

1891
 Mar. 24.
 THE QUEEN, ON THE INFORMATION OF }
 THE ATTORNEY-GENERAL FOR THE } PLAINTIFF;
 DOMINION OF CANADA..... }

AND

VAN DULKEN, WIELAND & COM- }
 PANY..... } DEFENDANTS.

*Trade-mark—Property in—Infringement of—R. S. C. c. 63 s. 12—53
 Vic. c. 14.*

The questions which the court has jurisdiction to determine under the Act 53 Vic. c. 14 are such as relate to rights of property in trade-marks, and not questions as to whether or not a trade-mark ought not to be registered, or continued on the registry, because it is calculated to deceive the public or for such other reasons as are mentioned in R.S.C. c. 63 s. 12.

DEMURRER to an information filed by the Attorney-General for the Dominion of Canada on behalf of the Crown.

The facts upon which the information was based, and the grounds of demurrer, are sufficiently stated in the judgment.

February 9th, 1891.

Ferguson, Q.C. (with whom was *Marceau*) in support of demurrer :

Prior to the passage of 53 Vic. c. 14 it will be admitted that there was no jurisdiction in this court to adjudicate upon the question now before it. If such jurisdiction is not conferred upon the court by that statute it does not exist. I submit that no jurisdiction to hear such a case as that presented by the information herein can be found in the statute. The Act of 1890 only confers jurisdiction upon the court to hear and determine cases where the true owner finds his identical trade-mark has been registered by some other person; it does not cover a case where a registered trade-mark is sought to be cancelled on the ground

that it is an imitation or infringement of a trade-mark which has been previously registered. The subject has a remedy in the ordinary courts of justice for such an injury, and does not need the intervention of the Attorney-General to enable him to obtain proper redress. The court should not assume a jurisdiction that is not clearly given by the Act. (Cites *Maxwell on Statutes* (1); *Hardcastle on Statutory Law* (2); *Wilberforce on Statutory Law* (3); *The Attorney-General v. Sillem* (4); *James v. South Western Ry. Co.* (5).

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Again, there should be a relator in the case. The Crown has no interest or property involved in it, and will not be effected in any way by its result. The information, therefore, is bad in substance; the court could not give costs against the Crown in such a case.

Christie, Q.C. contra: A relator is not necessary. The absence of a relator cannot be successfully relied upon as a ground of demurrer to such an information as this. He is only introduced in Crown suits for the purpose of costs. (Cites *The Attorney-General v. The Niagara Falls Bridge Company* (6); *The Attorney-General v. Bradlaugh* (7); *The Attorney-General v. The Edison Telephone Company* (8); *Story's Equity Pleadings* (9); *Hardcastle on Statutory Law* (10); *Daniel's Chancery Practice* (11); *The Attorney-General v. Wright* (12). Section 11 of *The Revised Statutes of Canada*, c. 63 is copied almost word for word in the new Act. Unless it is held that section 3 of the Act of 1890 has no meaning, this action is properly instituted. Where one person has registered a trade-mark which belongs to another then it is necessary to bring a relator into the suit.

(1) 2nd ed. 158.

(2) Pp. 52, 55.

(3) Pp. 55, 56 and 244.

(4) 10 H. L. Cas. 720.

(5) L. R. 7 Ex. 296.

(6) 20 Grant 34.

(7) 14 Q. B. D. 667.

(8) 6 Q. B. D. 244.

(9) C. 2 s. 8.

(10) Pp. 134, 135.

(11) Ed. 1879, Pp. 11, 16, 65.

(12) 3 Beav. 447.

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because the Crown has no direct interest therein ; but where two trade-marks are registered and one infringes the other, the Crown has an interest in the suit because people are liable to be deceived, and the public interest demands a rectification of the register by the Crown. Even if no jurisdiction is expressly given by the Act of 1890, the Court should assume it and proceed according to its ordinary procedure. (Cites *The Interpretation Act*, R.S.C., c. 1. s. 7, sub-secs. 49-52.)

Again, I submit if one trade-mark infringes a nother they are practically one and the same trade-mark. In such a case it becomes a question of property that the court has to decide, and it cannot be disputed that, under the Act of 1890, the court has the right to hear and determine questions of property in trade-marks.

Ferguson, Q. C. in reply :

The trade-marks are not the same, and the information does not allege that they are. Again, the information does not allege that the Crown has any interest in the suit.

BURBIDGE, J. now (March 24th, 1891) delivered judgment.

The information sets out that John DeKuyper & Son are the owners of certain trade-marks and devices therein described which were registered in the office of the Minister of Agriculture on the 21st April, 1875 ; that on the 2nd of April, 1884, the defendants obtained the registration in the said office of a trade-mark that is an infringement on and an imitation of the registered trade-marks and devices of the said John DeKuyper & Son, and which so resembles the latter as to be likely or calculated to deceive, and the registration of which conflicts with the registration of DeKuyper & Son's said trade-marks and devices, and

was effected through error and oversight ; that application was made on behalf of John DeKuyper & Son to the Minister of Agriculture for the cancellation of registration of the defendants' trade-mark, and that the Minister, having considered such application, decided that the matter thereof was a question for the decision of this Court, and so notified the parties according to law.

