1950
Apr. 26-29
May 16-18
June 27-28
1953
July 29

BETWEEN:

CAMPBELL MANUFACTURING CO. LIMITED ..... } PLAINTIFF;

AND

THORNHILL INDUSTRIES LIMITED and SLAZENGERS CANADA (1936) LIMITED ..... } DEFENDANTS.

Patents—Trade marks—Infringement—Passing off—Process for weighting badminton shuttlecocks—Anticipation—Prior user—Lack of subject matter—Combination—Commercial success—"Blue Goose", "Snow Goose" and "Blue Hawk"—Onus on plaintiff to show reasonable probability of confusion.

The plaintiff brought action for infringement of its patent for a process for weighting badminton shuttlecocks, infringement of its trade mark Blue Goose by the use of the names Snow Goose and Blue Hawk and for passing off. The validity of the patent was attacked for lack of novelty and subject matter and infringement of the trade mark and passing off were denied.

Held: That claims 1 and 2 of the patent in suit are too wide.

2. That claims 3 and 4 are invalid for lack of subject matter.

3. That in an action for infringement of a trade mark by the use of a similar mark the onus is on the plaintiff to show that the use of the two marks at the same time and in the same area in association with similar wares is likely to result in confusion.

4. That the name Snow Goose is confusingly similar to the plaintiff's trade mark Blue Goose but that the name Blue Hawk is not.

Action for infringement of patent and trade mark and for passing off.

The action was tried before the President of the Court at Toronto and Ottawa.

A. S. Patillo Q.C. and *A. J. MacIntosh* for plaintiff.

J. M. Godfrey for defendants.

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

THE PRESIDENT now (July 29, 1953) delivered the following judgment:

This is an action for infringement of the plaintiff's Canadian patent No. 343,728 dated August 7, 1934, for "badminton shuttlecocks and process of making same" brought against both defendants and for infringement of the plaintiff's trade mark "Blue Goose" and for passing off brought against the defendant Thornhill Industries Limited.

I shall deal first with the claim for infringement of the patent. The specification opens with the following statements:

This invention relates to Badminton Shuttlecocks and more particularly to the weighting thereof.

It is essential that Badminton Shuttlecocks be of consistent weight. A variation of 1 grain in the weight of a shuttlecock means an approximate variation of one foot in a full back line serve. Tests of leading imported makes show a variation in weight of as much as 7½ grains, with the result that expert players and tournament players make a practice of testing shuttlecocks before using them and rejecting those which are off weight. Frequently only eight or more shuttlecocks in a carton of twelve shuttlecocks made by ordinary processes are accepted for use by such players. It will, therefore, be seen that it is of the highest importance that there should be a minimum of variation in the weight of Badminton shuttlecocks.

The ordinary practice in weighting shuttlecocks is to make up the base and add sufficient weight to bring the base up to a predetermined weight, say 47 grains. The feathers, string and glue, size, lacquer or other adhesive or cement are then added to bring the completed shuttlecock up to the required total weight, say 77 grains. Owing to variations in the size and weight of the feathers and string and the amount of lacquer, adhesive or cement used, however, there is, as stated above, variation of from 7 to 8 grains in the total weight of the finished shuttlecock made by the ordinary methods of construction described above.

It is thus disclosed that the object of the invention was to attain a minimum of variation in the weight of badminton shuttlecocks, commonly called "birds", and the extent of the variation in the case of shuttlecocks made according to the ordinary practice whereby weight was added to the base before the feathers, string, glue and lacquer were added is pointed out.

Then the inventor declared that this large variation in weight is avoided by his construction whereby the weight is added after the base has been made up and the feathers added thereto as more particularly described and illustrated. Certain drawings are annexed to the specification and the inventor then describes his process in detail. His description with the omission of the numbers identifying the elements with those shown on the various figures of the drawings is as follows:

To the base, which is ordinarily of fine textured cork, is applied a kid covering extending to about ¼" from the top and which is suitably secured to the base by glue or other adhesive. The top and the upper end of the side walls are reinforced with a cap which may be made of strong textured pasteboard or kid. Besides forming a finish for the upper end of the base, this cap provides a firm surface through which to drill holes for receiving the quills or stems, feathers or other flight steadying devices, and the

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weight, as hereinafter described, and forms, a substantial support for the walls of the base which prevents splitting or breaking away when the holes are being drilled or when the feathers are struck when the shuttlecock is used in play.

