

1918  
 Oct. 23.

IN THE MATTER OF THE PETITION OF  
 THE AMERICAN SHEET AND TIN PLATE  
 COMPANY,

PETITIONER;

AND

THE PITTSBURGH PERFECT FENCE COM-  
 PANY, LIMITED,

RESPONDENT.

*Trade Mark—Specific trade mark—Registration—Resemblance to existing mark—Manufactured articles dissimilar.*

In an application for the registration of a specific trade mark, where the resemblance to an existing registered trade mark is not sufficient to cause deception, registration should be granted.

**P**ETITION for an order directing the registration of a trade mark.

Tried before the Honourable Mr. Justice Cassels, at Ottawa, September 13, 1918.

*Peers Davidson*, K.C., for petitioners.

*F. H. Chrysler*, K.C., for respondent.

CASSELS, J. (October 23, 1918) delivered judgment.

The petitioners ask for an order directing the registration in the trade mark register of the Department of Agriculture, Ottawa, of a trade mark claimed to be their property.

The trade mark in question consists in the outline of a keystone bearing across the face of the same and extending at each side the word "Keystone", and above this symbol an ellipse of broken lines sur-

rounded by the words "American Sheet and Tin Plate Co.—Trade Mark."

The drawing of the said trade mark is shown in the application marked Exhibit No. 1, on the application before me. The Registrar refused the application on the ground that representations of the key-stone had already been registered in favour of the Pittsburgh Perfect Fence Company, Limited, and Henry Disston & Sons, Inc.

Notices as required by the statute were duly served upon the Pittsburgh Perfect Fence Company, Limited, and also upon Henry Disston & Sons, Inc. The Pittsburgh Perfect Fence Company, Limited, appeared in opposition to the petition. Henry Disston & Sons, Inc., entered no appearance, but allowed the matter to go by default.

The case was tried before me on September 13 last, and at the request of counsel for the petitioners, the hearing was adjourned, written arguments to be furnished by counsel.

Arguments have been filed on the part of the petitioners, and also on the part of the respondents, and I may state that the arguments of both counsel are commendable for the clearness with which their respective views are stated. Counsel have selected certain authorities which show the principles which would govern any applications of this nature and I have myself refrained from multiplying citations. It is easy to multiply authorities in trade mark and patent cases by the thousand, but in my view nothing is gained by so doing.

After the best consideration I can give to the case I am of opinion that there is no reason why the petitioners should not be entitled to registration of their trade mark. What they ask is that their registra-

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tion should be for a specific trade mark, as being representative of steel sheets and plates of rolled soft steel, not tool or crucible steel. It has to be borne in mind at the threshold of the case that there is no application on the part of the petitioners to register as their trade mark the word "Keystone" by itself.

The first ground of objection by the Pittsburgh Perfect Fence Company, Limited, is to the effect that on May 27, 1904, they registered in the Department of Agriculture a specific trade mark consisting of a keystone with the words "Pittsburgh Perfect" and the initials of the company's name, *viz.*, "P.P.F.Co." Such drawing is set out in the statement of objections on behalf of the Pittsburgh Perfect Fence Company filed in this Court.

It is conceded that since the year 1913, the petitioners in this case have continuously used their trade mark on goods manufactured and sold by them; and have built up a large business in the manufacture and sale of sheets and plates of rolled soft steel, not tool or crucible steel.

It is also conceded that the respondents, the Pittsburgh Perfect Fence Company, Limited, have never manufactured or placed upon the market goods of a class similar to those manufactured and sold by the petitioners in this case.

It must also be kept clearly in mind that the respondents in no way claim as a trade mark the word "keystone" or the symbol of a keystone by itself. Their trade mark has a keystone, but in combination with other symbols described in their application. Not merely have they never used their trade mark on materials of a similar class to those manufactured and sold by the present petitioners, but I do not think, notwithstanding the argument on their be-

half, that they ever contemplated or intended to manufacture or to sell steel sheets similar to those manufactured and sold by the petitioners.

