

In re

GEBR NOELLE'S application for an Order to register
the word *Albaloid* as a GENERAL TRADE MARK.

1913
Oct. 23
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*Trade-mark and Design Act (R.S. 1906, ch. 21, secs. 4 (a) and (b)—Interpretation—
General and Specific Trade-Marks—Definition.*

Under the language of sec. 4, sub-sec. (a) of the *Trade-Mark and Design Act* (R.S. 1906, ch. 71) a general trade-mark means a trade-mark used in connection with the various articles in which the proprietor deals in his trade, and may cover several classes of merchandise if the proprietor is trading in such several classes.

On the other hand, under sub-section (b), a specific trade-mark is limited to a class of merchandise of a particular description, so if the applicant deals in two different classes of merchandise he must apply for two specific trade-marks, one applicable to each class.

- (2) While a general trade-mark covers all the classes of merchandise in which the applicant deals, and when registered prevents any subsequent registration of the same subject-matter as a general trade-mark, it would not confer an unlimited right to the mark the world over as against anyone carrying on an entirely different business who applies for a specific trade-mark consisting of the same mark as applied to goods of a different character not manufactured by the owner of the general trade-mark.

THIS was a petition for an order to register the word "Albaloid" as a general trade-mark in Canada, an application to the Minister of Agriculture to register the same having been refused.

The facts are stated in the reasons for judgment.

W. L. Scott, for the petitioner, contended that the two marks do not conflict, that is to say "Albaloid" and "Albolene." There is nothing in the Act limiting a general trade-mark to the registration by one party, that is to say, there may be two general trade-marks registered by two different people, provided they deal in different classes of goods.

He cited: *Batt v. Dunnet* (1), *In re Lake & Elliott's Trade-Mark* (2), *Somerville v. Schembri*, (3), *Singer*

(1) (1899) 16 R. P. C., 413.

(2) (1903) 20 R.P.C. 605.

(3) (1887) 12 A. C. 457.

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Manuf. Co. v. Wilson (1), *Maxwell v. Hogg* (2), *Edwards v. Denis* (3).

R. V. Sinclair, K.C., for the Minister of Agriculture, submitted that the cases cited by counsel were all with respect to specific trade-marks. There is no such thing known under English statute law as a general trade-mark. Every trade-mark acquired under that law is a specific trade-mark. Parliament has declared that there may be two kinds of trade-marks in Canada, one specific and one general. It would be well to contrast the effect of section 16 with sub-section (a) of section 4, of the *Trade Mark and Design Act*. There was no such thing as a general trade-mark in Canada before the statute was passed, and the question is how far it has limited it. There have been no cases which dealt with the consideration of the section in the Canadian courts—and in none of the other countries is there such a thing as a general trade-mark. There is no help to be gained from any of the decisions cited. The definition of a general trade-mark means a trade-mark used in connection with the sale of various articles in which the proprietor deals in his trade, occupation, business or calling. But even under our statute, the proprietor does not obtain an absolutely general trade-mark *per se*, but it is limited to the class of business in which he is dealing.

CASSELS, J., now (October 23rd, 1913) delivered judgment.

This was a petition for an order to register the word "Albaloid" as a general trade-mark in the trade-mark register in the Department of Agriculture.

In the month of September, 1910, the petitioner applied to the Minister of Agriculture to have registered the word "Albaloid" as a general trade-mark.

(1) (1876) 2 Ch. D. 443.

(2) (1867) 2 Ch. 314.

(3) (1885) 30 Ch. D. 454.

This application was refused, the ground of the refusal being that as appears by the registry the word "Albolene" had been registered as a general trade-mark on the 31st day of May, 1893, by a firm carrying on business in New York of the name McKesson & Robbins.

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It is not contended that the word "Albaloid" could be registered with the word "Albolene" previously registered as a general trade-mark, if the question merely depended on the register and without further evidence.

Under clause 11, sub-sec. (b) of the *Trade-Mark and Design Act*, the application was rightly rejected.

