

EXCHEQUER COURT OF CANADA

BETWEEN:

THE C. TURNBULL COMPANY } PETITIONER;
LIMITED

AND

DOMINION WOOLLENS AND WOR- } RESPONDENTS.
STEDS, LIMITED, ET AL.....

Trade-Mark—Expunging—Calculated to deceive—Prior adoption—General similarity

The petitioner, long prior to the registration of respondents' mark, adopted for use a specific trade-mark consisting of the representation of a ram, across the centre of which appears the word "Ceetee," with under the word "Ceetee" the words "Pure Wool" and over the word "Ceetee" the words "Guaranteed Unshrinkable" and under the ram the phrase "Established 1859," as applied to woollen goods of all kinds. The respondents had registered a specific trade-mark consisting of the representation of a sheep arranged in front of the representation of radiating rays of light arranged under a rectangular figure, together with the name Dominion cutting through the rectangular figure and the words Woollens & Worsteds Limited flanked on either side, as applied to woollens, worsteds, knitted goods and

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wearing apparel. The Court found that the petitioner adopted its trade-mark some time previous to the adoption by the respondents of their mark and the registration thereof, and held:

1. That inasmuch as the most conspicuous part of the two trade-marks and that which caught the eye, was the ram which was similar in general shape and appearance, the respondents' trade-mark was calculated to deceive and was registered without sufficient cause and should be expunged.
2. Where two persons apply for registration of their marks and such registration is refused by reason of other similar marks being on the register, and where subsequently, without notice to the other, one of said marks was registered, upon petition to the Court by the other person for the registration of its mark and for expunging the other marks cited against it, the Court is in the same position as the Commissioner of Patents and should deal with the same as if there were two co-pending applications for registration before it, and must decide whether both should be registered or, if only one, which one.
3. That there is nothing in the law prohibiting a party from adopting a particular representation of a sheep in connection with other designs for use as a trade-mark and that the same may be registered as such.

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PETITION of petitioner herein to have its trade-mark registered and respondents' trade-mark, among others, expunged from the Register of Trade-Marks. Contestation was joined between The C. Turnbull Company Limited and the Dominion Woollens and Worsteds Limited, only.

The petition was heard before the Honourable Mr. Justice Angers, at Ottawa.

W. L. Scott, K.C., for the petitioner.

A. J. Thomson, K.C., for the respondents.

The facts of the case and points of law raised are stated in the reasons for judgment.

ANGERS J., now (August 27, 1932), delivered the following judgment.

The petitioner is a manufacturer of woollen goods and underclothing, carrying on business at the city of Galt, in province of Ontario.

The name of the company was originally The C. Turnbull Company of Galt Limited. In December, 1930, The C. Turnbull Company of Galt, Limited, sold and transferred to The C. Turnbull Company, Limited, the present company and petitioner herein, all its assets, including present and future trade-marks, trade names and trade designs: see exhibit 12.

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The new company being the successor of the old one, for brevity's sake, I shall refer to either of them as the petitioner.

By its petition, the C. Turnbull Company, Limited, asks:

1. that its trade-mark consisting of the representation of a ram across the centre of which appears the word *Ceetee*, with the words *guaranteed unshrinkable* over the word *Ceetee* and the words *pure wool* under the word *Ceetee* and, under the representation of the ram, the words *established 1859*, be ordered to be registered as a specific trade-mark for woollen goods of all kinds;

2. That the entry in the Register of Trade-Marks, Register number 50, folio 12122, of the trade-mark of Morgans (Hereford) Limited, a conspicuous portion of which is a sheep, be expunged;

3. That the entry in the Register of Trade-Marks, Register number 209, folio 45736, of the trade-mark of L. W. Caldwell & Company, Limited, a conspicuous portion of which is a ram, be expunged;

4. That the entry in the Register of Trade-Marks, Register number 242, folio 52237, of the trade-mark of Dominion Woollens & Worsteds Limited, a conspicuous portion of which is the representation of a sheep, be expunged.

The trade-mark of the respondent, Dominion Woollens & Worsteds Limited, is described as consisting of the representation of a sheep (in fact a ram) arranged in front of the representation of radiating rays of light arranged upon a rectangular figure together with the name *Dominion* cutting through the rectangular figure and the words *Woollens & Worsteds Ltd.* flanked on either side.

The petition, together with a notice of its filing, was duly served upon L. W. Caldwell & Company, Limited, and Dominion Woollens & Worsteds, Limited; it was not served upon Morgans (Hereford) Limited, which, as the proof shows, is no longer in existence. I shall deal with the demand for expunging the Morgans (Hereford) Limited's trade-mark later.

A notice of the filing of the petition was duly published in the issues of the *Canada Gazette* of the 17th, 24th and 31st of October and 7th of November, 1931, as appears from the affidavit of publication filed herein.

L. W. Caldwell & Company Limited, through its solicitors, consented to judgment being given directing that the entry of its trade-mark in the Register of Trade-Marks, register number 209, at folio 45736, should be expunged: see exhibit 2.

The respondent Dominion Woollens & Worsteds Limited alone contested the petition.

