

IN THE MATTER of the Petition of ELKINGTON & CO.,
Limited, of the City of Birmingham, England ;

1908
Feb'y. 18.

AND IN THE MATTER of the registration of the Specific Trade-Mark of "ELKINGTON & CO." as applied to the sale of Electro-Plate, and Goods of Precious Metals, Table Knives, Carving Knives, Cake Knives, and other articles of cutlery, in pursuance of the provisions of the Trade-Mark and Design Act.

Trade-mark—Petition for registration—Specific mark—Name of firm as applied to sale of Electro-plated ware and cutlery—English and Canadian Statutes compared.

Held, that the wording of the Trade-Mark and Design Act (R. S. c. 71, s. 5) is wider than the Imperial Patents, Designs and Trade-Marks Act, 1883, (46-47 Vict., c. 57, sec. 64), and that under the word "names" as used in the Canadian Act, the name of an individual or firm, without anything more and without being accompanied by any particular distinctive feature, may be considered and known as a trade-mark, and is entitled to registration as such.

[REPORTER'S NOTE.—The facts disclosed in the material filed in support of the petition established that the name "Elkington & Co." (as applied to the sale of electro-plate and goods of precious metals, table knives, carving knives, cake knives and other articles of cutlery) without any distinctive mark or form was registered in England as a trade-mark in 1876 by the petitioners' predecessor in title ; and that the name had been in use as a trade-mark by them for some thirty-five years before, and had acquired distinctiveness and become well-known throughout the world owing to such long continuous use.]

PETITION to obtain an order for the registration of a specific trade-mark.

The grounds upon which the petition was based are set out in the following affidavit:—

I, Hyla Garrett Elkington, of the said City of Birmingham, England, managing director of Elkington & Co., Limited, of 128 Newhall Street, in the said City of Birmingham, and the petitioners named herein, make oath and say:—

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1. That the said petitioners are a chartered company, with head office in the City of Birmingham, and carry on business as Silversmiths and Electro-Platers and Cutlers, in the United Kingdom of Great Britain and Ireland; and in all the principal countries of the world—the original company being entitled “Elkington & Co.”

2. That the said petitioners duly acquired the said trade-mark “Elkington & Co.” as applied to the sale of electro-plate and goods and precious metals, table knives, carving knives, cake knives, and other articles of cutlery, from their predecessors in business, Elkington & Co., who were the original proprietors thereof.

3. That on the 16th day of April, A.D. 1907, the said petitioners duly filed an application for the registration of the said Specific trade-mark “Elkington & Co.” in the Department of Agriculture (Trade Mark and Copyright Branch) at Ottawa, Canada, under number 58,766, as applied to the sale of electro-plate and goods of precious metals, and on the 20th day of May, 1907, amended the application so as to embrace the additional articles of cutlery referred to in clause 2.

4. The registration of the said specific trade-mark “Elkington & Co.” has been duly refused in the form as presented, the office holding that the name of an individual or firm should be presented in a distinctive form for registration.

5. That the said trade-mark “Elkington & Co.” as applied to the sale of “Electro-Plate and Goods of Precious Metals,” and without any distinctive mark or form, and as presented for registration in Canada, was duly registered by Elkington & Co. as a trade-mark in the United Kingdom of Great Britain and Ireland under No. 4311, Clause 14, on the 28th day of March, 1876, and was in use as a trade-mark on said goods by said Elkington & Co. for thirty-five years prior to the said date; and has been continuously so used up to the pre-

sent time by the said petitioners and their said predecessors in business, Elkington & Co.

6. That the said trade-mark "Elkington & Co." as applied to the sale of "table knives, carving knives and cake knives," and without any distinctive mark or form, and as presented for registration in Canada, was duly registered by the said petitioners as a trade-mark in the United Kingdom of Great Britain and Ireland under No. 248,080, Class 12, and such trade-mark has been continuously used in respect of said goods by the said petitioners and their said predecessors in business since the year 1869 up to the present time.