The minister or his deputy has no means of ascertaining except from the registry whether such trade-mark should or should not be registered. There is no power in the statute regulating trade-marks which enables the minister or his deputy to take evidence, and adjudicate on the facts and to determine whether, having regard to the particular circumstances of the case, such trade-mark should be registered or not.

On the hearing of this petition it is open to the court to receive evidence and adjudicate on the merits, having regard to the circumstances of the case.

The facts are shortly, as follows:—

McKesson & Robbins who registered as a general trade-mark the word "Albolene" on the 31st day of May, 1893, were carrying on and are still carrying on in the city of New York the general business of wholesale dealers in drugs, chemicals and druggist sundries of all kinds.

The applicants who reside in Germany have for a great number of years been exporting to Canada articles of their manufacture, being "forks and spoons made of Britannia metal," a class of merchandise entirely

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different from the classes of merchandise dealt in by the owners of the registered trade-mark "Albolene."

It would appear that the applicants have registered in England and elsewhere the word "Albaloid" as their trade-mark. It does not appear that this word has been registered in these countries as a general trade-mark, and I am not aware whether the statutes in these various countries contain the same provisions as in our statute, enabling the registration of a general trade-mark as distinguished from a specific trade-mark.

These foreign trade-marks are not produced. I gathered from Mr. Scott's careful argument that the clause of our statute permitting a registration of a general trade-mark is unique.

Under the *Imperial Trade-Marks Act, 1905*, sec. 8, it is provided that "A trade-mark must be registered in respect of particular goods or classes of goods."

Section 16 of the *Canadian Trade-Mark and Design Act* (R. S. 1906, ch. 71), provides that:—

"A general trade-mark once registered and destined to be the sign in trade of the proprietor thereof shall endure without limitation."

The definition of a trade-mark as given by Mr. Lowe, Deputy Minister of Agriculture, in the case of *Bush v. Hanson* (1) is that the essential element of a trade-mark is the "universality of right to its use, *i.e.*, the right to use it the world over as a representation of, or substitute for, the owner's signature."

Mr. Paul, in his work on Trade-Marks, (2) puts it in this way, "It has been well defined as one's commercial signature."

Mr. Scott argued before me that the same rules should be applied to a general trade-mark as those held to apply in the case of specific trade-marks.

(1) (1888) 2 Ex. C. R. 557.

(2) Ed. 1903, p.5.

That if in the case of a specific trade-mark a mark already registered as a specific trade-mark can be taken by another and registered and used as a specific trade-mark for an entirely different class of merchandise, so in the case of a general trade-mark registered in connection with a general class of business another person can register and use the same general trade-mark in connection with an entirely different class of business.

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There is no authority on the point and the question is one of considerable difficulty. My own view is that there is a distinction between the case of a general trade-mark and that of a specific trade-mark.

I am of opinion that once a general trade-mark has been registered for a particular word, the same word cannot be registered as a general trade-mark by any one else. If this were permitted it would lead to confusion. I think the second applicant is limited to an application for a specific trade-mark if otherwise entitled thereto.

The purpose and object of trade-mark legislation is stated by Vaughan Williams, L.J., in *Bowden Wire, Limited, v. Bowden Brake Co., Ltd.*, (1) as follows:—

“The whole object of registering trade-marks is this that in passing off cases it was found that a great deal of trouble and expense might be incurred in proving the identity or character of the goods which were passed off with the goods which the plaintiff said were the goods manufactured or sold—in this case manufactured by them. Then the *Trade Marks Act* was passed for the express purpose of making it easy to afford protection to traders at less expense and less trouble. The whole object is that by registering a trade-mark you should be able to represent to the public: ‘You may rely upon it that all goods which

(1) (1913) 30 R.P.C. 590.

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bear this registered trade-mark are the goods manufactured or sold by me the registered proprietor of the mark.' "

A few other cases bearing on the question, all of them relating practically to specific trade-marks as distinguished from what our statute permits as a general trade-mark, are as follows:—

In *Re Jelley, Son & Jones' Application*, (1) the judgment of Jessel, M. R., may be referred to.