A plurality of holes or receptacles for the feathers are bored preferably by an automatic multiple drill around the periphery of the top of the base. This drill has a tolerance of approximately only $\frac{1}{1000}$ of an inch, and each hole is substantially identical in length, width and angle in order to ensure a perfect setting for each feather.

In the center of the top of the base there is now drilled a cylindrical hole, cavity or receptable in practice measuring about $\frac{1}{4}$" x $\frac{3}{8}$".

The feathers which have previously been washed, bleached and treated, and stamped out in uniform size and shape, are then assembled in jigs to secure proper alinement and setting, and their stems or quills are inserted in the holes which have been bored in the base as above described.

The feathers are then stitched in a known manner by stitchings adjacent the base and approximately midway of the length of the feathers about 1" from the base.

The feathers are now lacquered, and the upper portion of the base at the junction of the cap and the kid covering is strapped with an adhesive ribbon. The shuttlecock is now placed on a highly sensitive weighing machine together with a frustro-conical plug, the diameter of the smaller end of which is substantially the same as the diameter of the central hole and the diameter of the larger end of which is slightly larger than the diameter of the hole, and the length of which is slightly less than the depth of said hole. The scale is counterbalanced by a weight which equals the desired total weight of the shuttlecock, usually about 77 grains. Weighting material in the form of fine lead pellets or other suitable material is then poured on to the scale until the shuttlecock, plug and weighting material balances the weight on the other pan of the scale. The shuttlecock is then removed and the weighting material poured into the central hole. Glue or cement is then applied to the hole and/or the plug which is then inserted with its smaller end first and forced into position with its top level with the top of the base and just below the cap. When the plug is forced in the hole the cork of the base is slightly expanded by the larger end of the plug. This causes pressure to be exerted against the ends of the feathers anchoring them more firmly in the base. The stiffly lacquered cap slightly overlaps the top of the plug and effectively prevents it from coming out of the hole. Over the top of the plug is then secured a seal of paper or similar thin material which seals the plug and the hole.

The centre of gravity of an unweighted shuttlecock is located substantially at the top of the base, where the weighting material is located in the conventional shuttlecock. It will be observed that according to my invention the weight is located below the centre of gravity which gives the shuttlecock a steadier flight.

It is clear from this description that the necessary weight required to bring the finished shuttlecock up to a predetermined weight is, except for a thin paper seal and a small amount of glue or cement, added last.

The specification ends with 14 claims of which the first 4 read as follows:

1. A process of making a shuttlecock, provided with a base and a flight steadying device, which consists in first securing the flight steadying device to the base, and then adding weighting material thereto.

2. A process of making a shuttlecock, provided with a base and a flight steadying device, which consists in first securing the flight steadying device to the base, then weighing the shuttlecock, and finally adding weighting material thereto to bring it up to a predetermined weight.

3. A process of making a shuttlecock, provided with a base and a flight steadying device, which consists in forming a cavity in the top of the base to receive weighting material, securing the flight steadying device to the base, inserting weighting material in the cavity, and applying a closure to said cavity.

4. A process of making a shuttlecock, provided with a base, and a flight steadying device, which consists in covering the base, forming a cavity in the top of the base, applying the flight steadying device, then inserting weighting material in the cavity, and finally closing the cavity.

The claims in suit which are alleged to have been infringed are claims 2, 3 and 4 but claim 1 is set forth because the defendant asks for a declaration under section 60 of The Patent Act, 1935, Statutes of Canada 1935, chapter 32, that the claims in suit and claim 1 are invalid.