In its statement of defence, Dominion Woollens & Worsteds, Limited, avers that it does not oppose the registration of the petitioner's trade-mark, but that it does oppose the demand to expunge from the register its own trade-mark. It admits that the word Ceetee used in conjunction with the representation of a ram is understood by the public and the trade to indicate goods manufactured by the petitioner, but it denies that the representation of a ram without the word Ceetee is so understood. Respondent adds that, before and after the adoption by petitioner of its trade-mark, the representation of a sheep has been commonly used by manufacturers of woollen goods and that such representation is not by itself the proper subject of a trade-mark, because it is descriptive of the goods to which it is applied. Respondent further alleges that the representation of a sheep constitutes part of the trade-marks set out in the particulars delivered with the Statement of Defence and of a large number of other trade-marks for woollen goods registered and unregistered which are in use in Canada and elsewhere. Respondent goes on to say that its trade-mark is a valid one and denies that its use constitutes an infringement of the petitioner's trade-mark. The respondent accordingly submits that the petition should be dismissed as far as it is concerned, with costs.

On the 10th of April, 1931, the petitioner filed an application for the registration of its above described trade-mark with the Commissioner of Patents. The Commissioner acknowledged receipt of this application, of the drawing attached thereto and of the registration fee on the 13th of April, 1931.

On the 28th of April, 1931, the Commissioner wrote to petitioner notifying it that Morgans (Hereford) Limited, of Hereford, England, had a trade-mark consisting of a device of a sheep standing on grass with the words *Wyeland selected wool* printed across its body, registered in connec-

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tion with cloths and stuffs of wool and articles of clothing made therefrom, since the 16th of July, 1907, and that L. W. Caldwell & Company, Limited, of Calgary, Alberta, had a trade-mark consisting of the representation of a shield on which appears a ram, registered in connection with textiles and textile products, since the 20th of February, 1929, and that the petitioner's application appeared to be in conflict with the registrations cited and must be refused.

On the 4th of April, 1931, the respondent filed an application for the registration of its above described trade-mark with the Commissioner of Patents. The latter acknowledged receipt of this application, together with the drawing and the registration fee accompanying it, on the 9th of April, 1931.

On the 28th of April, 1931, the same day on which he advised the petitioner that its application was refused, the Commissioner wrote to the respondent, referring to the same trade-marks as in his letter to the petitioner, namely those of Morgans (Hereford) Limited and of L. W. Caldwell & Company, Limited, and notifying it that its application was in conflict with the said trade-marks and must be refused.

The respondent was more insistent; it asked for the reconsideration of the Commissioner's decision and, after some correspondence, forming part of the Patent and Copyright Office file, which was produced as exhibit 9, it finally succeeded in having its trade-mark registered. The registration is dated the 19th of May, 1931.

I must say that I am at a loss to understand why the respondent's application should have been accepted and the petitioner's application refused. As Counsel for respondent put it:

possibly we were not so easily satisfied as my friend, and pursued the Registrar a little further and got him to change his original ruling, while my friend's clients were not persistent enough.

If Caldwell's and Morgan's registrations were in the way of the petitioner's mark, surely they were to the same extent in the way of the respondent's mark. However since L. W. Caldwell & Company Limited has consented to the expunging from the register of its trade-mark and since, for the reasons hereinafter set out, I am inclined to grant the demand for the expunging of Morgans (Hereford) Lim-

ited's trade-mark, I am not particularly interested in the reasons which induced the Commissioner to grant one trade-mark and refuse the other. I have cited these facts solely for the purpose of explaining why, in my opinion, I should deal with the matter as if I had before me two co-pending applications for the registration of trade-marks, and I had to decide whether both should be registered or, in the event of there being a conflict, adjudge which of the two ought to have priority and be allowed to go on the register.

The respondent's trade-mark and the petitioner's trade-mark, as covered by the application exhibit 8, are both very broad: they cover practically any kind of woollen articles.

The application of the petitioner states that the trade-mark which it seeks to register is to be used in connection with the sale of *woollen goods of all kinds*. The respondent's trade-mark is to be applied to the sale of *woollens, worsteds, knitted goods* and wearing apparel.

The petitioner has almost exclusively, at least during the last fifteen years or so, restricted its production to underwear; the respondent, on the other hand, has only manufactured outerwear. Admissions were filed in the record as exhibit 4, reading as follows:

The following facts are hereby admitted:

1. Neither the first trade-mark of the petitioner, consisting of the word "Ceetee" alone, nor the present trade-mark consisting of the representation of a ram bearing the word "Ceetee" has ever been applied by the petitioner to knitted outerwear.

2. Up to about the year 1917 The C. Turnbull Company of Galt Limited manufactured and sold certain classes of knitted outerwear, namely jerseys and sweater coats, and during the years 1927, 1928 and 1929 such Company sold sweater coats which it purchased from other manufacturers. None of such jerseys and sweater coats were sold under the trade-mark referred to in paragraph 5 of the petition, but were in all cases sold under the mark "Turnbull's."

