BETWEEN:

BATTLE PHARMACEUTICALS.... PETITIONER,

AND

LEVER BROTHERS LIMITED..... RESPONDENT.

1944
Sept. 26

1946
Mar. 8

Practice and Procedure—The Unfair Competition Act, 1932, Statutes of Canada, 1932, c. 38, ss. 49, 52, 53, 54, 55—Not necessary to apply to Registrar under s. 49 before filing originating notice of motion under s. 52—Proceedings by firms or persons carrying on business in names other than their own—General Rules and Orders, rules 42, 168—The Rules of the Supreme Court, 1883, of England, Order XVIIIA rr. 1, 2, 11—Partners may sue or be sued in firm name—Single person may be sued in name or style other than his own but cannot sue in such name or style—Motion under s. 52 of The Unfair Competition Act, 1932, not interlocutory—Statements in supporting affidavit based on information and belief not admissible.

On the return of the petitioner's motion for an order expunging the registration of the respondent's word mark "Vimms" on the ground of its non-user in Canada by the respondent since the date of its registration, counsel for the respondent took preliminary objections that the petitioner should first have applied to the Registrar under s. 49 of the Act, that the notice of motion did not disclose who the petitioner was, and that statements in the affidavits filed in support of the motion were inadmissible under rule 168 of the General Rules and Orders.

Held: That it is not a condition precedent to the filing of an originating notice of motion under section 52 of The Unfair Competition Act, 1932, that the petitioner should first make an application to the Registrar under section 49.

2. That partners may sue in their firm name but a single person, while he can be sued in a name or style other than his own, cannot sue in such name or style. *Mason* v. *Mogridge* ((1892) 8 Times L.R. 805) followed.

3. That a motion made pursuant to an originating notice of motion filed under section 52 of the Act is not an interlocutory motion and statements in an affidavit filed in support of it based on information and belief are not admissible as proof of the grounds on which the motion is made.

Preliminary objections to a motion under section 52 of The Unfair Competition Act, 1932, for an order expunging the registration of the respondent's word mark "Vimms".

The objections were heard by the Honourable Mr. Justice Thorson, President of the Court, at Ottawa.

C. F. H. Carson, K.C. for respondent.

R. C. Greig for petitioner.

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

THE PRESIDENT now (March 8, 1946) delivered the following judgment:

The petitioner, the registered owner of the word mark "Multivims", filed an originating notice of motion under section 52 of The Unfair Competition Act, 1932, Statutes of Canada, 1932, chap. 38, for an order expunging the registration of the respondent's word mark "Vimms" on the ground that it "has not been and is not now used in Canada on the wares for which the said mark was registered."

On the return of the motion, counsel for the respondent took a number of preliminary objections. He contended that, if the ground for expunging is non-user of the trade mark since the date of its registration, the initial jurisdiction is with the Registrar and an application should first have been made to him under section 49. In my view, this objection cannot be sustained. Section 49 reads as follows:

49. (1) The Registrar may at any time, and shall at the request of any person who pays the prescribed fee, notify the person appearing from the register to be the owner of any trade mark that he considers, or that it has been represented to him that such trade mark has ceased to be used as a trade mark in Canada, or for any other specific reason to be set out in the notice, the registration of such mark should be cancelled or that an entry relating thereto should be struck out, corrected or amplified, and request him to advise whether he has any, and if any, what objection to the amendment of the register accordingly.

(2) If the person to whom such notice has been addressed agrees to the proposed amendment of the register in whole or in part, such amendment shall forthwith be made by the Registrar in accordance with such agreement.

(3) If, within three months from the despatch of such a notice as aforesaid, no reply to it has been received from the person to whom it was addressed, the Registrar shall send such person a second notice enclosing a copy of the first and stating that if, within a reasonable time to be fixed by the notice, no objection to the proposed amendment of the register is received, such amendment will be made, and, unless an objection is received within the time limited, the Registrar shall amend the register accordingly.