Mr. D. H. Pollitt, the plaintiff's president and general manager and its chief witness, claimed that he was the inventor of the process covered by the patent in suit, the date of the invention being some time prior to March 14, 1934, the date of the specification. His evidence was that the plaintiff began to make shuttlecocks about the middle of 1933. At that time most of the shuttlecocks came from England, the only Canadian companies making them being the Badminton Manufacturing Company which made the Blue Goose shuttlecock, the National Games Company which was in the process of winding up and Spalding's in Brantford. According to Mr. Pollitt, in all cases where weight was added to a shuttlecock the addition was made before the feathers were applied and there were no shuttlecocks in which weight was added after the feathers were put on. There was a call at the time for a shuttlecock that was uniform and consistent in flight. Mr. Pollitt weighed shuttlecocks made by competitors, of whom he considered Ayers of England and the Badminton Manufacturing Company of Toronto the main ones, and found a substantial variation in weight. The English makers such as Ayers

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appeared to be more concerned with the spread of the feathers than with uniformity of weight but Mr. Pollitt considered that uniformity in the weight of shuttlecocks would make for uniformity and consistency of flight. It was while he was working on the problem of uniformity and consistency of flight that he devised his process of adding weight to a shuttlecock to bring it up to a predetermined weight and adding it last by putting it into a cavity and then closing the cavity. At first the cavity was made in the top shroud that covered the base but later the shroud was left off. I pass over all the various arrangements made by the plaintiff and the personal animosities that developed and come to 1947. In that year the defendant Slazengers Canada (1936) Limited sold a shuttlecock called the Falcon Crown, which had been made for it by the defendant Thornhill Industries Limited, and about six months later the latter defendant put out other shuttlecocks under the names Snow Goose, Blue Hawk and others. In all of these the necessary weight to bring the shuttlecock up to the desired weight was put into a well in the centre of a plastic crown on top of the cork base, the weight being added after the feathers had been assembled and the completed shuttlecock had been weighed. The plaintiff contended that the manufacture and sale of these shuttlecocks constituted an infringement of its patent and complained to the defendants accordingly.

In the course of his evidence Mr. Pollitt emphasized the fact that he added the necessary weight last in order to bring his shuttlecock up to a predetermined weight, but counsel for the plaintiff realized, of course, that there could not be an invention in the idea of adding the necessary weight last. There is nothing novel in such an idea. It has been embodied in several processes such as, for example, that of adding weight to a tennis racquet in order to bring it up to a desired weight. If there is any invention it must be in a particular process of adding weight last. This is what was claimed . This process is described in the specification and consists, to put it briefly, in making a cavity in the top of the cork, adding the requisite number of lead pelletts to bring the shuttlecock up to the predetermined weight and then closing the cavity with a plug and covering

it with a seal. Thus the addition of the weight is the last part of the process of manufacture, except for the closing of the cavity by the plug and covering it with a seal.

The defendant Thornhill Industries Limited attacked the validity of the patent for lack of novelty and lack of subject matter, as the English cases put it. In other words, it was contended that the invention was anticipated by prior publication and prior user of it and that no exercise of inventive ingenuity was required to bring it into existence. Both defendants denied infringement.

In support of the argument that the plaintiff's invention had been anticipated by a prior publication counsel for the defendants relied on United Kingdom patent No. 333,342, dated August 14, 1930, issued to N. E. Snow. *In The King* v. *Uhlemann Optical Company Limited* (1) I set out the requirements that must be met before an invention should be held to have been anticipated by a prior publication as follows:

> The information as to the alleged invention given by the prior publication must, for the purposes of practical utility, be equal to that given by the subsequent patent. Whatever is essential to the invention or necessary or material for its practical working and real utility must be found substantially in the prior publication. It is not enough to prove that an apparatus described in it could have been used to produce a particular result. There must be clear directions so to use it. Nor is it sufficient to show that it contained suggestions which, taken with other suggestions, might be shown to foreshadow the invention or important steps in it. There must be more than the nucleus of an idea which, in the light of subsequent experience, could be looked on as being the beginning of a new development. The whole invention must be shown to have been published with all the directions necessary to instruct the public how to put it into practice. It must be so presented to the public that no subsequent person could claim it as his own.

And I referred to *inter alia* to *Pope Appliance Corporation v. Spanish River Pulp and Paper Mills Ld.* (2) where Viscount Dunedin, at page 52, put the test in these words:

> Would a man who was grappling with the problem solved by the Patent attacked, and having no knowledge of that patent, if he had had the alleged anticipation in his hands have said, "That gives me what I wish"?

and later, at page 56:

> Does the man attacking the problem find what he wants as a solution in the prior so-called anticipations?