3. Neither Dominion Woollens and Worsteds Limited nor any Company whose assets or shares it acquired ever manufactured knitted underwear. In one of the factories now owned by Dominion Woollens and Worsteds Limited there are a few machines which could be used, but have not been used, for the manufacture of knitted underwear.

The evidence discloses the following facts.

From 1900 to 1908 The C. Turnbull Company of Galt, Limited, used the mark Ceetee, without the ram, on all its woollen underwear. Since 1908 the company has made use of its present trade-mark consisting of the representation of a ram, across the centre of which appears the word

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Ceetee, with under the word *Ceetee* the words *pure wool* and over it the words *guaranteed unshrinkable*.

Approximately 95 per cent of its woollen underwear has, since 1908, been sold under the said trade-mark: see deposition Norwood.

Underwear with the mark above described has been extensively advertised throughout Canada since 1908, in newspapers, magazines, farm papers and other publications, as shown particularly by exhibits 13 and 18. From 1907 to 1931 inclusively, the petitioner spent \$357,640.66 on advertising; during the same period, sales amounted to \$18,175,069.72; these figures are taken from the summary of sales and advertising expenditures prepared by the company's auditors, filed as exhibit 13. I may note here that the parties agreed that proof with respect to sales and advertisements could be made by the production of certificates purporting to be signed by the respective auditors of the parties: see agreement exhibit 3. Approximately two-thirds of the goods mentioned in the Auditors' report (exhibit 13) bore the trade-mark (deposition Auld).

The evidence further shows that the goods manufactured by the petitioner are of a very high quality: McGiffin, who has been in the haberdashery business in Ottawa, as a retailer for 45 years and has handled the petitioner's underwear for the last 20 years, says that people who are looking for high grade underwear ask for the petitioner's goods; two witnesses, Norwood, a haberdasher of Toronto, and Holbrook, a retired haberdasher of Ottawa, both of whom are well acquainted with the petitioner's merchandise for having sold it for years, stated that it is the best made in Canada and equal to any British make. This is undoubtedly an excellent recommendation.

The petitioner's goods are sold extensively all over Canada. According to the evidence, some customers will ask for *Ceetee* underwear and others for the underwear with the sheep on it (depositions Cooper, Holbrook and McGiffin).

Dominion Woollens and Worsteds Limited, the respondent, has applied its trade-mark to woollen outerwear, as men's, women's and children's sweaters, pullovers and coats, mitts, cloths and yarns. From the first of May, 1931, to the second of April, 1932, sales aggregated \$2,258,038.64; during the same period, \$3,811.63 was spent on advertis-

ing (deposition Whitten). Whitten, secretary-treasurer of the respondent, stated that his company sells very little to retailers; the bulk of its sales is to wholesalers, jobbers and large departmental stores (same deposition). I must say that it seems to me quite indifferent that the respondent's goods be sold to the retailers direct or through intermediaries.

Considering the long prior use by the petitioner of its trade mark, I think that, in the event of a conflict between the applications of the petitioner and of the respondent, precedence should have been given to the petitioner's application: Kerly on Trade-Marks, 6th edition, p. 205, where he says:

Where any marks already in use are trade-marks, whether registered or unregistered, it is clear that they are obstacles to the registration of any mark which so closely resembles them as to be calculated to deceive, unless the applicant has an independent trade-mark right in the mark he puts forward. This is expressly enacted by section 19 in regard to registered trade-marks; and it follows, in the case of unregistered trade-marks, from the prohibition placed by section 11 upon the registration of any matter, the use of which, by reason of its being calculated to deceive or otherwise, would be deemed disentitled to protection in a Court of Justice.

I am convinced that if all the facts had been put before the Commissioner of Patents, he would have given precedence to the petitioner's application and allowed its mark to go on the register. I have no hesitation in saying that this is what I would have done. I may add that had there been any objection on the part of the respondent to the registration of the petitioner's trade-mark I would have felt bound to overrule it. However, as I have already remarked, the respondent says it has no objection to the registration of the petitioner's trade-mark and that settles the matter as far as this question is concerned.

I shall therefore direct the Commissioner of Patents to register the petitioner's trade-mark, in accordance with the provisions of the Trade-Mark and Design Act, as a specific trade-mark for woollen goods of all kinds.

There remains for me to examine the question as to whether I should grant the petitioner's demand for the expunging of the respondent's trade-mark from the register. To this end I must determine if the respondent's trade-mark is identical with the petitioner's trade-mark or so resembles it as to be calculated to deceive or mislead the public.

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The respondent naturally denies the similarity or resemblance and says that there is no likelihood of deception or confusion. The respondent further says that the sheep, or, in fact, any other animal, is descriptive and besides *publici juris* and therefore cannot constitute the feature or at least the main feature of a trade-mark.

Under Section 11 of the Trade-Mark and Design Act (R.S.C., 1927, ch. 201), 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 the 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.

Section 45 of the Act says that the Exchequer Court may, at the suit of any person aggrieved by an entry made without sufficient cause in the register of trade-marks, make such order for expunging or varying it as the court may think fit.