(4) Except as in the next following section provided, the Registrar shall not cause any amendment to be made in the register to which the person appearing therefrom to be the owner of the mark makes any objection.

Section 49 provides a procedure whereby the Registrar may amend the register in respect of a registered trade mark in cases where the person appearing on the register to be the owner of such mark agrees to the proposed amendment, as provided in subsection (2), or does not object to it within the time referred to in subsection (3). If he makes any objection the Registrar may not make any amendment, except as provided in section 50, with which we are not here concerned. The procedure is not restricted to cases where the amendment is proposed on the ground that the trade mark has ceased to be used as a trade mark in Canada, but extends to those where it is proposed "for any other specific reason".

Section 49 gives the Registrar no jurisdiction to determine any dispute relating to a registered trade mark between the registered owner and any other person. The jurisdiction to deal with such a dispute is vested in the Exchequer Court of Canada under section 52, which provides as follows:

> 52. (1) The Exchequer Court of Canada shall have jurisdiction, on the application of the Registrar or of any person interested, to order that any entry in the register be struck out or amended on the ground that at the date of such application the entry as it appears on the register does not accurately express or define the existing rights of the person appearing to be the registered owner of the mark.
>
> (2) No person shall be entitled to institute under this section any proceeding calling into question any decision given by the Registrar of which such person had express notice and from which he had a right to appeal.

There is nothing in section 52 to indicate that resort cannot be had to the Court without first applying to the Registrar under section 49. If effect were to be given to the respondent's contention it would mean that, before a petitioner could take any action under section 52, he would first have to wait until all the steps referred to in section 49 had been taken and all the time required for such steps had elapsed, that is to say, he would have to request the Registrar to notify the registered owner of the trademark of his proposed attack on it and his reason therefor; the Registrar would have to send out the requested notice; the three months could elapse without any reply from the registered owner; then the Registrar would have to send out a second notice with a time fixed therein for receiving

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an objection; and then, if an objection was received, the Registrar would be quite powerless to make any amendment. Moreover, section 54 makes it clear that applications under section 52 are to heard and determined summarily. It seems to me that it would be quite unreasonable to construe the Act as requiring a petitioner desirous of attacking a registration to go through all the preliminary procedure of section 49 with the waste of time involved and its abortive results. Moreover, such a requirement would be quite inconsistent with the summary nature of the proceedings under section 52. In my view, it is not a condition precedent to the filing of an originating notice of motion under section 52 that the petitioner should first make an application to the Registrar under section 49.

Counsel also objected that the notice of motion did not disclose who the petitioner was. The matter of proceedings, such as this, by firms or persons carrying on business in names other than their own is not provided for by any Act of Parliament or by the Rules of this Court, and in such cases Rule 42 of the General Rules and Orders of this Court applies, which provides:

> In any proceeding in the Exchequer Court respecting any patent of invention, copyright, trade mark or industrial design, the practice and procedure shall, in any matter not provided for by any Act of the Parliament of Canada or by the Rules of this Court (but subject always thereto) conform to, and be regulated by, as near as may be, the practice and procedure for the time being in force in similar proceedings in His Majesty's Supreme Court of Judicature in England.

Resort must, therefore, be had to Order XLVIIIA of "The Rules of the Supreme Court, 1883" of England as it stood at the date of the filing of the notice of motion. Under r. 1 of that Order it is provided:

> 1. Any two or more persons claiming or being liable as co-partners and carrying on business within the jurisdiction may sue or be sued in the name of the respective firms, if any, of which such persons were co-partners at the time of the accruing of the cause of action; and any party to an action may in such case apply by summons to a judge for a statement of the names and addresses of the persons who were, at the time of the accruing of the cause of action, co-partners in any such firm, to be furnished in such manner, and verified on oath or otherwise as the judge may direct.

