of this matter by any of the parties hereto to have part of the evidence taken or the matter determined at some other place than that hereinbefore appointed, under provisions of the Statute in that behalf.

Dated at Ottawa this 17th day of March, A. D. 1916.

W. G. P. CASSELS,
J. E. C.

JUDGMENT IN ACTION FOR INFRINGEMENT.

(Copied from Action.)

IN THE EXCHEQUER COURT OF CANADA.

Before the Hon. Mr. Justice Cassels.

Tuesday, 28th May, A. D. 1912.

Between

Fruitatives, Ltd.,

Plaintiffs,

and

La Compagnie Pharmaceute que de La Croix Rouge, Ltd.,
Defendants.

This matter having come for trial at the City of Ottawa, County of Carleton on the 3rd day of May, A. D. 1912, before this Court in the presence of Counsel as well for the Plaintiffs as for the Defendants whereupon, upon hearing read the pleadings herein and upon hearing the evidence adduced at trial and what was alleged by counsel aforesaid this Court was pleased to direct that this action should stand over for judgment and the same coming on this day for judgment.

This Court doth order and adjudge that Defendants above named, their servants and agents, he and they are hereby restrained from infringing upon the registered Specific Trade-Mark of Plaintiffs as set out in pleadings in this action by the use of a rectangular carton covered with a four-part lithographed label on which the chief word is "Fruit-i-nol" with the word "Tablet" underneath and a sub-title "Fruit Liver Regulator," and said label being coloured like the Plaintiffs' label and having fruit designs on it similar to those upon the Plaintiffs' label and being the carton produced and marked upon the trial of this action as Plaintiffs' Exhibit No. 6 or the use of any similar imitation of the Plaintiffs' said Specific Trade-Mark.

And this Court doth further order and adjudge that the defendants do deliver up to the Registrar of this Court all of the said cartons which are in their possession at the date of this judgment and that for the purpose of ascertaining the identity and quantity of such cartons such enquiries be had as the Registrar of this Court may deem necessary.

And this Court doth further order and adjudge that the defendants do pay to the Plaintiffs the costs of this action including their costs of the examinations for discovery forthwith after the taxation thereof.

And this Court doth order and adjudge with prejudice of any further proceedings therefor that the Plaintiffs are not entitled in this action to have the defendants' Specific Trade-Mark consisting of the word "Fruit-i-nol" expunged from the Register of Trade-Marks.

By the Court,

(Sgd.) CHAS. MORSE,

Registrar.

APPENDIX V.

THIRD SCHEDULE OF BRITISH ACT OF 1905. CLASSIFICATION OF GOODS.

Illustrations.

Note.—Goods are mentioned in this column by way of illustration, and not as an exhaustive list of the contents of a class.

<p>Class 1.</p> <p>Chemical substances used in manufactures, photography, or philosophical research, and anti-corrosives.</p>	<p>Such as—</p> <p>Acids, including vegetable acids.</p> <p>Alkalis.</p> <p>Artists' colours.</p> <p>Pigments.</p> <p>Mineral dyes.</p>
<p>Class 2.</p> <p>Chemical substances used for agricultural, horticultural, veterinary, and sanitary purposes.</p>	<p>Such as—</p> <p>Artificial manure.</p> <p>Cattle medicines.</p> <p>Deodorisers.</p> <p>Vermin destroyers.</p>
<p>Class 3.</p> <p>Chemical substances prepared for use in medicine and pharmacy.</p>	<p>Such as—</p> <p>Cod liver oil.</p> <p>Medicated articles.</p> <p>Patent medicines.</p> <p>Plasters.</p> <p>Rhubarb.</p>
<p>Class 4.</p> <p>Raw or partly prepared vegetable, animal, and mineral substances used in manufactures, not included in other classes.</p>	<p>Such as—</p> <p>Resins.</p> <p>Oils used in manufactures and not included in other classes.</p> <p>Dyes, other than mineral.</p> <p>Tanning substances.</p> <p>Fibrous substances (e. g., cotton, hemp, flax, jute).</p>

Wool.
Silk.
Bristles.
Hair.
Feathers.
Cork.
Seeds.
Coal.
Coke.
Bone.
Sponge.