(1) [1950] Ex. C.R. 142 at 157. (2) [1929] R.P.C. 23.

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The requirements are thus seen to be very exacting. In my judgment, they are not met in the present case by the Snow patent. It is true that the process described in it is very similar to that described in the patent in suit as will be seen from the following description in the Snow patent specification:

> In the manufacture of the base of the shuttlecock, which base may be made of cork, cork composition, rubber, rubber composition or other material suitable for the purpose, I form a centrally-disposed cavity in said base, which opens at the top thereof and extends down beyond the centre of gravity of said base. Into said cavity are inserted metal (for instance lead) or other discs, or alternatively, pellets, flakes or the like, which are caused to lie at the bottom of said cavity, and constitute weighting means, the number inserted being such as to bring the total weight of the shuttlecock up to a predetermined standard. When the desired total has been thus obtained a plug of cork or other suitable material and which closely fits into the cavity, is inserted therein as far as possible so as to bear on the aforesaid weighting elements, and is secured in place by adhesive. The exposed end of said plug, which may be trimmed off if projecting, is finally covered by the kid or other covering material applied to the base so that the shuttlecock has an absolutely normal appearance.

While the process thus described is similar to the Pollitt process the Snow patent does not disclose that the weight required to bring the shuttlecock up to a predetermined weight is to be added last. This, in my opinion, disposes of it as an anticipation of the patent in suit.

I now come to the allegations of prior user of which there were said to be two instances. Mr. M. Fried who started the National Games Company in Toronto in 1929 said that they started manufacturing shuttlecocks in 1932, that at first they used lead discs like tinfoil for weighting them but found this process unsatisfactory and that later they came across the idea of using brass darts of three different sizes to bring the shuttlecocks up to the uniform weight demanded by the Badminton Association. Mr. Fried stated that after the shuttlecock was completely assembled they weighed it and then added the necessary weight to bring it up to the specified weight by pressing the proper sized dart right into the cork flush with the top of it and then covering it with an identifying seal or sticker. Mr. Fried said that he used this process late in January 1933. This was prior to the date of Mr. Pollitt's invention. Against Mr. Fried's statement there is the evidence of Mrs. Kilby who was employed in the National Games Company

plant to cut and sew feathers that the darts were put in under the kid shroud on top of the cork before the feathers were put on. And Miss Winston's evidence is to a similar effect. This is confirmed by the fact that the only samples of shuttlecocks made by the National Games Company with darts in them that were produced as exhibits showed that the darts had been put into the cork underneath the kid shroud. It is also significant that there were no samples of shuttlecocks made as Mr. Fried described produced at the trial. In my opinion, he was mistaken in his statement that the darts were added last and I reject it.

The second alleged prior user gives me more concern. Mr. S. Gillespie said that he started the Badminton Manufacturing Company in 1929, 1930 or 1931 and made shuttlecocks. His evidence was that after he had assembled the shuttlecock he inserted a tack in the centre to bring it up to the proper weight and covered it with a seal of tin foil. The tacks which he used were of different weights. He put the unweighted shuttlecock on a scale with the tin foil and then added a tack of the proper weight to bring the shuttlecock up to the predetermined weight. The tack was then inserted into the top of the cork with a plunger. Mr. Gillespie's evidence received support from Mr. F. Shuttleworth who said that he saw shuttlecocks on the premises of the Badminton Manufacturing Company with a tack put in the centre and covered with a seal. There were cartons of these shuttlecocks up to the ceiling. The tack was put in last except for the seal. And Mr. E. Purkis said that in 1935 he saw shuttlecocks with tacks put in last except for a covering label. He obtained samples of them from a person who had been manufacturing them, who must have been Mr. Gillespie. Mr. Purkis turned these over to his patent solicitor who died soon afterwards. Against this evidence there is the positive statement of Mrs. Kilby who was with Mr. Gillespie all the time that he was at the Badminton Manufacturing Company that the additional weights were applied before the feathers were put in and the evidence of Miss Winston that while she worked with the Badminton Manufacturing Company tacks were used under the kid shroud. There is also the statement of Mr. Morrow that the tacks were placed under the top shroud before the feathers were put on. But for the evidence of Mr. Purkis

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I would have no difficulty in not accepting the statements of Mr. Gillespie and Mr. Shuttleworth but the weight of his evidence is reduced by the fact that no sample of a shuttlecock with a tack put in the top was produced and there is no evidence that any one ever used such a shuttlecock. It is strange, if there was such a shuttlecock, that one of them did not find its way into Mr. Lawson's extensive collection. Under the circumstances, it seems to me that the Court ought not to invalidate a patent for prior user of the invention covered by it except on evidence that is more convincing than that in this case, even if the use of tacks last could otherwise be regarded as prior user of the invention in suit.