There is obviously much similarity between the rams of the two marks; a mere glance at the drawings is sufficient to notice it. Both animals are represented standing, side-wise, with their heads pointing to the left of the picture. There is a very slight difference, hardly noticeable to the casual observer, in the position of the heads. The petitioner's ram is looking straight ahead, whereas the respondent's ram's head is slightly turned to the left. The petitioner's ram, as already mentioned, bears in the centre the word *Ceetee*, above which appear the words *guaranteed unshrinkable* and below the words *pure wool*; the respondent's ram bears no inscription; around it however appear, in triangular form, the name *Dominion Woollens & Worstedes Ltd.* I do not think that the words appearing on the petitioner's ram and the name inscribed around it in the respondent's trade-mark are sufficient to distinguish one mark from the other for the public in general. The dominant feature of both trade-marks is the ram; it is conspicuous and attracts the eye. The written matter is, in my opinion, secondary and much less attractive; I am inclined to believe that in many cases, it will escape the attention of the average purchaser. Probably the prudent and

cautious purchaser may not be misled, but the one whom I have to consider is the incautious and unwary purchaser, who will be more attracted by the representation of the ram and is prone to pay little attention, if any, to the words or phrases appearing on or around the animal. As a witness said, some customers come in a store and ask for underwear with the sheep; if offered underwear bearing the respondent's trade-mark, the customer is exposed to be misled and to believe that he is getting the petitioner's goods. Of course the purchaser who goes into a store with the intent of getting Ceetee underwear will ask for it and look for the word *Ceetee* on the goods offered to him; but I am inclined to think that this purchaser will be the exception. The witness Cooper said that six out of eight customers will ask for the underwear with the sheep; this statement causes me no surprise; the name apparently does not strike the ordinary unwary purchaser. A person who, for 10, 15 or 20 years, has been in the habit of buying the petitioner's underwear on the inducement of the representation of the ram thereon, is offered underwear bearing the respondent's trade-mark, of which the most conspicuous feature is the sheep, is liable to accept this merchandise under the impression that he is getting the same as he has been buying in the past.

It seems to me that, if the respondent had intended to copy—I must say that there is no proof to that effect—the petitioner's mark, it could not have done better. The choice of the ram instead of the common sheep appearing on most of the trade-marks filed as exhibits by the respondent, the representation of the animal in profile, in a standing position, with its head pointing to the left of the picture, every detail, except for the not very prominent obliquity of the respondent's ram's head, tends to create the impression that both rams are exactly alike. Probably the slight difference between the two animals would be noticed by most persons looking at the two marks at the same time; but I am sure that very few people, after looking at both animals on different occasions, could point out the dissimilarity between them. As Kerly (op. cit., p. 270) says:

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 person acquainted with the mark first registered, and not having the two side by side for comparison, might well be deceived, if the goods

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were allowed to be impressed with the second mark, into a belief that he was dealing with 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. 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.

I can easily conceive an incautious purchaser mistaking one of the marks for the other and accepting the goods of the respondent for those of the petitioner. Such confusion would be unfair to the petitioner who has a long established business and has earned a well deserved reputation for the underwear it has been selling under its trade-mark for approximately 24 years.

What constitutes a deceptive resemblance or, in other words, what degree of resemblance is required to be calculated to deceive, is a matter incapable of definition *a priori*. Kerly (op. cit., 463) says:

No definite rule as to the amount of resemblance required can be formulated *a priori*, but the net impression produced and "the main idea left on the mind" by one mark must be compared with that left by the other, for marks may well be confused by purchasers, who see the defendant's mark when they have present in their memories only an indefinite recollection of the plaintiff's, in cases where the marks could not be mistaken for each other if they were seen side by side. So that the whole mark of the defendant may too nearly resemble that of the plaintiff, although all the essential particulars of the two are distinguishable.

In *Re Christiansen's Trade Mark*, often called the *Taendstikker Case* (1), where the Court of Appeal, reversing the decision of Chitty J., held that a label for match-boxes so resembled another label registered for the same goods as to be calculated to deceive, the judgment proceeded on the ground that the impression produced or the idea left on the mind by both labels was similar. At page 61 of the report, The Master of the Rolls says:

Now let us see what it is we are to consider. We are to consider whether the one trade-mark is so like the other trade-mark that it is calculated to deceive. What is the trade-mark? The trade-mark is not the distinguishing feature of the trade-mark. The trade-mark is not one part of the matter. The trade-mark is not in the one case "Medals" and in the other case "Nitedals." That is not the trade-mark. If you say that, you strike out all the rest. 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 at it to see whether, with that distinction the whole was like

or unlike. That is what he did, but the argument raised by Mr. Romer, and which was not only shadowed but put plainly forward by his skilful cross-examination was this: the moment there is any distinction in any part the things are at once unlike. That is his point. Therefore he cross-examined the people thus: "The lamps or the medals are alike and they are common?" "Yes." "The two things in the middle are unlike?" "Yes." "The word at the bottom is common to the trade, and it is the same in both?" "Yes, but it is common to the trade." Therefore, he says, everything but the words "Medals" and "Nitedals" is common, and those two are different, and therefore the whole is different. 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 is the same, and leaves out altogether the mode in which the things are put together in the two pictures.

