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Sept. 1.

JOHN DEKUYPER & SON.....PLAINTIFFS;

AND

VAN DULKEN, WIELAND & COMPANY..... } DEFENDANTS.

Trade-Mark—Rectification of register—Relief for infringement—Jurisdiction of Exchequer Court, 54-55 *Vic. c.* 35 *and* 54-55 *Vic. c.* 26.

The court has jurisdiction to rectify the register of trade-mark in respect of entries made therein without sufficient cause either before or subsequent to the 10th day of July, 1891, the date on which the Act 54-55 Vic. c. 35 came into force.

Quære? Has the Court jurisdiction to give relief for the infringement of a trade-mark where the cause of action arose out of acts done prior to the passage of 54-55 Vic. c. 26?

DEMURRER to a statement of claim whereby relief was sought for the purpose of cancelling the registration of a trade-mark.

The questions arising upon the demurrer are stated in the judgment.

June 21st, 1892.

Ferguson, Q.C. (with whom was *Duhamel*) in support of the demurrer: The Court has no jurisdiction to rectify any entry made prior to the 10th July, 1891, and the registration of the defendants' trade-mark was made in 1884. Whatever jurisdiction the court has in this matter has to be derived from the *Trade-Mark and Design Act* of 1891 (54-55 Vic. c. 35) and not under *The Exchequer Court Amendment Act*, 1891. The former Act is not retrospective in its operation. Up to 1891 this court had no power to compel the Minister of Agriculture to rectify the registration of any trade-mark duly made. With reference to the relief sought for the alleged infringement, I submit that the fact that the person aggrieved always had a convenient remedy in the

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provincial courts is one of the very strong reasons to urge against any retroactive effect being given to the new Act. The defendants have acquired a vested right under the old law to have the case tried by jury, and it ought not to be interfered with unless such interference is clearly and expressly authorized by the legislature. (Cites *Wilberforce on Statutes* (1); *Maxwell on Statutes* (2); *re Suche* (3); *Kimbray* v. *Draper* (4); *Endlich on Statutes* (5); *Hardcastle on Statutes* (6); *Ings* v. *Bank of P. E. Island* (7); *Fisher's Digest* (8); *Coats* v. *Kelly* (9).

Again, the plaintiffs have not alleged anything to show that the registration of the defendants' trade-mark was made without sufficient cause, and they have, consequently, not put themselves within the benefit of the remedy provided for by section 1 (12) of 54-55 Vic. c. 35.

Christie, Q.C. *contra.*

The plaintiffs have a remedy in this court, either under 54-55 Vic. c. 35, or under 54-55 Vic. c. 26. The defendants have acquired no property by their registration of the trade-mark. It was laid down in the case of *Partlo* v. *Todd* (10), that the fact of ownership is a condition precedent to the right to register under *The Trade-Mark and Design Act*, and that if the party registering is not the owner he obtains no advantage by such registry and it may be cancelled. It is the very fact of lack of proprietorship on the part of the defendants that makes their registration a registration without sufficient cause within the meaning of the statute. We have a clear right

(1) Pp. 161, 244.
(2) Pp. 257, 357.
(3) 1 Ch. Div. 50.
(4) L.R. 3 Q.B. 160.
(5) P. 367.
(6) P. 195.
(7) 11 Can. S.C.R. 265.
(8) Vol. 6. col. 2022.
(9) 15 Ont. App. 81.
(10) 14 Ont. App. 444; 17 Can. S. C.R. 196.

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under the statutes and authorities to an injunction restraining defendants from the use of the trade-mark, and also to damages for the infringement. Cites *Bondier* v. *Depatie* (1); *Sebastien on Trade-Marks* (2); *Smith* v. *Fair* (3); *The Henrich Bjorne* (4).

Ferguson, Q.C., in reply: Plaintiffs do not allege that they are the owners of our trade-mark. In their pleadings they set out two trade-marks that are not the same. Clearly there cannot be an order pass to cancel our registration in view of this fact, and if there has been an infringement of the plaintiffs' trade-mark, the cause of action in respect thereof arose prior to the passing of the statutes under discussion.

BURBIDGE, J. now (September 1st, 1892) delivered judgment.

The determination of the questions raised by the demurrer to the statement of claim in this case depends upon the construction to be given to certain provisions of two Acts of the Parliament of Canada, passed in the year 1891, to which I shall presently refer.

By the second clause of the 11th section of *The Trade-Mark and Design Act* (5) it was in substance provided that errors in registering trade-marks and oversights in respect to conflicting trade-marks might be corrected by the Minister of Agriculture, who for such purpose was to cause all persons interested in the matter to be notified to appear before him, in person or by attorney, with their witnesses. By the 21st section of the Act he had authority to correct clerical errors in the drawing up or copying of any instrument made under the preceding sections of the Act, and there can, I think, be no doubt that the power of rectification given by

(1) 3 Dor. 233.
(2) Chap. vi.
(3) 14 Ont. 729.
(4) 11 App. Cas. 270.
(5) R. S. C. c. 63 s. 11 (2).

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the 11th section was intended to be and was a substantial power. By virtue of it he might have determined the right to the exclusive use of a trade-mark in any case where, through some error or oversight, two persons had obtained registration of the same trade-mark, and I see no reason why, at the instance of a person interested, he might not have entertained an application to expunge from the registry an entry that ought not to have been made, and which, but for some error or oversight would not have been made therein.