I think there is a great deal of force in Mr. Davidson's reference to the charter incorporating the Pittsburgh Perfect Fence Company, Limited. That charter is dated November 13, 1903. It incorporates the corporation with the corporate name of the Pittsburgh Perfect Fence Company, Limited. They are created a corporation for the purposes and objects following, that is to say: "To construct and erect "fences of every nature and description, and for the "said purpose, to manufacture, produce, buy, sell "and trade and deal in iron, steel, wire and other "metals of every description and all products and "articles made therefrom."

It is not necessary to deal with the intricate question, so often lately discussed, as to whether or not considering the limited purposes for which the company was incorporated they could nevertheless embark in the general business of manufacture. The latest case that I have had the pleasure of reading, and one very instructive, is that of *Edwards v. Blackmore*,<sup>1</sup> decided by the Appellate Division of Ontario.

At present I merely refer to the fact that from the time of their incorporation, namely, November 13, 1903, down to the present time, they have never manufactured the class of goods so extensively dealt in by the present petitioners; and, moreover, the purpose of their incorporation was to construct and erect fences, and for that purpose to deal in the articles mentioned.

<sup>1</sup> (1918), 42 D.L.R. 280, 42 O.L.R. 105.

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As I have pointed out, there has been no claim put forward upon the part of the Pittsburgh Perfect Fence Company, Limited, that the word "Keystone" forms their trade mark; and this is further emphasized by the fact that on December 30, 1913 (Ex. No. 5) a consent was given to Henry Disston & Sons, Inc., in which they state that "we can see no possibility of our being hampered on account of Henry Disston & Sons, Incorporated, having the keystone registered as their trade mark in Canada on the articles below enumerated", naming these articles. Henry Disston & Sons, Inc., have never, according to the evidence, used the word "keystone" by itself as their trade mark, but always in combination; and they have only manufactured the articles referred to in their application for a trade mark, a class of articles entirely dissimilar to the articles manufactured and sold by the petitioners.

There is no suggestion of any fraudulent intention on the part of the petitioners to steal the trade of the respondents, nor could it be possible under the circumstances of this case that such contention could reasonably be put forward.

There is no similarity between the trade mark of the petitioners and the trade mark of the Pittsburgh Perfect Fence Company. From the year 1913 to the present time the petitioners have been using their trade mark without objection on the part of the Pittsburgh Perfect Fence Company, or any other person. This is not a case of "passing off."

Our *Trade Mark Act*, as it has been stated, differs in a great many respects from the English Trade Mark Acts. It provides that "All marks, names, labels, brands, packages or other business devices, which are adopted for use by any person in his

“trade, business, occupation or calling, for the purpose of distinguishing any manufacture, product or article of any description manufactured, produced, compounded, packed, or offered for sale by him, applied in any manner whatever either to such manufacture, product or article, or to any package, parcel, case, box or other vessel or receptacle of any description whatsoever containing the same, shall, for the purposes of this Act, be considered and known as trade marks.”

Section 11, however, which reads as follows: “The Minister may refuse to register any trade mark—

“(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.” limits the application of the Act.

I cannot do better than quote from the language of the late Lord Macnaghten, in the case of *Standard Ideal Company v. Standard Sanitary Manufacturing Company*.<sup>1</sup> His Lordship gave the decision of the Board, and is reported as follows: “On the question as to the validity of the alleged trade mark their Lordships are compelled to differ from the Court of King’s Bench. The Canadian *Trade*

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“*Mark and Design Act, 1879, (42 Vict., c. 22)* re-  
quires trade marks to be registered. It does not,  
however, contain a definition of trade marks cap-  
able of registration. It provides that ‘All marks,  
names, labels, brands, packages or other business  
devices, which are adopted for use by any person  
in his trade, business, occupation or calling for the  
purpose of distinguishing any manufacture, pro-  
duct or article of any description manufactured,  
produced, compounded, packed or offered for sale  
by him applied in any manner whatever, either to  
such manufacture, product or article, or to any  
package, parcel, case, box or other vessel, or re-  
ceptacle of any description whatsoever containing  
the same, shall for the purposes of this Act be con-  
sidered and known as trade marks.’