And, in the same case, Lindley, L.J., says (p. 63):

I think if we look at the two boxes as they are sold and issued in the trade the resemblances between the two are so great that, although there are differences which might be detected, yet those differences are not so obvious as to make the whole dissimilar. I am quite aware that there is a great mass of evidence to show that a great portion of what is on these boxes is common to the trade. That, to my mind, only makes it the more imperative that the distinguishing features shall be such as to make the dissimilarity obvious. If the dissimilarity is so small, and the common features are so numerous, that the two as a whole are similar, the dissimilarity goes for nothing; and the more there is that is common and similar, the more difficult it is to make the dissimilarity striking. I do not say it cannot be done, because, of course, it can be done. The difference here, looking at the boxes, is simply this, that the word "Medals" is used instead of the word "Nitedals," all the rest being, according to the evidence, common. Now I do not think that is a dissimilarity which is sufficient in this case, because, although I rather agree in the view taken by Mr. Justice *Chitty*, that the leading feature is the name at the top or the bottom of the label, one must not be misled by that. The question is, notwithstanding that, what is the effect of the use or introduction of that distinguishing character upon the whole? When you look at the wholes, then it appears to me, I confess, that the dissimilarity is not enough to make the wholes dissimilar. The wholes are, to my mind, on the evidence, similar, notwithstanding the dissimilarity.

See also *Re Barker's Trade-Mark* (1); *Re Worthington's Trade-Mark* (2).

In the *Worthington's Trade-Mark Case*, James, L.J., said (p. 565):

Now, in dealing with these words (calculated to deceive) in the Trade Marks Registration Act, it appears to me that the Act of Parliament is one to which one might apply the principle of liberal construction. I do not generally like to use general maxims or general principles in considering Acts of Parliament or any other instrument, but I think this is one in which we might fairly say the provisions of the statute ought to be construed liberally, so as to advance the remedy and repress the mischief. It appears to me the intention was to prevent a person, having a trade-mark, being liable to be injured by another trade-mark which might be used to imitate his or be passed off as his.

(1) (1885) 53 L.T.R. 23.

(2) (1880) 42 L.T.R. 563.

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The marks must be compared as they are seen in actual use: Kerly, op. cit., 463; *Wilkinson v. Griffith* (1); *Seixé v. Provezende* (2); *Orr Ewing v. Johnston* (3).

In the *Worthington's Trade-Mark Case* (*supra*) Brett, J., said (p. 565):

It seems to me the arguments in the present case have raised two questions—one of law and one of fact. The question of law is this, whether in construing this Act of Parliament you are to look only at the marks as printed in the advertisement, or whether you are to look at the marks as they will probably be used in the course of trade . . . There again there is nothing about form or outline; it is the trade-mark taken as a whole. That being so, and the mischief being a mischief which is to be done to one person by another in the course of trade, and in the use of these marks in trade, it seems to me that it would be a narrow construction of the statute to say that you are only to look at the mark as it is printed in the advertisements, and that the proper construction is to say you are to look at the trade-mark as it will be used in the course of trade.

The drawing annexed to the respondent's trade-mark is very large, much too large in fact to be used on any garment. On account of its size and of the contrast between the black and white of the photostat copy, the name Dominion Woollens & Worsteds Ltd., is very conspicuous. But when the mark is reduced to a normal size for use on a garment of underwear or outerwear and the contrast between the colour of the garment and of the sheep and lettering surrounding it is lessened, the name will not be so conspicuous, hence the danger of confusion.

I may further cite, on this particular point, the case of *Farrow's Trade-Mark* (4). In this case one Farrow applied to register a buffalo, described as a *charging buffalo*, as a trade-mark for mustard. The application was opposed by Colman, who had registered a bull's head also for mustard, on the ground of resemblance calculated to deceive. The Comptroller General refused the registration and Farrow appealed to the Board of Trade, who referred the appeal to the Court. Stirling, J., adopting the interpretation given to the words *calculated to deceive* in re *Worthington's Trade-Mark* and in re *Christiansen's Trade-Mark*, held that the applicant's mark so nearly resembled the opponent's mark as to be calculated to deceive and dismissed the application. See also: re *Speer's Trade-Mark* (5); re *Barker's Trade-Mark* (*supra*).

- (1) (1891) 8 R.P.C., 370 at p. 375. (3) (1880) L.R. 13 Ch. D. 434 and
 (2) (1866) L.R., 1 Ch. 192 at p. (1882) L.R., 7 A.C., 219.
 196. (4) (1890) 7 R.P.C. 260.
 (5) (1887) 4 R.P.C. 521.