By the Act of 53 Victoria, chapter 14, the jurisdiction theretofore vested in the Minister of Agriculture to determine, in certain cases, the right to the exclusive use of a trade-mark was transferred to this court; and by the 3rd section of the Act it was provided that errors in registering trade-marks, and oversights in respect to conflicting registration of trade-marks, might be corrected in this court upon proceedings instituted therein in the manner provided in the first section of the Act. It happened, however, that the manner of proceeding in the court, so far as the Act dealt with procedure, was defined in the second and not in the first section thereof. That was one difficulty. Then the only jurisdiction clearly conferred upon the court was the authority to determine, in a proper case, the question of the right to the exclusive use of a trade-mark, and in the case of *The Queen* v. *Van Dulken* (1), which was in reality a proceeding between the parties to this action, I held that the court had, as the law then stood, no jurisdiction to determine questions as to whether or not a trade-mark ought not to be registered or continued on the registry because it was calculated to deceive the public, or for such other reasons as were mentioned in the 12th section of the Act (2).

(1) 2 Ex. C. R. 304.

(2) R. S. C. c. 63 s. 12.

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The Act 53rd Victoria, chapter 14, was repealed by 54-55 Victoria, chapter 35, and other provisions substituted therefor.

By the latter Act it was provided :—

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11. The Minister of Agriculture may refuse to register any trade-mark in the following cases :—

(*a.*) If he is not satisfied that the applicant is undoubtedly entitled to the exclusive use of such trade-mark ;

(*b.*) If the trade-mark proposed for registration is identical with or resembles a trade-mark already registered ;

(*c.*) If it appears that the trade-mark is calculated to deceive or mislead the public ;

(*d.*) If the trade-mark contains any immorality or scandalous figure;

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

2. The Minister of Agriculture may, however, if he thinks fit, refer the matter to the Exchequer Court of Canada, and in that event such court shall have jurisdiction to hear and determine the matter, and to make an order determining whether and subject to what conditions, if any, registration is to be permitted.

It will be observed that to give the court jurisdiction in such a case there must be an application to register a trade-mark, the Minister must refuse to register, and he must refer the matter to the court. But the statute does not stop there. By a subsequent provision (1), in terms substantially identical with those used in the 90th section of the English Act (2) to define the jurisdiction of the High Court of Justice, the Exchequer Court is given power, on the information of the Attorney-General or at the suit of any person aggrieved by any omission without sufficient cause to make any entry in the register of trade-marks, or by an entry made therein without sufficient cause, to make such order for making, expunging or varying the entry as it thinks fit. By another Act passed in the same session (3) the court was amongst other things given

(1) 54-55 Vic. c. 35 s. 1 (12). (2) 46-47 Vic. c. 57 s. 90 (1).
(3) 54-55 Vic. c. 26 s. 4.

jurisdiction as well between subject and subject, as otherwise, in all cases of conflicting applications for the registration of any trade-mark, or in which it is sought to have any entry in any register of trade-marks made, expunged, varied or rectified, and in all other cases in which a remedy is sought respecting the infringement of any trade-mark. The Act 54-55 Victoria, chapter 35, came into force on the 10th July, 1891, and 54-55 Victoria, chapter 26, on the 30th of September of the same year.

The objections raised by the demurrer are that the court has no jurisdiction :—

1. To rectify any entry made in the registry of trade-marks prior to the 10th July, 1891, or—

2. To give any other relief where the infringement complained of happened before the 30th of September of that year.

First, in respect to the rectification of the registry of trade-marks there is no question that the jurisdiction conferred should in its exercise be limited to entries made after the statute came into force, unless it is clear, as I think it is, that Parliament intended the statute to apply to entries then already made. There is nothing in its language to show a contrary intention The court may make, it is enacted, an order respecting an entry made in the register of trade-marks, without sufficient cause (1), and it is to have jurisdiction in all cases in which it is sought to have any entry therein made, expunged, varied or rectified (2). This power of rectification was not in 1891 a new one. It had been exercisable by the Minister of Agriculture since 1868 (3), and the object of Paliament was to transfer that power to the court, and perhaps to define it somewhat more explicitly, and to remove the doubts

(1) 54-55 Vic. c. 35 s. 1 (12.) (2) 54-55 Vic. c. 26 s. 4.
(3) 31 Vic. c. 55 s. 6.

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that had arisen as to the meaning of the Act of 1890. To apply the jurisdiction in question to cases where entries had been made before the 10th of July is not to interfere with any vested right, for the Act did not in this respect do more than substitute one tribunal for another, and no one could be said, I think, to have had any vested right to have his controversy determined in a proceeding before the Minister of Agriculture. On the other hand to limit the jurisdiction to entries made in the register subsequently to July 10th, would be to take away and destroy the remedy that any person aggrieved by an earlier entry would otherwise have had for the protection of his rights. I am, therefore, of opinion that the jurisdiction of the court in respect of the rectification of the register of trade-marks may be exercised in respect of any entry made therein without sufficient cause, as well where such entry was made before the coming into force of the amending Act of 1891, as where it was made afterwards.

The second objection is not so much to the jurisdiction of the court as to the character and extent of the relief that may be given to the plaintiffs, in case they are found to be entitled to relief. It is alleged in substance that the infringement complained of was continued during the year 1891, and consequently at a date subsequent to the passing of the Acts of that year to which reference has been made. At present, therefore, it is not necessary to express any opinion as to the court's jurisdiction where in the case of an infringement of a trade-mark the cause of action arises out of acts done prior to September, 1891; though there is not wanting, it may be added, precedents for the exercise of jurisdiction in an analogous case (1).

(1) *The Alexander Larsen*, 1 *Wm. Rob.* 288; *The Ironsides*, 1 *Lush*, 458.

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There will be judgment for the plaintiffs on the demurrer to the statement of claim, and with costs, upon payment of which the defendants may amend and plead.

Judgment accordingly.

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Solicitors for plaintiffs: *Christie, Christie & Greene.*

Solicitors for defendants: *Duhamel & Merrill.*