

1931

Jan. 22.  
Feb. 23.

WESTERN CLOCK COMPANY.....PETITIONER;

VS.

ORIS WATCH COMPANY, LTD.....RESPONDENT.

*Trade-marks—Expunging—Calculated to deceive—Abandonment—  
Intention*

By its action, Petitioner, owner of the trade-marks "Big Ben", "Baby Ben", "Pocket Ben", "Glo-Ben" and "Ben Hur", seeks to have the trade-mark "Bentima", owned and registered by the defendant, expunged, on the ground that the same was liable to confuse and deceive the public.

*Held*, that as the trade-marks in question consisted of distinctive names and were printed in such a conspicuous place and manner, there could not be any confusion as to which was which, and the public, even the unwary and incautious purchaser, could not be made or led to purchase the goods of the defendant for that of the plaintiff; that the defendant's trade-mark was not liable or calculated to confuse or deceive the public, and was properly registered and should not be expunged.

2. That the fact of non-user of a trade-mark alone does not establish the abandonment thereof; to succeed in such contention, it must be established that the original owner of the mark, not only discontinued its use, but also intended to abandon the same.

PETITION to have the trade-mark "Bentima" expunged.

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

*W. D. Herridge, K.C.*, for plaintiff, argued that the use of the trade-mark "Bentima", as applied to watches created confusion in the minds of the public, accustomed to buy plaintiff's products. The use of the syllable "Ben" with any prefix or suffix constituted infringement of plaintiff's trade-mark. That the use of "Ben" by defendant would lead the public to believe that the goods so marked were the plaintiff's, being of the same type of articles. That moreover the respondent had never any intention of using the trade-mark in question and, in fact, had never used it, or, if at any time the trade-mark was used, it had been abandoned. He cited:

Kerley—pp. 266, 269-272, 275, 301 to 305, 458, 459, 462 and 463, also pp. 119 and 120.

*Williams Candy Co. v. Crothers* (1925) S.C.R. at p. 380.

*Pugsley, Dingman & Co. Ltd. v. Proctor & Gamble Co.* (1929) S.C.R. 442.

*American Druggists Syn. v. Bayer Co.* (The Aspirin case) (1923) Ex. C.R. 65; (1924) S.C.R. 558 *et seq.*

*O. M. Biggar, K.C.*, for defendant, argued that there could be no confusion between the marks; that the defendant's mark was not calculated to deceive and was properly registered. That the onus of proving abandonment was on the plaintiff, and he must prove there was no intention of using the mark, that mere non-user is not abandonment. That "Bentima" was a new and invented word.

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The facts are stated in the Reasons for Judgment.

AUDETTE J., now (February 23, 1931), delivered judgment.

This is an action to expunge from the Canadian Register the objecting party's specific trade-mark registered on the 8th October, 1929, and consisting of the fancy word "Bentima" "to be applied to the sale of *watches and parts of watches*," upon the ground that it so nearly resembles the petitioner's trade-mark as to be calculated to deceive and upon the further ground of non user and abandonment.

The petitioner's five specific trade-marks are as follows:—

- "Big Ben" to be applied to the sale of clocks, watches and other timepieces. 22nd January, 1910.
- "Baby Ben" to be applied to the sale of clocks, watches and other horological instruments. 30th May, 1912.
- "Pocket Ben" to be applied to the sale of watches, clocks and time-keeping instruments and parts and components thereof. 3rd July, 1918.
- "Glo-Ben" to be applied to the sale of watches, clocks and timekeeping instruments and parts and accessories thereof. 20th May, 1919.
- "Ben Hur" to be applied to the sale of clocks, watches, timekeeping instruments and parts thereof. 4th January, 1927.

There is no trade-mark for the word "Ben" by itself,—the syllable "Ben" is used with either a prefix or a suffix.

While the origin of these names used as trade-marks by the respective parties has nothing to do with the present controversy, it may be said that the evidence discloses that the word "Bentima" has been coined from the word "Ben"—the Hebrew for "son"—and the English word "time",—thus "son of time" which was changed to "tima".

The word "Big Ben" at once reminds us of the name of the immense bell of 13½ tons placed in the Westminster Tower, London, England, in 1858, and thus baptized both

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from its enormous mass and from the abbreviation of the name "Benjamin", after Sir Benjamin Hall, First Commissioner of Works, at the time when the clock was erected.

Now the plaintiff's other four trade-marks, besides "Big Ben", present three of them with a prefix to the syllable "Ben" and one, "Ben Hur", with a suffix.

A fancy or coined word must speak for itself, it must be a fancy word of its own inherent strength. One could not take the word "spade" and make it a fancy word. And, as was held in *Davis and Company v. Stribolt and Company* (1), the word used in a foreign country as the common term to describe and denote an article is not a fancy word within the meaning of the Act.

None of the plaintiff's trade-marks is for the syllable "Ben", but with prefix and suffix attached thereto.

Moreover, the syllable "Ben" by itself is a French, English, Scotch and Arab word. Whether one can take the ownership of a word from the French and English languages, monopolize it and say to others you cannot use that word, is a question which need not be considered here.

The plaintiff even carries his contention further and says you cannot, because of my trade-marks, use the syllable "Ben" in any word you wish to make a trade-mark of to identify your merchandise. Is it to say that from the existence of the plaintiff's trade-marks, there results an inhibition from any one using as a trade-mark any word or syllable of either the French or English language, which would embody the infiltration of the syllable "Ben", be that word of any number of syllables? This would be arbitrarily trenching on the rest of the trade and on our language and grammar.