The attacks on the ground of anticipation of the invention by prior publication or by prior user, therefore, fail.

There remains the challenge of lack of subject matter but before I deal with it some of the claims in suit may be summarily disposed of. Claim 1 cannot stand. It is plainly too wide in that it purports to cover any process of adding weighting material to a shuttlecock after securing the flight steadying device to the base and is not even limited to adding weight for the purpose of bringing the shuttlecock up to a predetermined weight.

There was a difference of opinion regarding claim 2. Counsel for the defendants considered it the basic claim but counsel for the plaintiff conceded that it was too wide. I agree. It is narrower than claim 1 in that it is restricted to adding weight last to bring a shuttlecock up to a predetermined weight but it is too wide in that it covers any process by which weight is added last for such a purpose. The claim is not restricted to any particular process of adding weight last and is, in effect, tantamount to claim for the idea of adding weight last to bring the shuttlecock up to a predetermined weight. As already stated there is no novelty in this idea.

Claims 3 and 4 remain. These are limited to a particular process of adding the necessary weight last, namely, that of forming a cavity in the top of the base, inserting weighting material in it and closing it. Counsel for the plaintiff relied upon claim 4 as the basic one in that it specified the order in which the various steps are to be taken, namely, that a cavity is formed in the base and the

flight steadying device is applied, that then the weighting material is inserted in the cavity and that finally the cavity is closed. It should be noted that there is no reference in claims 3 or 4 to adding weight to bring the shuttlecock up to a predetermined weight and there is no indication otherwise as to the amount of weight that should be added. It will be seen that the process adopted by Mr. Pollitt is very similar to that which was disclosed in the Snow patent. Indeed, the Snow process would have been an anticipation of the Pollitt process except for the fact that in the latter the weight is added last or almost last. But although this difference is sufficient to prevent the Snow patent from being considered as an anticipation of the patent in suit it does not dispose of it entirely for the process of making a cavity, putting the weighting material in it and then closing it was disclosed by the Snow patent and was, therefore, not new. This raises the question whether the adding of the weight last or almost last can make the process, which was otherwise not a novel one, patentable, particularly since the idea of adding weight last to an object in order to bring it up to a predetermined weight is itself not a novel one. Counsel for the plaintiff realized, of course, that neither the particular process of adding weight by creating a cavity, putting the weight into it and then closing it nor the idea of adding the weight last was novel but contended that claim 4 was a combination claim and that although the elements in the combination were not new the combination itself was new. It is, of course, not necessary to the validity of a combination invention that its elements should be new. Indeed, all of them may be old. If it is the combination that is the invention it is immaterial that the elements are old: *vide British United Shoe Machinery Company Ld.* v. *A. Fussell & Sons Ld.* (1); *Baldwin International Radio Co. of Canada Ltd.* v. *Western Electric Co. Inc. et al* (2); Terrell on Patents, 8th Edition, pages 78-81. In *The King* v. *American Optical Co.* (3) I summarized the tests of a valid combination invention as follows:

> It is essential to the validity of a patent for a combination invention, apart from considerations of novelty and inventive ingenuity, that the combination should lead to a unitary result rather than a succession of results, that such result should be different from the sum of the results

(1) (1908) 25 R.P.C. 631 at 656, 657. (2) [1934] S.C.R. 94 at 104.
(3) [1950] Ex. C.R. 334 at 355.

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of the elements and that it should be simple and not complex. The elements may interact with one another provided they combine for a unitary and simple result that is not attributable to any of the elements but flows from the combination itself and would not be possible without it.

