BETWEEN:

WHITEHALL LABORATORIES LIMITED ..... APPELLANT;

AND

ULTRAVITE LABORATORIES LIMITED ..... RESPONDENT.

1963
Oct. 15
1964
Mar. 11

Trade Marks—Registration—Trade Marks Act, S. of C. 1952-53, c. 49, ss. 12(1)(d) and 6(5)(e)—Confusion—First impression as criterion of confusion.

This is an appeal by Whitehall Laboratories Limited, from the decision of the Registrar of Trade Marks allowing the registration of the trade mark "Dandress" by the respondent over the opposition of the appellant which alleged that the said trade mark was confusing with its already registered trade mark "Resdan" and was accordingly not registrable.

Held: That the decisive criterion as to the existence of confusion between two trade marks is one of first impression.

2. That the trade marks "Resdan" and "Dandress" sound phonetically confusing at least on first impression.

3. That the appeal is allowed.

APPEAL from a decision of the Registrar of Trade Marks.

The appeal was heard by the Honourable Mr. Justice Dumoulin at Ottawa.

Cuthbert Scott, Q.C. for appellant.

Roy Saffrey for respondent.

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

DUMOULIN J. now (March 11, 1964) delivered the following judgment:

The above mentioned appellant, assignee of the registered trade mark "RESDAN", opposed the respondent's application for registration of "DANDRESS" as another trade mark, under serial No. 259-985.

On February 7, 1962, the Registrar of Trade Marks rejected this opposition, having arrived at the conclusion "that the two marks in their totalities are not confusing

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and that their concurrent use in the same area would not be likely to lead to the inference that the wares emanate from the same person".

From this decision, the Whitehall Laboratories Ltd., appeal to this Court.

Three grounds of appeal were put forward on the opponent's behalf, of which two, namely paragraphs 1 and 2, need be retained. Paragraph 1 is as follows:

> (1) That under the provisions of Section 37(2)(*b*) of the *Trade Marks Act*, the word DANDRESS is not registrable as offending the provisions of section 12(1)(*d*) of the Act, and accordingly should be refused registration by virtue of the provisions of Section 36(1)(*b*) of the Act.

The opening lines of paragraph 2 state that:

> (2) Section 12(1)(*d*) enacts that where a word or mark is confusing with a registered trade mark it is not registrable . . .

These quotations are taken from the Registrar of Trade Marks' file on which the respondent relied in support of its contestation of the appeal.

Reverting now to the subject matter, the gist of the problem consists in the correct application of section 12(1)(*d*) which enacts that:

> 12. (1) Subject to section 13, a trade mark is registrable if it is not
> . . .
> *d*) confusing with a registered trade mark;
> . . .

One of the main objects pursued by the *Trade Marks Act* is the avoidance of confusion between trade names or trade marks, so that the public may be protected against deception or misrepresentation.

It would be, of course, utterly impossible to define the ever-changing guiles resorted to by unfair trade competition, wittingly or unwittingly. Section 6, s-s. (5)(*e*) of our *Trade Marks Act*, 1-2 Elizabeth II, c. 49(1953), suggests certain norms with which the Court should comply when examining the possibility of confusion and I quote:

> 6. (5) In determining whether trade marks or trade names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including
> . . .
> *e*) the degree of resemblance between the trade marks or trade names in appearance or sound or in the ideas suggested by them;
> . . .

In other words, it has been held, as will be seen hereunder, by the highest legal authorities, that the decisive criterion was one of first impression.

The late Mr. Justice Kerwin, as he then was, speaking for the Supreme Court of Canada, *in re Battle Pharmaceuticals v. The British Drug Houses Ltd.*[1], expressed himself thus on this issue:

> The principle adopted by the House of Lords on that point is the same as has governed this Court in proceedings under section 52 of *The Unfair Competition Act* and it is found in a passage in the dissenting judgment of Lord Justice Luxmoore in the Court of Appeal, which was accepted in the House of Lords by all the peers as a fair statement of the duty cast upon the court. The passage referred to appears in the speech of Viscount Maugham at page 86 of the report:
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> > "The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of s. 12 of the *Trade Marks Act*, 1938, must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word, and has perhaps an imperfect recollection of it, who is likely to be deceived or confused. Little assistance, therefore, is to be obtained from a meticulous comparison of the two words, letter by letter and syllable by syllable, pronounced with the clarity to be expected from a teacher of elocution. The Court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to that person's wants."
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> Applying that principle to the case at bar, we are satisfied that the President of the Exchequer Court came to the right conclusion.

The British decision alluded to above was that of *Aristoc Ltd. v. Rysta Ltd.*[2], delivered on December 8, 1944, in the House of Lords.

In the opinion of the Court, the trade styles "RESDAN" and "DANDRESS" sound phonetically confusing at least on first impression and such is the applicable touchstone.

For the reasons above, I reach the conclusion that the appellant's opposition should be allowed and the decision of the learned Registrar of Trade Marks of February 7, 1962, set aside. The appellant (opponent) will be entitled to recover its costs after taxation.

Judgment accordingly.

[1] [1945-1946] S.C.R. 50 at 53.

[2] (1945) 62 R.P.C. 65 at 72.