And r. 2 provides:

> 2. When a writ is sued out by partners in the name of their firm, the plaintiffs or their solicitors shall, on demand in writing by or on behalf of any defendant, forthwith declare in writing the names and places of

residence of all the persons constituting the firm on whose behalf the action is brought. And if the plaintiffs or their solicitors shall fail to comply with such demand, all proceedings in the action may, upon an application for that purpose, be stayed upon such terms as the Court or a judge may direct. And when the names of the partners are so declared, the action shall proceed in the same manner and the same consequences in all respects shall follow as if they had been named as the plaintiffs in the writ. But all the proceedings shall, nevertheless, continue in the name of the firm.

Then follow rr. 3 to 10, which do not here concern us. Then r. 11 provides:

11. Any person carrying on business within the jurisdiction in a name or style other than his own name may be sued in such name or style as if it were a firm name; and, so far as the nature of the case will permit, all rules relating to proceedings against firms shall apply.

It was held in *Mason* v. *Mogridge* (1) that while a single person trading under a name other than his own could be sued, he could not sue, under such name.

If, therefore, the petitioner is a partnership, there is no objection to the style of cause and the respondent could obtain the necessary information as to the members of it by taking the steps indicated by the rules. If such steps were taken it would, no doubt, be ascertained whether the petitioner is a partnership or a single person. If the petitioner is a single person carrying on business in a name or style other than his own, the notice of motion could be set aside on a motion for such purpose. There was nothing before the Court to indicate whether the petitioner was a partnership or a single person and, consequently, no action can be taken on this objection.

A further objection was that the affidavit filed in support of the motion by the solicitor for the petitioner did not comply with Rule 168 of the General Rules and Orders. The deposition objected to reads:

3. That I have been informed by the petitioner herein that the said word mark "Vimms" has not been and is not now being used in Canada by the Respondent herein on the wares for which it was registered.

Rule 168 provides in part:

Affidavits shall be confined to such facts as the witness is able of his own knowledge to prove, except on interlocutory motions on which statements as to his belief with the grounds thereof may be admitted.

(1) (1892) 8 T.L.R. 805.

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Section 53 provides for the making of applications under section 52 either by filing an originating notice of motion with the Registrar of the Court or by a counterclaim in an action for the infringement of the mark. Under section 54 every such application is to be heard and determined summarily on evidence adduced by affidavit, "unless either party requires some issue of fact to be determined on oral evidence". Section 55 provides for the transmission by the Registrar of Trade Marks to the Registrar of the Court of all papers on file in his office relating to the matters in question in the proceedings, on the request of any of the parties to such proceedings and the payment of the prescribed fee.

Where a petitioner does not take advantage of the provisions of the Act for the proper disposition of the matters in controversy involved in his originating notice of motion or does not comply with the requirements of the Rules he runs the risk of having his motion dismissed. Here the petitioner has taken no step to indicate that he requires any issue of fact to be determined on oral evidence and the file of the Registrar of Trade Marks was not produced. The only material before the Court having any bearing on the issue of non-user of the trade mark by the respondent since its registration was, therefore, the deposition referred to. Even if the motion before the Court were an interlocutory one the deposition would not be admissible since there is no statement as to the deponent's belief in the information received, but a motion made pursuant to an originating notice of motion filed under section 52 is not an interlocutory motion and statements in an affidavit filed in support of it based on information and belief are not admissible as proof of the grounds on which the motion is made. The result is that there is no proof at all before the Court of non-user by the respondent of its word mark "Vimms" since its registration, and effect must be given to the respondent's objection. While the Court might, in a proper case, grant an adjournment of the hearing of the motion under circumstances such as these, on an application therefor and on appropriate terms, in order to enable the petitioner to perfect his material, such an application for adjournment would have to be

dealt with on its merits. In the present case, there is no object in granting any such concession to the petitioner, in view of the decision of this Court in *The British Drug Houses, Limited* v. *Battle Pharmaceuticals* (1) and its affirmation by the Supreme Court of Canada (2), whereby the registration of the petitioner's own word mark "Multivims" was ordered to be expunged. Consequently, the petitioner's motion must be dismissed with costs.

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Judgment accordingly.