Class 5.

Unwrought and partly wrought
metals used in manufacture.

Such as—

Iron and steel, pig or cast.
Iron, rough.
“ bar and rail, including
rails for railways.
“ bolt and rod.
“ sheet, and boiler and
armour plates.
“ hoop.
Lead, pig.
“ rolled.
“ sheet.
Wire.
Copper.
Zinc.
Gold, in ingots.

Class 6.

Machinery of all kinds, and parts
of machinery, except agricul-
tural and horticultural machines
included in Class 7.

Such as—

Steam engines.
Boilers.
Pneumatic machines.
Hydraulic machines.
Locomotives.
Sewing machines.
Weighing machines.
Machine tools.
Mining machinery.
Fire engines.

Class 7.

Agricultural and horticultural ma-
chinery, and parts of such ma-
chinery.

Such as—

Ploughs.
Drilling machines.
Reaping machines.

Thrashing machines.
Churns.
Cyder presses.
Chaff cutters.

Class 8.

Philosophical instruments, scientific instruments, and apparatus for useful purposes. Instruments and apparatus for teaching.

Such as—
Mathematical instruments.
Gauges.
Logs.
Spectacles.
Educational appliances.

Class 9.

Musical instruments.

Class 10.

Horological instruments.

Class 11.

Instruments, apparatus, and contrivances, not medicated, for surgical or curative purposes, or in relation to the health of men or animals.

Such as—
Bandages.
Friction gloves.
Lancets.
Fleams.
Enemas.

Class 12.

Cutlery and edge tools.

Such as—
Knives.
Forks.
Scissors.
Shears.
Files.
Saws.

Class 13.

Metal goods not included in other classes.

Such as—
Anvils.
Keys.
Basins (metal).
Needles.
Hoes.
Shovels.
Corkscrews.

Class 14.

Goods of precious metals (including aluminium, nickel, Britannia metal, &c.) and jewellery, and imitations of such goods and jewellery.

Such as—

Plate.
 Clock cases and pencil cases of such metals.
 Sheffield and other plated goods.
 Gilt and ormolu work.

Class 15.

Glass.

Such as—

Window and plate glass.
 Painted glass.
 Glass mosaic.
 Glass beads.

Class 16.

Porcelain and earthenware.

Such as—

China.
 Stoneware.
 Terra Cotta.
 Statuary porcelain.
 Tiles.
 Bricks.

Class 17.

Manufactures from mineral and other substances for building or decoration.

Such as—

Cement.
 Plaster.
 Imitation marble.
 Asphalt.

Class 18.

Engineering, architectural, and building contrivances.

Such as—

Diving apparatus.
 Warming apparatus.
 Ventilating apparatus.
 Filtering apparatus.
 Lighting contrivances.
 Drainage contrivances.
 Electric and pneumatic bells.

Class 19.

Arms, ammunition, and stores not included in Class 20.

Such as—

Cannon.
 Small-arms.
 Fowling pieces.

- Swords.
Shot and other projectiles.
Camp equipage.
Equipments.
- Class 20.
Explosive substances.
- Such as—
Gunpowder.
Guncotton.
Dynamite.
Fog-signals.
Percussion caps.
Fireworks.
Cartridges.
- Class 21.
Naval architectural contrivances
and naval equipments not in-
cluded in Classes 19 and 20.
- Such as—
Boats.
Anchors.
Chain cables.
Rigging.
- Class 22.
Carriages.
- Such as—
Railway carriages.
Waggons.
Railway trucks.
Bicycles.
Bath chairs.
- Class 23.
(a) Cotton yarn.
(b) Sewing cotton.
- Class 24.
Cotton piece goods of all kinds.
- Such as—
Cotton shirtings.
Long cloth.
- Class 25.
Cotton goods not included in
Classes 23, 24, or 38.
- Such as—
Cotton lace.
Cotton braids.
Cotton tapes.

