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| <p>1930 <u>Dec. 1.</u></p> | <p>LIGHTNING FASTENER COMPANY, LIMITED</p> | } | PETITIONER; |
| AND | | | |
| <p>1931 <u>March 10.</u></p> | <p>CANADIAN GOODRICH COM- PANY, LIMITED ,.....</p> | } | OBJECTING PARTY. |

Trade-marks—Petition to register—"Zipper"—Descriptiveness

Held that the word "Zipper" having become descriptive of slide fasteners generally and the public having come to associate this word with that type of fasteners, it is not a proper word to be registered as a trade-mark.

PETITION by the Petitioner herein to have the word "Zipper" registered as a trade-mark.

The petition was heard before the Honourable Mr. Justice Maclean, President of the Court, at Ottawa.

Harold G. Fox for petitioner.

Russell S. Smart, K.C., for defendant.

The facts are stated in the Reasons for Judgment.

THE PRESIDENT, now (March 10, 1931), delivered the following judgment.

This matter comes before the Court under sec. 12 of the Trade-Marks and Designs Act, and involves four applications for registration of the word *Zipper*, as a trade-mark.

The petitioner, Lightning Fastener Co., Ltd., on September 30, 1927, made application for the registration of the word *Zipper* as a specific trade-mark to be used "in connection with the sale of Separable Fasteners, particularly of the slide controlled type." The Canadian Goodrich Company, which I shall hereafter refer to as the Goodrich Company, in February, 1929, applied for the registration of the word *Zipper* as a specific trade-mark to be

used in connection with "slide fasteners and articles containing same." This applicant made application for the registration of the word *Zipper* as a general trade-mark on October 17, 1927, but this was refused, and thereupon it applied for the specific trade-mark here in question. The Ripper Manufacturing Company, of Vancouver, on September 22, 1927, applied for registration of the word *Zipper* as a trade-mark to be applied to receptacle opening devices; this applicant did not appear at the hearing. The Clogard Wardrobe Company of Washington, D.C., on June 5, 1928, applied for registration of the word *Zipper* as a trade-mark to be used in connection with wardrobe bags. This applicant did not appear at the hearing. The G. E. Prentice Manufacturing Co. filed a statement of objections but at the trial it withdrew the same. One of the objections filed by this company was that the word zipper, if registered as a trade-mark, was calculated to mislead the public because by common usage all such separable fasteners were known in the trade as zip or zipper fasteners, and that had come to be a descriptive term of that type of fastener device. In the end the contest was limited to the petitioner and the Goodrich Company. The Commissioner declined to pronounce on these several conflicting applications for registration, until the rights of the several applicants were determined by the court, and in due course the issues arising from these conflicting applications for registration came before me in the way I have just stated.

The petitioner has for some years been engaged in the manufacture of a fastener device of the slide control type, at St. Catharine's, Ontario. This device consists of two opposed series of members adapted to be attached one on each side of an aperture in some article and adapted to interlock so as to close the aperture upon the slide being operated in one direction, and to separate so as to leave the aperture open upon the slide being operated in the opposite direction. This device is so well known that no further description of it is necessary; I shall refer to it as a slide fastener. The petitioner had for years used and applied the trade-mark *Lightning* to the fasteners which it manufactured, the same being applied in a manner I need not pause to explain; the petitioner however alleges

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that it commenced, on or about the first day of September, 1927, to use the word "zipper" as a word mark for its fasteners, that use commencing just shortly before its application for the registration of that word. Whether this use was extensive or not does not appear.

The Goodrich Company in 1923, became, by assignment I think, the registered holder of a specific trade-mark consisting of the word Zipper, to be used in connection with the sale of footwear. For some time it has been manufacturing in Canada a line of overshoes of different styles equipped with slide fasteners; in recent years, the petitioner has been supplying the Goodrich Company with the fasteners used in its overshoes and sold under the trade-name of Zipper. The Goodrich Company say that the word Zipper has become generally associated by the public in Canada, and throughout the world, with goods manufactured by the Goodrich Company, or by the B. F. Goodrich Company, the parent company, in the United States. It is doubtless true that this company has manufactured large quantities of overshoes in Canada under the trade-name of Zipper, and has expended substantial amounts of money in advertising the same. In its statement of objection to the petitioner's application, the Goodrich Company allege that it was in anticipation of the danger of a competitor, or some manufacturer of fasteners, applying for registration of the word Zipper to be used in connection with slide fasteners, which would lead the public into the belief that it was buying the footwear of the Goodrich Company, that it made application to register the word Zipper to be used in connection with slide fasteners and articles in which the same were used.

I have reached the conclusion that the applications of the petitioner and the Goodrich Company should be denied upon the ground that the word Zipper has become descriptive of sliding fasteners of the type in question, and that the public have come to associate the name Zipper with that type of fastener. It was urged that it was not generally true that the slide fastener was referred to by the public as Zipper and that it was only occasionally that it

was so described. I think there is sufficient evidence to justify one in holding that the word Zipper has in such degree become descriptive of slide fasteners as to preclude its registration as a trade-mark. It was upon this ground that the Prentice Manufacturing Company, in its filed statement of objections was purporting to resist the registration. No party to this proceeding was interested in establishing that the word Zipper had become descriptive of the slide fastener, and in that respect the hearing was not satisfactory; the public was not in any way represented. Counsel for the petitioner very plainly stated that its concern in the matter was not so much whether the Goodrich Company was permitted to register the word, but that third parties should not be permitted to register it. I have already stated the reasons assigned by the Goodrich Company for its application for registration; it was not so much that it wished the registration, but rather that it did not wish others to get it. However there is some evidence upon the point. The secretary of the Goodrich Company testified that it had, since 1924, many requests for fasteners under the name of Zipper, in fact there was put in evidence a letter from the Goodrich Company to the petitioner company inquiring about fasteners suitable for portfolios, and they were referred to as "Zipper Fasteners." On discovery, counsel for the petitioner made the admission, that the petitioner company received orders and letters from customers, going as far back as 1925, requiring shipment of fasteners, and describing them as Zipper Fasteners. Sundback, President of the petitioner company, admitted that letters were received at the office of that company describing the fasteners, as Zipper fasteners, and that occasionally in the company's factory, and upon the street, slide fasteners would be referred to as Zippers. He also stated that in the United States, this type of fasteners are occasionally referred to as Zipper fasteners, as in Canada; Sundback is also consulting engineer of a company manufacturing slide fasteners in the United States. I suspect that much stronger evidence was available upon this point, had any objecting party intervened to oppose seriously the applications, upon that ground. I have no