Even if it be conceded that the combination claimed by the plaintiff meets these tests and that a unitary result did flow from the combination, namely, shuttlecocks of greater uniformity of weight than those produced by previous process, and even if it be admitted that there was novelty in the combination, if the evidence as to the last use of darts or tacks to bring shuttlecocks up to a predetermined weight is not accepted, in that prior to the invention there had never been a process whereby weight was added to a shuttlecock to bring it up to a predetermined weight by putting the weight into a cavity and doing so last except for the closing of the cavity, this is not enough. It must also be shown that in addition to the combination being a novel one it required the exercise of inventive ingenuity to bring it about. In my opinion, this essential requirement is missing in the present case. The idea of adding weight last to an object in order to bring it up to a predetermined weight is an obvious one. That being so, it seems to me that any person skilled in the art and having the knowledge which such a person ought to have, including the knowledge of the process disclosed in the Snow patent, would in the course of working on the problem of producing shuttlecocks of uniform weight obviously adopt the Snow patent process and add the necessary weight last or almost last. Moreover, if Mr. Pollitt started with the idea of attaining the desired uniform weight by adding the necessary weight last and knew of the other methods of applying weights, as a person skilled in the art should have done, it seems to me that he would obviously select the Snow patent process as the one to adopt for the purpose of adding the necessary weight last or almost last.

Under the circumstances, I find no difficulty in concluding that claim 4 is invalid for the reason that it did not require any inventive ingenuity to devise the combination covered by it. The claim falls for lack of subject matter. And claim 3 falls with it.

Counsel for the plaintiff relied upon the commercial success of the shuttlecock produced by the process covered by the patent as evidence of invention. The circumstances under which the commercial success of a new device may be regarded as evidence of invention are set out in *The King* v. *Uhlemann Optical Company* (1) and *The King* v. *American Optical Company* (2). In my opinion, the evidence of the commercial success of the plaintiff's shuttlecock falls far short of the kind of evidence required. Mr. Pollitt said that the plaintiff survived in a very competitive field, that English makes of shuttlecocks had been selling to the trade at $54 or $55 per gross but that by 1935 the plaintiff's shuttlecocks had brought the price down to $28.50, that the plaintiff and its licensee had become the only manufacturers in Canada and supplied 90 per cent of the Canadian consumption, that the plaintiff did the greater portion of the shuttlecock business in New Zealand and sold extensively in the United States and that the plaintiff's pre-eminence continued during and after the war. The survival of the plaintiff is of little importance. Mr. Pollitt considered Ayers and the Badminton Manufacturing Company the plaintiff's only serious competitors and the evidence is that the former passed out of the picture in Canada because of defective sales organization and that the plaintiff bought out the latter. Moreover, there is no substantial evidence that serious work was being done on the problem that Mr. Pollitt was dealing with. Mr. Pollitt said that to his knowledge nobody was working on it. The English manufacturers were more concerned with securing consistency of flight by the spread of wings than by seeking uniformity of weight and the plaintiff's device has not been adopted in England. And I have already commented on the alleged efforts in Canada to deal with the problem. Moreover, the plaintiff's success such as it was may be due to reasons that have nothing to do with the question of invention, such as the substantial reduction in the price of the shuttlecocks and the plaintiff's superior organization and merchandising ability.

(1) [1950] Ex. C.R. 142 at 163; [1952] S.C.R. 143 at 152.

(2) [1950] Ex. C.R. 344 at 367.

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In view of the finding that the claims in suit are invalid it is not necessary to deal with the evidence relating to infringement for there can be no infringement of an invalid patent.

The plaintiff's action must, therefore, so far as it relates to infringement of the plaintiff's patent be dismissed with costs as against both defendants and the defendant Thornhill Industries Limited is entitled to a declaration that claims 1 to 4 inclusive of the patent in suit are invalid.

The plaintiff's claim for infringement of its trade mark "Blue Goose" may be dealt with briefly. This trade mark was originally registered by the Badminton Manufacturing Company on March 14, 1934, as No. N.S. 2796 in Register 8 and used by it in association with its shuttlecocks. In 1936 the Badminton Manufacturing Company sold its assets, including the goodwill of its business and its trade mark, to the plaintiff and on July 27, 1936, the plaintiff became its registered owner pursuant to an assignment dated July 21, 1936. Since then the plaintiff has used the trade mark "Blue Goose" on the shuttlecocks made and sold by it and it is recognized by the trade as being associated with the plaintiff's products. The validity of the trade mark and the plaintiff's title to it are not challenged.