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The information concludes with a claim for a decree that the registration of the defendants' trade mark be cancelled as an infringement of the rights of the said John De Kuyper & Son, and as having been registered by error and oversight. The defendants demur to the sufficiency of the information principally upon the ground that the court has no jurisdiction to hear the matter or grant the relief prayed for, and it is admitted that if such jurisdiction is not conferred upon the court by the Act of Parliament 53 Vic. c. 14, it does not exist.

Prior to the passing of that Act it was provided by the 11th section of *The Trade-Mark and Design Act* (1), that if any person made application to register as his own any 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 trade-mark, the Minister should 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 who was the rightful owner of such trade-mark, and that after hearing such persons and their witnesses, the Minister should order such entry or cancellation or both to be made as he deemed just. By an amending Act, 53 Vic. c. 14 sec. 1, it is now provided that on such application the Minister shall cause all persons interested in the matter to be notified that the question is one for the

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decision of the Exchequer Court of Canada, and that no further proceedings shall be had or taken concerning such application until the rights of the parties have been declared and adjudged by such court, or until the parties have agreed among themselves as to their respective rights ; and by the second section of the Act last cited, the court is given authority upon information in the name of the Attorney-General of Canada, and at the relation of any party interested, to declare the rights of the contesting claimants with respect to such trade-mark. It will be observed that, so far as we have as yet seen, the jurisdiction vested formerly in the Minister and now in the court is to determine which of two or more persons claiming to own a trade-mark is entitled thereto.

By the 12th section of *The Trade-Mark and Design Act* (1) it is provided that the Minister 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 immoral or scandalous figure ;

(d.) If the so called trade-mark does not contain the essentials necessary to constitute a trade-mark properly speaking.

By the second clause of the 11th section of the Act last mentioned, it was provided that errors in registering trade-marks and oversights in respect of conflicting registrations of trade-marks might be corrected in a manner similar to that provided in the first clause of the section already cited at length ; and by the 3rd section of the amending Act (2) it

(1) R. S. C. c. 63.

(2) 53 Vic. c. 14.

is provided that 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 as provided in section one of the amending Act. Now, passing over the difficulty suggested that section one of the Act makes no provision for the manner in which such proceedings shall be instituted, unless, indeed, the notice from the Minister to the persons interested that the question is one for the decision of this court can be considered a proceeding therein, we come to the more important question as to what are the errors and oversights which the court may correct. By the first and second sections of the amending Act, the court is given authority to declare the respective rights of persons where one has obtained registration of a trade-mark of which the other claims to be the owner. It might, however, have happened that through error or oversight both parties had obtained registration, and then I think that the court would have jurisdiction under the third section to hear and determine the question of ownership. It may be that under the 11th and 12th sections of the amended Act (1) the Minister might have gone further and have tried out questions as to whether one mark resembled another, or was calculated to deceive or mislead the public, or for any other reason in such 12th section mentioned, ought not to be registered or continued on the registry. But the Minister's powers under the 12th sec. of the Act last referred to are not in any way affected by the amending Act; and Parliament has not, at least in express terms, given the court any jurisdiction in respect of such matters. The most that can be said, I think, is that the amending Act, taken as a whole, suggests that possibly Parliament intended to give

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to the court all the jurisdiction formally exercisable by the Minister under section 11 of the amended Act. But having regard to the well established rules for the interpretation of statutes conferring a new jurisdiction on courts, I ought not, it seems to me, to act on that surmise when I can otherwise give a reasonable meaning and effect to all the provisions of the Act.

Now, in the case before the court, it is not alleged that the defendants have obtained registration of a trade-mark of which DeKuyper & Son are the owners, but of one which is an infringement on, and an imitation of, that owned by the latter, and so resembling it as to be calculated to deceive. The questions are no doubt closely related, but the information appears to have been framed on the 12th and not on the 11th section of the Act (i).

The plaintiff will have leave to amend, and it is possible that the issues which the persons who are, in reality though not in name, the relators, wish to have determined may, as suggested on the argument, be raised on an enquiry under the 11th section as to whether or not the two trade-marks are, in their essential particulars, the same, and if so, whether they are entitled to the exclusive use thereof. If the plaintiff amends, an opportunity will thereby be afforded to consider the objections taken to the form of the information, and which it has not become necessary for me to determine.

There will be judgment for the defendants on the demurrer with costs, and the plaintiff may amend upon the usual terms.

*Demurrer allowed with costs.*

Solicitors for plaintiff: *Abbotts, Campbell & Meredith.*

Solicitors for defendants: *Duhamel, Marceau & Merrill.*

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(1) R. S. C. c. 63.