It has been argued on behalf of the respondent that the lettering on the two marks is different and that the name of the respondent company appears prominently on its own. I do not think that this differentiates the respondent's trade-mark sufficiently from the petitioner's to save it from being, in the eyes of the law, calculated to deceive. In the matter of *Biegel's Trade-Mark* (1) a mark was ordered to be expunged for reason of its resemblance to another trade-mark, in circumstances which I consider more favourable to the respondent than in the present instance. Wm. Younger & Co. had registered in 1876 certain trade-marks for fermented liquors, such as beer, wine and whisky, of which a triangular device was a material portion. Biegel, in 1886, registered a trade-mark comprising a somewhat similar triangular device for the same class of goods. Younger & Co. moved to rectify the register by expunging so much of Biegel's mark as consisted of this triangular device. The lettering was quite different in the two trade-marks and moreover the name Wm. Younger & Co. appeared prominently on the latter's mark, while the respondent's mark bore the name of C. L. Wilh Brandt, Biegel's principal, with the words St. Pauli Brauerei. Chitty, J., found the mark too similar and granted the motion.

The trade-marks of Wm. Younger & Co. and of Biegel have been reproduced in the report and a look at them shows that the triangular devices in each of them are not as prominent as the rams on the marks of petitioner and respondent herein and that, on the whole, the marks had more distinguishable features than the marks with which I am now concerned; still the respondent's trade-mark was held to resemble too nearly the petitioner's trade-mark and to be objectionable.

Another case in which an application to register was refused on the ground that the mark too closely resembled another one and was likely to create confusion is that of *Currie & Co.'s Application* (2). The facts are briefly recited in the head-note as follows (p. 682):

C. applied to register a Trade-Mark for whisky in Class 43. The Comptroller refused registration on account of another Trade-Mark registered by B. for whisky in 1883. Both marks contained the device of a

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(1) (1887) 4 R.P.C. 525.

(2) (1896) 13 R.P.C. 681.

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fighting-cock and the words "Cock o' the North," but in most other respects were dissimilar. C. appealed from the Comptroller's decision, and gave notice of a motion that the registration be proceeded with, which was served upon the Comptroller and also upon B. It appeared from the evidence filed on the motion that C.'s Trade-Mark had been in use, with a slight variation, for about 11 years, and that B.'s Trade-Mark had been in use since the early part of 1883.

In this case as in the previous one, the trade-marks were printed in the report and it is quite obvious that the two marks contain many more distinguishing features than the marks of the petitioner and of the respondent. *In re Currie & Co.'s Application*, the only feature in common was the cock, but this cock, similar in both marks, was held to be the thing that caught the eye. A glance at the two trade-marks (at pp. 682 and 683) will show that the cocks are far from being as dominant as the rams appearing on the marks which form the subject of the present litigation.

In this case of Currie & Co.'s application, Kekewich, J. (at p. 684) expressed the following opinion:

The Comptroller, in my opinion, has exercised his discretion wisely. That discretion is reviewable by the Court, but I affirm the discretion. He is asked to register this Trade-Mark of the Applicants, which is said to be "Prince Charlie" whisky, and he objects, and the Respondents object, on the ground that they have already registered a Trade-Mark for whisky—that is, in precisely the same class, referable to the same goods, and which is so near the proposed Trade-Mark that the latter is calculated to deceive. I have heard a considerable amount of evidence to show that they have been both carrying on business and both using these marks for some time, and that no deception has occurred; but that does not seem to me to be the question at all. The question is whether this mark applied for is calculated to deceive; and "deceive" being a verb active, one has to apply a noun substantive, and that is, "ordinary or unwary purchasers." In my opinion, deception is extremely likely to follow the second registration.

In the same sense, I may refer to the decision of Joyce, J., in the Matter of the *Application of Pomril Ltd.* (1).

Kerly (op. cit., 465) says that "it was held that the use of words taken from the plaintiff's mark by the defendant was an infringement, notwithstanding that he always added his own name" and he cites several cases in support of his contention. What he says about words is, by analogy, to the same extent applicable to other features of the mark; the use of the defendant's name on a trade-mark, which is a colourable imitation of the plaintiff's trade-mark, is not, in most instances, sufficient to distinguish the former from the latter; in some cases, however,

where the elements of the labels were for the most part common to the trade or where the plaintiff could have no exclusive right to a common word, it was held that the name of the manufacturer was an element which could suffice to identify the goods: *Blackwell v. Crabb* (1); *Jewsbury & Brown v. Andrew & Atkinson* (2); *Thorne & Co. v. Sandow* (3); *Beard v. Turner* (4). In my opinion, these cases, in view of the circumstances particular to each of them, are distinguishable from the present one and cannot have any bearing on its issue.

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With regard to probability of deception, I may add to the decisions already alluded to, the following, in which devices were held to be calculated to deceive: In re *Sandow Ltd.'s Application* (5); *The Upper Assam Tea Company v. Herbert & Co.* (6); *Boord & Son v. Huddart* (7); *Boord & Son. v. Thom & Cameron* (8); re *The Australian Wine Importers Limited* (9); *Finlay v. Shamrock Co.* (10); re *The Distributing Corporation's Application* (11); re *Jelley's Application* (12); *Wright, Crossley & Co. v. Blezard* (13).