In the late summer of 1948 the defendant Thornhill Industries Limited put out several shuttlecocks under various names one of which was Snow Goose and another Blue Hawk. Mr. Miller explained that these names had been taken out of books on ornithology. On September 17, 1948, the plaintiff's solicitors wrote to the defendant claiming that the use of the names infringed the plaintiff's trade mark. Thereupon, the defendant almost immediately discontinued and abandoned the use of the name Snow Goose but continued to use the name Blue Hawk for a few months. The evidence is that it discontinued and abandoned the use of the name Snow Goose in October, 1948, and that the last sale of a shuttlecock under the name Blue Hawk was on April 20, 1949. Notwithstanding these facts the plaintiff continued the proceedings as, of course, it was entitled to do.

It is well established that in an action for infringement of a trade mark by the use of a similar mark the plaintiff must show that the use of the two marks at the same time

and in the same area in association with similar wares is likely to result in confusion of the kind referred to in section 2(*k*) of The Unfair Competition Act, 1932, Statutes of Canada 1932, chapter 38. The onus is on the plaintiff to show reasonable probability of such confusion: *vide Pepsi-Cola Company of Canada Limited* v. *Coca-Cola Company of Canada Limited* (1). There was no evidence of actual confusion. Indeed, Mr. S. S. M. Lawson said that he would not be misled and he did not know of any confusion. When the defendant brought out its shuttlecock under the name Snow Goose he was not struck with the similarity between it and the name Blue Goose which he associated with the plaintiff but he fairly explained that he would not be confused because of his familiarity with shuttlecocks. But evidence of actual confusion is not necessary. The tests of similarity of trade marks have been dealt with in many cases, one of the latest in this Court being *Freed & Freed Ltd.* v. *Registrar of Trade Marks et al* (2) where several of the leading cases were referred to. There it was stated that the proper test to be applied has been laid down by high authority and reference was made inter alia to *Aristoc, Ld.* v. *Rysta, Ld.* (3) in which the House of Lords decided that the question whether two marks are similar must be answered by the judge on whom the responsibility lies as a matter of first impression. This test was expressly approved by the Supreme Court of Canada in *Battle Pharmaceuticals* v. *The British Drug Houses Ltd.* (4). While it may be easier to apply the test of first impression to single words, such as those in question in the *Aristoc* case (*supra*), than to word marks consisting of more than one word the principle is the same.

Applying this test and with full appreciation of the subjective approach involved in it I have reached the conclusion that the name Snow Goose is confusingly similar to the plaintiff's trade mark "Blue Goose" but that the name Blue Hawk is not.

In the course of the hearing counsel for the defendant stated that he was prepared to consent to an injunction against the use of the words Snow Goose or Blue Hawk without any enquiry as to damages or costs. If the plaintiff

(1) [1940] S.C.R. 17 at 32.
(2) [1950] Ex. C.R. 431.
(3) [1945] A.C. 68.
(4) [1946] S.C.R. 50 at 53.

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so elects it may have judgment to that effect. But otherwise, there will be judgment dismissing the plaintiff's claim for infringement of its trade mark so far as the use of the name Blue Hawk is concerned but allowing it in respect of the use of Snow Goose with an injunction restraining such use and an enquiry as to damages, if the parties are not able to agree on an amount, and judgment accordingly. In respect of this portion of the plaintiff's case the plaintiff is entitled to costs as against the defendant Thornhill Industries Limited, which I fix at the sum of $100 inclusive of disbursements and the costs of the inquiry if it is proceeded with, such costs to be offset against the costs of the action for infringement of the patent.

There is no evidence, in my opinion, sufficient to justify any finding of passing off.

There will, therefore, be judgment dismissing the plaintiff's claim for infringement of its patent as against both defendants with costs but with only one set of counsel fees and declaring claims 1 to 4 inclusive of the patent invalid and, if the plaintiff does not elect to accept the defendant's offer, judgment in respect of the claim for infringement of its trade mark as stated.

Judgment accordingly.