“The Act, however, declares that the Minister  
may refuse to register any trade mark ‘if the so-  
called trade mark does not contain the essentials  
necessary to constitute a trade mark, properly  
speaking.’

“The Act does not define or explain the essentials  
of a trade mark, nor does it provide for taking off  
the register an alleged trade mark which does not  
contain the requisite essentials. In applying the  
Act the Courts in Canada appear to consider them-  
selves bound or guided mainly by the English law  
of trade marks and the decisions of the Courts of  
the United Kingdom.”

A case that to my mind has considerable bearing  
on the case before me, is the case of *Re Bagots, Hut-  
ton & Company's Trade Mark*.<sup>1</sup> This was a case in  
which a decision of Mr. Justice Neville was reversed  
by the Court of Appeal. The judgment in appeal is

<sup>1</sup> [1916] 2 Ch. D. 103.

reported in L.R. 2 Ch. D. 103. The application there was on the part of Bagots Limited, for the registration for gin of a trade mark comprising the picture of a cat in boots. The allegation made by the opponents to the registration was that the proposed trade mark would be calculated to deceive by reason of the fact that in some eastern countries a certain gin manufactured by the opposers had become known as Cat Gin. It would appear that the device of a cat was common to the gin trade. In the case before me the symbol of a keystone by itself or in combination with other words is also common. However, their Lordships reversed the decision in the Court below and ordered registration of the trade mark. There was an appeal taken to the House of Lords. The case in appeal is reported in [1916] 2 A.C. 382. The appellants contended that their goods had become known in the United Kingdom, and in the markets of the world, by the name of "Cat Brand," and that the trade mark which the respondents were seeking to register was calculated to cause the goods bearing the same to be described as "Cat Brand" goods, and to be passed off as and for the appellants' goods.

At page 387, the Lord Chancellor states that in this case the appellants seek to prevent registration of a trade mark which the respondents have used in this country for at least 17 years, upon the ground that if registered it would be calculated to deceive. He states that, "So far as the probability that deception owing to the resemblance of the two marks could occur, it is sufficient to say that a mere glance is sufficient to dispel any such apprehension." I think the same language might be used in the case before me.

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Lord Loreburn, at p. 392, states: "It was not calculated to deceive anyone in the United Kingdom."

At p. 393, Lord Haldane's reasons are set out, and he states: "The appellants' trade mark is not a 'cat, but a can on a barrel, and the appellation of 'their brands ought properly to be 'Cat and Barrel' brands, and not 'Cat' brands. To the more 'general appellation they are not entitled,' etc.

As I have pointed out, the Pittsburgh Perfect Fence Company, Limited, are not entitled to the trade mark "Keystone," but to this word in combination with other words, and symbols, and I fail to see how any person could be deceived by the use by these petitioners of their trade mark.

If, hereafter, any fraud is attempted by the petitioners, there is a remedy in the Courts. I do not myself apprehend that such an action will ever arise. I think the application of the petitioners should be allowed, and the order made directing the registration.

The petitioners have asked that the registration should be rectified by limiting the trade mark of the Pittsburgh Perfect Fence Company, Limited, and the Henry Disston & Sons, Inc., so as to confine their trade mark to a specific trade mark for the particular goods manufactured by them, and excluding therefrom the goods manufactured by the present petitioners. I do not think that this relief is necessary.

Under the circumstances of the case I think that no costs to any party should be allowed; but each party bear their own costs.

Solicitors for petitioners: *Davidson, Wainwright, Alexander & Elder.*

Solicitors for respondent: *Chrysler & Higgerty.*