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doubt that in the trade it is a very common practise to refer to these fasteners as Zippers, and that it is a very common thing with the general public I have no doubt. The reason for that is this. The Goodrich company gave the word mark Zipper to its overshoes and it used, for the first time I understand, slide fasteners in such overshoes. The fastener was then a novel and patented device; it was probably nameless, but was bound to get a name. I do not mean the trade-mark name the makers would give it. It is probable that the public, from the start, would associate the word Zipper less with the overshoe which was not novel, than with the type of fastener, which was novel. The trade-mark of the overshoe came to give the same name to the fastener. That is what happened, and it was to be expected. But there is sufficient evidence to justify me in holding that the word Zipper is descriptive of slide fasteners, and that the word is not a proper trade-mark for slide fasteners. Makers and vendors of slide fasteners may easily adopt other word marks to distinguish their particular goods. There is no particular reason why any one should have the word Zipper for sliding fasteners. Upon this ground alone, I think, the applications for registration of the word Zipper, to be applied to the slide fastener itself, should be refused.

But some of the applicants desire to register the word Zipper for articles in which is employed the slide fastener, and not for the slide fastener itself. The application of Ripper Manufacturing Company Ltd., is for the word Zipper as applied to receptacle opening devices. It is just a little difficult to understand what was in the mind of this applicant; whether the mark was intended for the fastener, or for the article in which it was to be used, is difficult to determine, but that after all matters little. The Goodrich Company applied for registration of the word for slide fasteners, and also for "articles containing same"; I assume that means all articles manufactured or sold by the applicant. The Clogard Wardrobe Company ask for registration of the same word in connection with wardrobe bags. This means, that each of these three applicants, wish the same word mark for articles or receptacles which

open and shut by the use of a slide fastener. The applications are the proof of this. It is perfectly plain that they wish this word mark, because it indicates that the goods or articles to which the word is to be applied opens and closes by means of a slide fastener, whether a wardrobe bag, a tobacco pouch, a shirt, a coat, or any other article. Used in that way by itself, the word *Zipper* is in my opinion descriptive and is therefore not a proper mark for registration. It is my opinion that none of these applicants are now entitled to the exclusive use of that word, when applied to articles containing the slide fastener. I must not be understood as meaning that this remark is applicable to the registration of *Zipper*, applicable to footwear, belonging to the Goodrich Company. Whether or not a descriptive word is in terms barred by the Trade-Marks Act, it was always, I think, a principle of Common Law that descriptive words were not registerable as trade-marks.

Returning again to the application of the Goodrich Company. If any one is entitled to the registration of *Zipper* as a trade name for slide fasteners, it might fairly be said that it should be this applicant. It is true, I think, that from the start its *Zipper* overshoe contained the slide fastener, but the trade-mark *Zipper* might be applied by the Goodrich Company to an overshoe fastened with buttons, buckles, or any other kind of fastener, and to footwear generally. The trade-mark *Zipper* had no application to the form of fastening. While it may be true that it was the Goodrich Company's extensive business and advertising that was responsible for the public associating the name *Zipper* with the sliding fastener, yet that affords no ground at this stage for permitting the Goodrich Company to register that word as a trade-mark for that type of fastener, for the reasons I have already stated. If the Goodrich Company applications are refused in respect of the slide fastener, then that is the end of the whole of the application, because it is only in respect of articles into which a slide fastener bearing the mark *Zipper* enters, that the same word is asked to be registered for the article itself. If the application in its entirety were granted, that

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there would be confusion is quite certain from the evidence. Sundback testified that the word Zipper had already been used in Canada. He stated that back as far as 1925, he saw a moth-bag containing a slide fastener on sale at Eaton's Ltd., in Toronto, under the trade name of Zipper. The slide fastener itself would not likely be examined by purchasers of articles for the purpose of ascertaining whose make they were, it would I think, be the word mark Zipper attached to the article that alone would attract the eye; the word mark Zipper, on the article itself, would merely emphasize the fact that the article was one opened and closed by a slide fastener. There is no limitation in the application, as to the articles the Goodrich Company might manufacture and sell under the trade name of Zipper, it might be moth-bags with a fastener containing the mark Zipper, and the word Zipper on the bag itself. This would indicate how difficult it would be in such a case to distinguish the moth-bag of the Goodrich Company from the moth-bag mentioned by Sundback. There is now in use in Canada according to Sundback, the word mark Zip-On used on drawer leggings, and Zip-O-Gripp used in connection with luggage, and in which the slidefastener is employed. There are other similar words on the register, but whether associated with slide fasteners is not clear. I have no doubt these marks are but adaptations of the word Zipper.

In my opinion the applications for registration made by the petitioner and the Goodrich Company should be refused, as also should the application of Ripper Manufacturing Company and Cloggard Wardrobe Company. Upon the facts, I think, I am within the spirit of the Trade-Marks Act in refusing these applications. There will be no order as to costs.

Judgment accordingly.