In the case of the *Singer Manufacturing Co. v. Wilson*, (2) Jessel, M. R., discusses the question, as follows:—

"Therefore, what the Court has to satisfy itself of is, that there has been an essential portion of the trade-mark used to designate goods of a similar description. I say of a similar description, because there is no right in a trade-mark except to protect the manufacturer of the goods. If a seller of carriages invented this fanciful mark, this curious animal, and put it on carriages, that would not prevent a manufacturer of woolen goods from putting it as a trade-mark on woolen goods. As I said before, you must have regard, not merely to the mark, but to the nature of the goods upon which the mark is impressed."

In *Somerville v. Schembri* (3), Lord Watson states as follows:—

"Had it not been for the views expressed by the Court of Appeal in giving judgment, it would hardly have been necessary for their Lordships to observe that the acquisition of an exclusive right to a mark or name in connection with a particular article of commerce cannot entitle the owner of that right to prohibit the use by others of such mark or name in

(1) (1878) 51 L. J. Eq. 640.

(2) (1876) 2 Ch. D. 434. at p. 443.

(3) (1887) 12 A. C. p. 457.

connection with goods of a totally different character; and that such use by others can as little interfere with his acquisition of the right."

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I will come now to the consideration of the Canadian *Trade-Mark and Design Act.* (R.S. 1906, ch. 71).

Section 4 of the statute is the interpretation clause. It provides as follows:—

"(a) In this part unless the context otherwise requires—'general trade-mark' means a trade-mark used in connection with the sale of various articles in which a proprietor deals in his trade, business, occupation or calling generally;

"(b) 'Specific trade-mark' means a trade-mark used in connection with the sale of a class of merchandise of a particular description.

The definition under (a) of general trade-mark means, I think, a trade-mark used in connection with the various articles in which the proprietor deals in his trade, and may cover several classes of merchandise if the proprietor is trading in these several classes.

A specific trade-mark is limited to a class of merchandise of a particular description, so if the applicant dealt in two different classes of merchandise he would have to apply under sub-sec. (b) for two specific trade-marks, one applicable to each class. The general trade-mark would, however, cover all the classes of merchandise in which the applicant deals. I do not think, however, that the general trade-mark would confer an unlimited right the world over as against those carrying on a business of an entirely different character.

The business of McKesson & Robbins is that of dealers in druggist supplies. If another trader manufactured steam engines, a business entirely dissimilar from that carried on by McKesson & Robbins, these latter people could not be possibly injured in any way by a specific trade-mark adopted and used by the other

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trader in connection with steam engines, although the word might be the same. The whole purport of the law of trade-marks is to prevent the passing off of goods of one as the goods of another whether intentional or not.

To come to the present case, I fail to see how the registration of "Albaloid" as a specific trade-mark as applicable to "forks and spoons of Britannia metal," could possibly enable the applicants to mislead the public into the belief that their goods were the goods of McKesson & Robbins. Moreover, while dealing with the question, it must be borne in mind that while the word "Albaloid" could not in my judgment be registered as a general trade-mark as long as the word "Albolene" stands on the registry, there is some dissimilarity between the two words.

On the whole I am of opinion that the applicants are not entitled to have registered the word "Albaloid" as a general trade-mark. I think, however, if limited to a specific trade-mark as applied to "forks and spoons of Britannia metal" it may be registered.

Mr. Scott on the argument before me declined to accept a specific trade-mark. This would not preclude his clients, if they think better of it. Nor do I wish it to be understood that they are entitled to the registration of this specific trade-mark. There may be other reasons known to the minister or his deputy which might disentitle the applicants to such registration. I am merely dealing with the case as if the only obstacle were a prior registration of the general trade-mark "Albolene."

I think the petitioner should pay the Minister's costs of the petition.

Judgment accordingly.

Solicitors for Petitioner: *Ewart, Scott, Maclaren & Kelly.*