Class 26.

Linen and hemp yarn and thread.

Class 27.

Linen and hemp piece goods.

Class 28.

Linen and hemp goods not included in Classes 26, 27 and 50.

Class 29.

Jute yarns and tissues, and other articles made of jute, not included in Class 50.

Class 30.

Silk, spun, thrown, or sewing.

Class 31.

Silk piece goods.

Class 32.

Other silk goods not included in Classes 30 and 31.

Class 33.

Yarns or wool, worsted, or hair.

Class 34.

Cloths and stuffs of wool, worsted, or hair.

Class 35.

Woollen and worsted and hair goods not included in Classes 33 and 34.

Class 36.

Carpets, floor-cloth, and oil-cloth.

Such as—

Drugget.
Mats and matting.
Rugs.

Class 37.

Leather, skins unwrought and wrought, and articles made of

Such as—
Saddlery.

- leather not included in other classes.
- Harness.
Whips.
Portmanteaus.
Furs.
- Class 38.
Articles of clothing.
- Such as—
Hats of all kinds.
Caps and bonnets.
Hosiery.
Gloves.
Boots and shoes.
Other ready-made clothing.
- Class 39.
Paper (except paperhangings), stationery, and bookbinding.
- Such as—
Envelopes.
Sealing wax.
Pens (except gold).
Ink.
Playing cards.
Blotting cases.
Copying presses.
- Class 40.
Goods manufactured from india-rubber and gutta-percha not included in other classes.
- Class 41.
Furniture and upholstery.
- Such as—
Paper hangings.
Papier mache.
Mirrors.
Mattresses.
- Class 42.
Substances used as food, or as ingredients in food.
- Such as—
Cereals.
Pulses.
Olive oil.
Hops.
Malt.
Dried fruits.
Tea.
Sago.

Salt.
 Sugar.
 Preserved meats.
 Confectionery.
 Oil cakes.
 Pickles.
 Vinegar.
 Beer clarifiers.

Class 43.

Fermented liquors and spirits.

Such as—
 Beer.
 Cyder.
 Wine.
 Whiskey.
 Liqueurs.

Class 44.

Mineral and aerated waters, natural and artificial, including ginger beer.

Class 45.

Tobacco, whether manufactured or unmanufactured.

Class 46.

Seeds for agricultural and horticultural purposes.

Class 47.

Candles, common soap, detergents; illuminating, heating, or lubricating oils; matches, and starch, blue, and other preparations for laundry purposes.

Such as—
 Washing powders.
 Benzine collas.

Class 48.

Perfumery (including toilet articles, preparations for the teeth and hair, and perfumed soap).

Class 49.

Games of all kinds and sporting articles not included in other classes.

Such as—
 Billiard tables.
 Roller skates.
 Fishing nets and lines.
 Toys.

Class 50.

Miscellaneous—

Such as—

- (1.) Goods manufactured from ivory, bone or wood, not included in other classes.
- (2.) Goods manufactured from straw or grass, not included in other classes.
- (3.) Goods manufactured from animal and vegetable substances, not included in other classes.
- (4.) Tobacco pipes.
- (5.) Umbrellas, walking sticks, brushes and combs.
- (6.) Furniture cream, plate powder.
- (7.) Tarpaulins, tents, rick-cloths, rope, twine.
- (8.) Buttons of all kinds other than precious metal or imitations thereof.
- (9.) Packing and hose of all kinds.
- (10.) Goods not included in the foregoing classes.

Coopers' wares.

Dated this 24th day of March, 1906.

(Sd.) D. LLOYD-GEORGE,
President of the Board of Trade.



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