In the case of *Wright, Crossley & Co. v. Blezard*, where the two labels, reproduced in the report do not resemble one another more than the Turnbull's and Dominion Woolen Marks do, Leigh Clare, V.C. said (p. 303):

The real question I have got to try is, not whether people would be deceived if they carefully read and looked at the labels, but whether people who have not paid very much attention to what is on one label, and have bought what I may call "on the view," would be misled by the other label, not looking very carefully at the other label. It is the same test exactly that I remember was applied when I was engaged in *Grafton v. Watson* with regard to copyright of design. If you see a design of a lady's dress in Regent Street, and see another design of another lady's dress in Bond Street a couple of hours afterwards, you may think that the two designs are exactly the same; whereas in fact, if you came to compare them bit by bit, you might see a great deal of difference. In the same way with these two labels; a man who has bought in one town, or in one street in a town, something which strikes him as being yellow, with red and black printed on it, may not have paid very much attention to the particular name or the particular lettering; and if he sees a label that looks very much like the one he knows, he may say:

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|------------------------------|-------------------------------|
| (1) (1867) 36 L.J., Ch. 504. | (7) (1904) 21 R.P.C., 149. |
| (2) (1911) 28 R.P.C., 293. | (8) (1907) 24 R.P.C., 697. |
| (3) (1912) 29 R.P.C., 440. | (9) (1889) 41 Ch.D., 278. |
| (4) (1865-66) 13 L.T.R. 746. | (10) (1905) 22 R.P.C., 301. |
| (5) (1914) 31 R.P.C., 196. | (11) (1927) 44 R.P.C., 225. |
| (6) (1890) 7 R.P.C., 183. | (12) (1882) 51 L.J. Ch., 639. |
- (13) (1910) 27 R.P.C., 299.

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"This is obviously the same stuff; I am going to buy it now, and I shall get the same stuff; that is, I shall get other stuff from the same source." Some questions are put about people who come into a shop—whether they come and ask for "*Crossley's Semolina*." Of course they do not. What they do is, they come in and see a package made up very much like the other. They do not discriminate, possibly, between the two. They ask for semolina, and they think that they are going to get the semolina they had before.

I might refer to other decisions in which marks or labels have been found to be too similar and calculated to deceive; they are very numerous; but the question under consideration is mostly one of fact; the cases upon which I relied are those which, in my opinion, come nearer to and have more points of similarity with the present one; I cannot see that any useful purpose would be attained by dwelling on this subject at any greater length.

Many of the above mentioned cases were infringement cases. The fact is worth noting, because, if the principle is the same, the rules applicable to an action for infringement or passing-off and to an application to expunge a mark from the register are different. A stronger case must be made out by the plaintiff in an infringement or passing-off action than by the owner of a mark opposing the registration of another mark or seeking its removal from the register. I shall again refer to Kerly (op. cit., p. 462):

It follows that the question to be answered, when an infringement without taking the actual mark is alleged, is the same question as arises when a mark tendered for registration is objected to, or, having been registered, is sought to be removed from the Register, on the ground that it so nearly resembles a trade-mark already on the Register as to be calculated to deceive, within the restriction of section 19. The principles governing the comparison of the marks, and determining what amount of resemblance is calculated to deceive, are the same in both cases, although a higher standard of resemblance must be conformed to in an action for infringement than that set up in cases of the other class.

It was incumbent upon the respondent, who adopted an important feature and distinctive characteristic of the petitioner's mark, to establish that there was no likelihood of deception. Kerly (op. cit., p. 457) says:

But the adoption of a single characteristic and distinctive particular from the plaintiffs' mark and its use alone, or with other matter, may well be an infringement of the entire mark. At any rate, it throws upon the defendant the onus of proving the contrary.

In the case of *Ford v. Foster* (1) Lord Justice James (at p. 623) says:

(1) (1872) L.R., 7 Ch. App., 611.

The Plaintiff makes this *primâ facie* case—that he has a plain trade-mark, a material and substantial part of which has been taken by the Defendants. Then the onus is, under those circumstances, cast upon the Defendants to relieve themselves from that *primâ facie* liability.

See also: *Orr Ewing v. Johnston* (1).

The respondent has failed to establish that there is no likelihood of confusion; as I have already said, I believe that the public may be deceived by the respondent's mark and be liable to accept the latter's goods as being the products of the petitioner.

It has been said and it is admitted (see exhibit 4) that the petitioner never applied its trade-mark to knitted outerwear and, on the other hand, that the respondent never manufactured knitted underwear. The admissions contained in exhibit 4 further mention that in one of the factories of the respondent there are machines which could be used, but have not been used, for the manufacture of knitted underwear. There is, as far as I can see, nothing to prevent the respondent from manufacturing underwear and applying its trade-mark thereto. On the other hand, the petitioner is not restricted, it seems to me, to the manufacture of underwear; it may, whenever it sees fit, make any kind of woollen outerwear, and sell it under its trade-mark. As I have said, both trade-marks are very broad; they apply to woollen goods of any description. The fact that the respondent has, up to the present time, deemed expedient to manufacture outerwear exclusively does not, in the circumstances, modify the situation; the respondent's trade-mark is to the same extent objectionable.