7. That such trade-mark "Elkington & Co." in simple block letters, and without any distinctive characteristics, applied to the sale of the goods referred to in Clause 2, has acquired distinctiveness and is well known throughout the world, owing to long continuous use.

8. That the said trade-mark "Elkington & Co." in the form presented in Canada has also been registered as a trade-mark in several of the European countries.

9. That the said petitioners have no knowledge of any person or firm or company bearing the name of "Elkington & Co." who are manufacturers of electro-plate and cutlery either in England or elsewhere; and the said petitioners are the exclusive proprietors throughout the world of said term "Elkington & Co." applied as a trade-mark for the sale of the goods heretofore specified in Clause 2.

10. That the trade-mark "Elkington" in simple block letters, and without any distinctive mark or form, as applied to the sale of electro-plate and goods of precious metals, has already been registered by the said petitioners in Canada on the 8th day of November, 1901.

11. The said petitioners are desirous of obtaining prompt registration of said trade-mark "Elkington & Co." as now presented and applied for in Canada under

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number 58,766 with a view of complying with the conditions of "The Gold and Silver Marking Act, 1906."

February, 10th, 1908.

C. J. R. Bethune, in support of the petition, cited the following authorities:—

"Elkington & Co." as a trade-mark, as applied to silver has been in continuous use for 35 years prior to 28th March, 1875, or since the year 1842, a period of 65 years, in round numbers, and has acquired a secondary meaning.

When the word "Canadian" although only in use seven years, and not a registered trade-mark, had acquired a secondary meaning then the law of trade-marks applied and the term "Canadian" was not geographical. *Rose v. McLean Publishing Co.* (1).

In *Gage v. The Canada Publishing Co.* (2), the use of the name "Beatty," the party's own name, as applied to a rival book, was restrained—there was no registered trade-mark—but the action was maintainable as a case of unfair trade competition.

The English cases reported as to unfair trade competition are more numerous than those on registered trade-marks, and the firm Elkington & Co., Limited, now have an exclusive right to the name "Elkington & Co." as applied to silverware, &c., even without registration, and could restrain others from using this name as applied to silver on the basis of unfair trade competition. By section 45 of the last British Trade-Mark Act, 1905, this common law right is expressly reserved.

"Names" in Canada should follow the principle laid down in *Ainsworth v. Wamsley* (3), and there is nothing to prevent another firm of silversmiths of the same surname from registering their name as a trade-mark, but it must be done in such a distinguishing manner as to

(1) 24 O. A. R. p. 246.

(2) 6 Ont. R. 68 ; 11 O. A. R. 402 ;
 11 S. C. R. 306.

(3) L. R. 1 Eq. 518.

prevent confusion with the previously registered mark, which trade-mark, as in our case, has been known and used for over sixty years.

See also *Skinner v. Oakes* (1), "a trade-mark may, and often does consist in the name of a person or partnership firm, and the exclusive use of such trade-mark is upheld, with this limitation that another person of the same name is not to be prevented from using his name in the same way provided there are no special circumstances which make it inequitable for him to do so."

The registration of the name "Elkington & Co." as a trade-mark in Canada as applied to silverware, &c., knives, &c., deprives no person of any rights whatever. We have a right of action under the common law respecting unfair trade competition, but the petitioners want to comply with the provisions of *The Gold and Silver Marking Act*, 1906, sec. 11.

See also U. S. Off. Gaz. No. 5, Vol. 132, No. 27304, of 4th. Feb., 1908, where the name "Newman" is registered as a trade-mark, having been used some ten years. See also *Smith v. Fair* (2).

February 18th, 1908.

SIR THOMAS W. TAYLOR, Judge *pro tempore* of the Exchequer Court of Canada, now delivered judgment.

This is an application by a firm carrying on business as silversmiths, electro-platers, and cutlers, at the City of Birmingham, England, to obtain registration of a trade-mark.

The petition they present alleges that on the 16th of April, 1907, they filed an application for the registration of a specific trade-mark "Elkington & Co.," in the Department of Agriculture, at Ottawa, under No. 58,766, as applied to the sale of electro-plate and goods of precious metals, and on the 20th May, 1907, amended

(1) 10 Mo. App. at p. 56.