Moreover, it is argued, on behalf of the plaintiff, that the objecting party's goods and merchandise are of the same class as that of the plaintiff. That is not quite accurate, these goods are in the same line of business, the same type or kind; but not of the same class. The plaintiff's watch, sold under the trade-mark "Pocket Ben", is decidedly of its own poor and inferior class, selling as low at \$1.75. It is made of inexpensive material, with neither jewel or precious stone. How can there be confusion between such

(1) (1888) 59 L.T.R. 854.

a watch and the ordinary, real, common, every day watch used by the public and to which it is accustomed?

In addition to this fact, it must be noticed that the plaintiff's trade-marks cover both clocks and watches, while the defendant's trade-mark is limited to watches and part of watches only.

There is no doubt that the objecting party started using his trade-mark after the plaintiff was using his own; but that has nothing to do with the case as presented, the question to be determined here is that of the probability of confusion or deception as resulting from these respective trade-marks. Is the name of one so nearly resembling the name of the other as likely to confuse or deceive, that is the question which the Court has to try and the Court must not surrender its own independent judgment in that respect.

Among others, in several cases, it was held that  
*Aquatite* was not too near *Aquascutum*,  
*Colonial* was not too near *Colonel*,  
*Limit* was not too near *Summit*,  
*Herogen* was not too near *Ceregen*,  
*Mendit* was not too near *Mendine*,  
*Swankie* was not too near *Swan*,  
*Lavroma* was not too near *Lavona* or *Lovona*,  
*Motrate* was not too near *Filtrate*,  
*Night Cap* was not too near *Red Cap*.

See *Kerly*, on Trade-Marks, 5th Edition, 307, 308.

Now, it is well to bear in mind that, unlike a patent or copyright which relates to the substance of an article, a trade-mark differs from them and does not protect the substance of the article to which it is attached from being imitated; but it identifies an article and indicates the source to which that article is to be attached. The function of a trade-mark is to identify the goods of an individual.

Distinctiveness is of the very essence and is the cardinal requirement of a trade-mark, which is used to distinguish the goods of a trader from the goods of all other traders.

Distinctiveness means adoption to distinguish. Sebastian, 5th Edition, 55. The trade-mark does not lie in each of its particular parts, but "*dans son ensemble*." It is the appeal to the eye which is to be considered and which must

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determine the difference or similarity in the "get up" of each article. And in the present case there is no special "get up," the trade-mark cannot be ascertained at a distance; because one could detect what is written on the dials, in very small type, only upon paying special attention and drawing closely to the article, to actually read what is written thereon.

There are on the market many clocks and perhaps watches of the same class and description, but there is no evidence that such articles would be similar to the "Bentima" watches of the defendant.

The essential characteristic of the trade-marks in question in this case is respecting a name, by itself, printed on the dials of clocks and watches.

The user of a trade-mark does not result in what the person who makes use of it may have in his mind; but what the public would obviously understand when the name or trade-mark is impressed or printed upon the goods. And considering that the trade-marks in question consist of a distinctive name printed and displayed in such a conspicuous place and manner, there cannot be any ambiguity as to which is which, and the public, even the unwary and incautious purchaser, could not be made or led to purchase the goods of one party for that of another. The difference between the names is so accentuated, that no one could be deceived because it is the name itself which strikes the eye upon looking at the merchandise. There is no imitation, the two marks are quite different and the evidence establishes that the plaintiff's trade-marks were not known to the objecting party when they adopted theirs.

Considering the distinction in the name of the parties, the trade-marks, their appearance, their sound, the nature of the goods involving such striking difference in prices, the difference between the marks and the surrounding circumstances, one is necessarily led to the conclusion that there is no likelihood, no reasonable probability of confusion or deception.

In a case of this kind, the circumstances must be such as to satisfy the Court that confusion and deception are probable, and when that is not adequately made out, relief must be refused. There is obviously no attempt to deceive in

this case and the names are distinctive and sufficiently distinguishable. *Andrew McLean Company v. Adams Manufacturing Company* (1).

Having found that there is no probability of confusion and deception, it might be unnecessary to consider the other questions raised at trial; however, it may be well to say briefly a few words respecting the plea of non-user and abandonment.

It was held (in the case of *Madame Irene v. Schweinburg* (2) ) that it is well settled that the mere non-user of a trade-mark does not establish abandonment thereof; but that one who contends that the mark has been abandoned must establish that the original owner of the mark not only discontinued its use, but intended to abandon the same.

The *onus* of establishing the non-user and the abandonment rests upon the plaintiff who relies upon it. The only evidence in this respect is the statement by two employees of the plaintiff that they never saw or heard of the use of the word Bentima, and that is far from sufficient. The evidence adduced under the Letter of Request to Switzerland issued in this case only establishes, when properly read, that the witnesses there could not say when "Bentima" was sold in Canada and in what quantity, "this could be found from the order books, but that would necessitate many days work."

A Court cannot lightly cancel and annul a document under the Great Seal of Canada, upon such evidence. The plaintiff has failed to discharge the *onus* of proving non-user and abandonment.

Therefore, there will be judgment dismissing the action and with costs in favour of the objecting party.

*Judgment accordingly.*

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(1) (1908) 31 App. D.C. 509.

(2) (1912) Off. Gaz. (U.S.) p. 1043.