There is no proof of actual deception; perhaps it is due to the fact that the respondent's trade-mark had only been in use for a few months when the case came up for trial. However proof of deception is unnecessary, if the mark is, in opinion of the Court, calculated to deceive or if it comprises essential features of the mark infringed or is a colourable imitation thereof: *Kerly*, op. cit., pp. 455 and 460; *Ford v. Foster* (*supra*), at p. 623; *Orr Ewing v. Johnston* (*supra*).

It has been urged on behalf of the respondent that an animal, in this particular case a ram, cannot be monopolized by any individual because it is descriptive and is com-

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(1) L.R., 13 Ch.D. 434 at p. 447, and (1882) L.R., 7 A.C. 219.

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mon to the public or, in other words, *publici juris*. The petitioner admits that it cannot claim a monopoly of the sheep, but submits that there is nothing in the law prohibiting him from adopting a particular representation of a sheep and thereby preventing others from using it. The petitioner's contention is, in my opinion, well founded. In order to show that the representation of a sheep is common to the trade, the respondent has filed a number of trade-marks, Canadian, British and American, in most of which a sheep is a more or less prominent feature (exhibits B. to W. inclusive). None of these marks offer any striking resemblance with that of the petitioner; most of them are entirely different. After a careful examination of these marks, I am convinced that none of them could be mistaken for the petitioner's trade-mark. Moreover the evidence shows that the majority of these marks have never been used in Canada and are not known to the trade (see depositions Auld, Cooper and McGiffin).

On the question raised by the respondent that the sheep is descriptive and moreover common to the trade and for these reasons cannot be a proper subject of a trade-mark, I may refer to the following cases: *Boord & Son v. Huddart (supra)*; *Boord & Son v. Thom & Cameron (supra)*; *Upper Assam Tea Co. v. Herbert & Co. (supra)*; *Orr Ewing & Co. v. Johnston & Co. (supra)*; *Australian Wines Importers (Supra)*. See also re *Dexter's Application & re Wills's Trade-Mark (1)*; *Star Cycle Co. v. Frankenburgs (2)*.

The ram adopted by the petitioner is, I think, a proper subject for a trade-mark and the respondent's defence fails on this point as well as on the others.

For the reasons hereinabove set forth, I have reached the conclusion that the petitioner is entitled to have its trade-mark registered and that the respondent's trade-mark must be expunged. Seeing the consent of L. W. Caldwell & Co. Ltd. (exhibit 2), the latter's trade-mark shall also be expunged.

I must now deal with the demand to expunge Morgans (Hereford) Limited's trade-mark. Proof has been made

(1) (1893) 2 Ch., 262.

(2) 24 R.P.C., 46 and (in appeal) 405.

that the trade-mark has not been used in Canada and is unknown to the trade (depositions of Auld, Cooper and McGiffin). It has further been established by affidavits, with the consent of the respondent, that Morgans (Hereford) Limited went into voluntary liquidation in 1910 and is apparently out of existence. The affidavits further disclose that the company's trade-marks (2) were removed from the register in England on account of non-payment of the fees and that the records do not reveal any assignment of or other dealings with the said trade-marks. In the circumstances, I am satisfied that the Canadian Trade Marks of Morgans (Hereford) Limited must be expunged from the register as being baneful to the trade: Kerly (op. cit.) p. 354; *Pink v. Sharwood* (1); re *John Batt & Co.'s Trade-Mark* and re *Carter's Application* (2).

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In the latter case, Lindley, M.R. (at p. 441) says:

It remains only to consider whether s. 90 of the Act of 1883 (the rectification section) is applicable to this case. We are of opinion that it is. The applicants are parties aggrieved; for the trade-mark 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 on this expression, nor to read it as if the word "made" were the all-important 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 any entry is at any time on the register without sufficient cause, however it got there, it ought in our opinion to 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.

There will be judgment as follows:

1. The entry in the Register of Trade-Marks, Register No. 50, at folio 12122, of the trade-mark of Morgans (Hereford) Limited, a conspicuous portion whereof is the representation of a sheep, is ordered to be expunged;
2. The entry in the Register of Trade-Marks, Register No. 209, at folio 45736, of the trade-mark of L. W. Caldwell & Company Limited, a conspicuous portion whereof is the representation of a ram, is ordered to be expunged;
3. The entry in the Register of Trade-Marks, Register No. 242, at folio 52237, of the trade-mark of Dominion Woollens & Worsteds Limited, a conspicuous portion of

(1) (1913) 30 R.P.C., 725.

(2) (1898) 2 Ch.D., 432.

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which is the representation of a sheep, is ordered to be expunged;

4. The petitioner's specific trade-mark consisting of the representation of a ram across the centre of which appears the word *Ceetee*, with under the word *Ceetee* the words *pure wool* and over the word *Ceetee* the words *guaranteed unshrinkable* and under the representation of the ram the phrase *established 1859*, as applied to woollen goods of all kinds, is ordered to be registered in the office of the Commissioner of Patents at Ottawa, in accordance with the provisions of the Trade-Mark and Design Act.

5. The petitioner will be entitled to its costs of action as against the respondent, the Dominion Woollens & Worsteds Limited.

Judgment accordingly.