WRIGHTS' ROPES LIMITED.....PETITIONER;

AND

BRODERICK & BASCOM ROPE CO.....RESPONDENT.

1931

May 28.
June 23.

Trade-marks—Expunging—Meaning of "mark"—Trade-Mark and Design Act, Ch. 201, R.S., 1927, Sec. 5.

The trade-mark in question is a specific trade-mark to be applied to the sale of wire ropes, and consists of a yellow coloured strand running through the length of such ropes. The present action is to have said trade-mark expunged as not being a proper trade-mark within the meaning of section 5 of the Trade-Mark and Design Act.

Held, that a coloured strand woven into a wire fabric is a "mark" which may be used by any person carrying on a manufacture of wire rope for the purpose of distinguishing the article manufactured or produced or offered for sale by him from that of any other manufacture; and that the same is a "mark" within the meaning of section 5 of the Trade-Mark and Design Act.

(1) (1928) Ex. C.R. 36, 40.
(2) (1887) 1 Ex. C.R. 233.
(3) (1929 4 D.L.R. 154.
(4) (1928) Q.R. 67 S.C. 78.
(5) (1928) 34 Revue Légale 436.
(6) (1885) L.R. 10 A.C. 249.

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PETITION by the petitioner herein to have the respondent's trade-mark, as described in the head-note herein, expunged.

The action was tried before the Honourable Mr. Justice Maclean, President of the Court, at Ottawa.

H. Gerin-Lajoie, K.C., for petitioner.

O. M. Biggar, K.C., for respondent.

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

THE PRESIDENT, now (June 23, 1931), delivered the following judgment.

This was a petition for an order that the respondent's trade-mark registered in Book No. 225, folio 48989 of the Register of Trade-Marks, be expunged.

The trade-mark in question is a specific mark to be applied to the sale of wire ropes and consists of a yellow coloured strand running through a length of wire rope. The respondent filed an answer to the said petition and counterclaimed for an injunction restraining the petitioner from infringing its mark, and for damages and such other relief as may appear just, together with costs.

The issue between the parties on the petition, and the question to be decided by the court, inheres in a construction of section 5 of the Trade-Mark and Design Act, Chapter 201, R.S., 1927. By that section it is provided that:

> 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.

It is reasonable I think to reach the conclusion that a coloured strand woven into a wire fabric is a "mark" which may be used by any person carrying on the manufacture of wire rope, "such use being for the purpose of distinguishing the article manufactured or produced, or offered for sale by him" within the words of the Act and their literal meaning.

The modern word "mark" has its origin in the Anglian word "merc" which had the meaning of "a sign." "Mark" is defined in the Oxford Dictionary as "A sign affixed or impressed for distinction." It is defined in Webster's New International Dictionary as "an affixed, impressed or assumed distinguishing sign or token." In the same work a mark is said to be "a character, device, label, brand, seal, or the like, put on an article to show the maker or owner, to certify quality, for identification," etc. Then, again, it is no distortion of language to say that a yellow coloured strand of wire as an element of a woven wire rope falls within the designation of a "business device" as mentioned in the said section of the Act; such device being one "adopted for use by any person in his trade for the purpose of distinguishing the same as his manufacture or product."

It has to be borne in mind that there is a difference between the provisions of the present English Trade-Mark and Design Act and the Canadian Act, in that the English Act contains a section defining what a trade-mark is, while the Canadian statute does not. Hence it is necessary to be careful in applying the English decisions since 1905 to any construction of section 5 of the Canadian Act. But in supporting the contention that the yellow coloured wire is a mark within the meaning of section 5 of the Canadian Act, assistance is to be had from the cases decided in England before there was any statutory definition of a trade-mark. These cases would distinguish between colour as the whole subject of a trade-mark—such as a coloured label—and colour applied to one particular feature or element in a manufactured article. It was held in the case of *Harter* v. *Souvazoglu* (1), that a mark consisting of coloured threads in the end of a piece of manufactured cloth was a good mark. In *Carver* v. *Bowker* (2) it appears to be taken for granted that colour may form a material part of the mark. In *Bass Ratcliff Gretton Ltd.* v. *John Davenport & Sons* (3), it appears from the remarks of Romer L.J., (at p. 539) that in the case of an old mark colour may be an important element. In *Reddaway's Application* (4),

(1) 1875, W.N. pp. 11 and 101.
(2) 1877, Sebastian's Dig. 350.
(3) 1902 19 R.P.C. 529.
(4) 1914 1 Ch. 856; (1914) 31 R.P.C. 147

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the case, it is true, arose under the English Act of 1905, but it is of assistance here because Warrington J., at p. 862, said: "I see no reason why three lines of colour woven into a fabric should not be a mark." And he held that "the weaving of the mark into the fabric" (a fact present in the wire fabric in the case now before me) was *"a user upon the goods"* of the mark "for the purpose of indicating that they are goods manufactured by the applicant." His finding under the English Act of 1905 that a mark of three colours capable of distinguishing the goods of the proprietor of the trade-mark was registrable, lends adequate support to a construction of section 5 of the Canadian Act which would qualify the yellow coloured strand in the wire rope sold by the plaintiff as a registrable "mark" or "business device."

I do not think it is necessary to pursue the authorities further, because the case before me does not involve any strained construction of section 5 of the Canadian Trade-Mark and Design Act in order to hold the mark in question registrable. I therefore find that the respondent's trade-mark, consisting of a "yellow coloured strand running through a length of wire rope," as applied to the sale of wire ropes is a registrable "mark" or "business device" within the meaning of the said section.

There will be judgment dismissing the petition with costs to the respondent. As to the issue of infringement raised by the counter-claim, I think the respondent is entitled to an injunction to restrain the petitioner from further infringing the respondent's trade-mark. There will be judgment accordingly upon the counter-claim, with costs to the respondent thereon.

Judgment accordingly.