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 April 29
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 May 3
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BETWEEN:

LIBBY, McNEILL AND LIBBY PLAINTIFF;

AND

CANADIAN CANNERS LIMITED DEFENDANT.

Practice—Trade marks—Compliance with Demand for Particulars—Reference in statement of defence to registered trade marks sufficient—Particulars of resemblances between registered trade marks and plaintiff's mark will not be ordered—Particulars of invalidity alleged must be furnished—Allegation of "common use" requires particulars of such to be furnished.

Held: That a reference to the registered trade marks on which a defendant will rely at trial is sufficient compliance with a Demand for Particulars; particulars of resemblances between certain registered trade marks and plaintiff's trade mark will not be ordered.

2. That when a defendant pleads invalidity of plaintiff's trade marks he must give particulars of the invalidity alleged.
3. That if a defendant intends to rely on particular users other than those owning registered trade marks he should furnish particulars of the first user in the trade and the names and addresses of a number of those alleged to have used the mark as a trade mark in the trade, such number of persons to be determined by the Court; the defendant will not be precluded from adducing further evidence at the trial.

MOTION for Particulars.

The motion was heard before the Honourable Mr. Justice Cameron at Ottawa.

J. J. Connolly, K.C. for the motion.

Christopher Robinson contra.

CAMERON J. now (May 3, 1948) delivered the following judgment:

In this action the plaintiff claims infringement of its three registered trade marks, that the trade mark of the defendant be expunged, that damages be awarded and certain other ancillary relief. The defendant denies infringement and by counter claim asks for an order expunging the three trade marks of the plaintiff from the register.

Paragraphs 6 and 7 of the Statement of Defence are as follows:

6. The trade marks covered by the registrations referred to in paragraphs 2, 3 and 4 hereof were not registrable by the plaintiff, since they resembled trade marks which were registered in respect of food products at the respective dates of such registrations, and since they did not contain the essentials of a trade mark properly speaking.

7. The trade marks covered by the registrations referred to in paragraphs 2, 3 and 4 hereof are not distinctive of the plaintiff's food products, since triangles are and have been for many years in common use in Canada by dealers on containers and labels for foods, including canned foods, and for non-alcoholic beverages, including canned and bottled fruit juices, and many trade marks including triangles have been registered in respect of such wares.

The plaintiff served a Demand for Particulars, the defendant replied thereto giving certain particulars and the plaintiff now moves for an order for further and better particulars, in respect of four matters:

1. The plaintiff asks for particulars of the respects in which the plaintiff's registered trade marks as set out in the Statement of Claim herein resemble the trade marks set out in paragraphs 1 and 2 of the said Reply to Demand for Particulars.

In its reply to the Demand for Particulars, the defendant has given the registration numbers and dates of certain registered trade marks which it alleges the plaintiff's trade marks resemble. Particulars of such resemblances are now asked for but in my opinion the defendant should not be required to give them. Full information on that point can be obtained by search in the Register of Trade Marks. Whether such resemblances do in fact exist is a matter to be determined at the trial by production of the record of registrations and argument in regard thereto. Such argument has no place in the pleadings. I am of the opinion on this point that the defendant has complied sufficiently with the demand for particulars by referring to the registered trade marks on which he will rely at the trial.

2. The plaintiff asks for particulars as to the manner in which the plaintiff's registered trade marks do not contain the essentials of a trade mark *properly speaking*, as alleged in paragraph 6 of the Statement of Defence.

A similar demand was made in paragraph 3 of the Demand for Particulars, but the defendant in its reply

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thereto gave no particulars. Paragraph 6 of the Statement of Defence (*supra*) is an allegation that the plaintiff's trade marks lacked registrability because (1) they resembled trade marks previously registered in respect of food products, and (2) they did not contain the essentials necessary to constitute a trade mark, properly speaking. (And should therefore not have been registered in view of the prohibition contained in the then existing section 11 (4) of the Trade Marks and Industrial Designs Act.)

The plaintiff asks for particulars on this point in order to be able to file its reply. I think it is well settled that when the defendant pleads invalidity of the plaintiff's trade marks, he must give particulars of the invalidity alleged; Kerly on Trade Marks, 6th ed., p. 537, where reference is made to *Rowland v. Mitchell* (1) in which case such particulars were ordered. It would be impossible for the plaintiff to properly frame its reply without knowing in what respect the defendant alleged invalidity of its (the plaintiff's) marks. It may be the case that paragraph 7 of the Statement of Defence (*supra*), in which it is alleged that the plaintiff's trade marks were not distinctive, is intended to disclose the particulars of the allegation in the previous paragraph that the plaintiff's marks "do not contain the essentials of a trade mark properly speaking." But it is not so stated either in the Statement of Defence or in the Reply to Demand for Particulars. In my view the plaintiff is entitled to be furnished with such particulars.

3. The plaintiff also asks for particulars of the common use in Canada of triangles by dealers on containers and labels for food, including canned foods, and for non-alcoholic beverages, including canned and bottled fruit juices, as alleged in paragraph 7 of the Statement of Defence, and in each case the name of the dealers, the date of first use, the date of registration of each such trade mark, the extent of the use thereof, the wares covered by each such trade mark and the description of each such trade mark.

The particulars given in paragraph 2 of the Reply to the Demand for Particulars constitute, I think, a sufficient compliance with paragraphs 3 and 4 of the Demand for Particulars insofar as *registered trade marks* are concerned,

for the same reason as I have set out in regard to Claim 1 of the Notice of Motion. But paragraph 7 of the Statement of Defence alleging "common use" in Canada is not confined to registered trade marks.

If the defendant intends to rely on particular users other than those owning registered trade marks (as set out in paragraph 2 of the Reply to the Demand for Particulars) the plaintiff should be furnished with particulars of the first user of triangles in the trade and the names and addresses of a number of persons alleged to have used the triangles as a trade mark in the trade (see Kerly on Trade Marks, 6th ed., p. 538). In the case of *Aquascutum Limited v. Moore* (1) such an order was made, but it was provided that the defendant at the trial would not be precluded from adducing further evidence, the order for particulars in that case requiring the defendant to name only three such alleged users of the mark. Unless, therefore, the defendant states that at the trial he does not intend to establish "common use" by reference to users other than those mentioned in paragraph 2 of the Reply to the Demand for Particulars, it should now give particulars of the first user of triangles in the trade and the names and addresses of three persons or firms (other than those mentioned in paragraph 2 of the Reply to the Demand for Particulars) alleged to have used "triangles" as marks in the trade. If the defendant has knowledge of less than three such alleged users, the number will be reduced to correspond with the number of users within the knowledge of the defendant; but at the trial the defendant will not be precluded from adducing further evidence.

4. The plaintiff also asks for further particulars of the trade marks set out in the said Reply to Demand for Particulars, more especially the description of each mark, the date of first use thereof, the date of registration, the name and address of the owner, and the wares covered by each mark.

The trade marks referred to on this point are all registered trade marks and I think it may be assumed that the defendant has no knowledge of the details thereof other than what may be contained in the Register of Trade Marks. As stated above these are open to inspection by

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the plaintiff and it has the same opportunity as the defendant to examine them. I do not think the defendant is required to give any further information on these matters.

The motion will therefore be granted to the extent indicated, and an order will go requiring particulars to be served and filed as above mentioned within fourteen days from the date of service of the order upon the defendant's solicitors; all further proceedings will be stayed until the delivery of such particulars by the defendant, and the plaintiff will deliver its Reply within fourteen days after delivery of the further particulars now ordered.

Costs of the motion will be costs to the plaintiff in the cause.

Order accordingly