(2) 14 O. R. 729.

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the application so as to embrace certain additional articles of cutlery. It is further alleged that registration of that specific trade-mark has been refused, in the form presented, the office holding that the name of an individual firm should be presented in a distinctive form for registration.

Probably this ruling was based upon some more recent English authorities. Claiming to be persons agrieved by the refusal or omission to make an entry in the Register of Trade-Marks of the trade-mark they desire to have registered, as they say, without sufficient cause, they now, under section 42 of *The Trade Mark and Design Act*, apply to this court for relief.

In support of the petition there is filed an affidavit of H. G. Elkington, of Birmingham, England, describing himself as managing director of the petitioner's firm. The rules of court as to publication in the *Canada Gazette*, and service upon the Minister of Agriculture seem all to have been duly complied with. No objections have been lodged, and on the return of the notice of hearing the petition no one appeared to oppose it.

As registration of the trade-mark in question was refused by the Minister of Agriculture, and this is, I understand, the first application to the court in which the question now arising has come before it, it deserves, even though unopposed, careful consideration.

It may be that since the passing of the Imperial Act of 1883, 46 & 47 Vict. c. 57, the trade-mark in question, in the form presented, would not obtain registration in England. The proper disposition of this application must therefore depend upon whether there is a difference between the terms of the Canadian Act now in force and the English Act.

The Trade Mark and Design Act, R. S. c. 71, s. 5, seems wider in its terms than the English Act of 1883. The enumeration in it of the particulars of what are

to be considered and known as trade-marks, is exactly the same as is found in the Canadian Act of 1875, 42 Vict. c. 22, s. 8. It was when comparing that latter Act with the English Act of 1883 that Mr. Justice Proudfoot in *Smith v. Fair* (1), said it "defined trade-marks in the most comprehensive terms, as all marks, names, brands, labels, or other business devices for the purpose of distinguishing any manufacture no matter how applied, whether to the article or the box." This is much more general than the definition of trade-mark in the Imperial Act of 1883, 46 & 47 Vict. c. 57, s. 64, and some care must be used in considering decisions in the English courts.

It seems singular that, as stated in the affidavit filed in support of the petition, the name "Elkington & Co.", just as presented here, was in March, 1876, registered in England. The Act then in force, and under which it must have been so registered, the 38 & 39 Vict. c. 91, s. 10, was worded just as the Act of 1883 is: "A name of an individual or firm printed, impressed, or woven, in some particular and distinctive manner."

To provide that "names" shall be considered and known as trade-marks, is certainly more comprehensive than that they shall be so, when printed, impressed or woven in some particular and distinctive manner. In the one case, the name alone seems sufficient, in the other, there must be something more than the name—something particularly distinctive in the way it is designed, in the form it takes, in the colouring, or in the surroundings.

I cannot see what objection there can be to a mere name being a trade-mark, under the provisions of an Act which says that "names", saying nothing more, may be considered or known as such.

(1) 14 Ont. R. at p. 732.

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As V. C. Page, Wood said in *Ainsworth v. Walmsley* (1), "is not a man's name as strong an instance of trade-mark as can be suggested, subject only to the inconvenience that if a Mr. Jones or a Mr. Brown relies on his name, he may find it very inadequate security because there may be several other manufacturers of the same name?"

I must hold that the wording of *The Trade-Mark and Design Act*, R. S. c. 71, s. 5, is wider than that of the English Act of 1883, and that under the word "names" as used in the Canadian Act, the name of an individual or firm, without anything more, without being accompanied by any particular distinctive feature, may be considered and known as a trade-mark, and is entitled to registration as such. That being so, the petitioners are entitled to have the name "Elkington & Co.", as presented to the Department of Agriculture under No. 58,766, considered and known as a trade-mark.

There should therefore be, as prayed, an order to enter the name as a trade-mark in the proper register kept for making entry of such marks.

Ordered accordingly.

(1) L. R. 1 Eq. at p. 525.
