THE THERMOGENE COMPANY LIMITED OF HAYWARD'S HEATH..... } PETITIONER;

1925
Sept. 29.

AND

LA COMPAGNIE CHIMIQUE DES PRODUITS DE FRANCE LTEE.... } RESPONDENT.

Practice—Trade-mark—Petition to expunge—Motion to amend by joining action for infringement.

Held: That where a petitioner has filed a petition in this court asking that a trade-mark be expunged, he should not be permitted to amend his petition by joining thereto a claim for infringement.

APPLICATION by the petitioner to amend his petition.

Ottawa, September 18, 1925.

Application now heard before the Registrar in Chambers.
R. S. Smart for petitioner.
Auguste Lemieux, K.C., for respondent.

The Registrar, now this 24th day of September, 1925, delivered judgment.

This was a summons issued on the 15th day of September, 1925, and returnable on the 18th day of said month for an order to show cause why the petitioner should not have leave to amend his petition as filed, by adding a new paragraph numbered 14 to the petition, and amending the prayer of the petition as set forth in the copy of the amended petition attached to the summons now on file.

Shortly stated, the object of the application is to obtain an order authorizing the amendment of the petition; first, to include a claim for the infringement of petitioner's trade-mark, with the usual remedy sought in infringement cases; and secondly, that the petition may be amended by adding the following paragraph thereto namely,

That the said entry made at folio 34814 of Trade-Mark registered No. 155, should be varied by expunging the word "Thermogene" therefrom.

* * * * * *

The authorities cited and relied upon by counsel for petitioner did not appear to me to support the application on its merits. Even if it were open to the petitioner under the practice of the court to add a claim for infringement to a petition seeking to expunge a trade-mark, I do not feel that where the issues have been joined between the parties upon the proceedings to expunge, for a lengthy period, in this

1925

THE THERMOGENE LTD. OF HAYWARD'S HEATH v. LA COMPAGNIE CHIMIQUE DES PRODUITS DE FRANCE LIMITÉE

case over five months, it would be fair to the respondent to require him now to meet a new and entirely distinct cause of action. The tardiness of the application does not strengthen its equity. My view in this behalf seems to be supported by such cases as *Saccharin Corp.* v. *Wild* (1). But my disinclination to grant the application does not rest wholly or indeed chiefly upon the above considerations. Rule 38 of the Practice provides for a joinder, in infringement actions instituted by statement of claim, of an application to have any entry in any registry of trade-marks, etc., expunged, varied, or rectified. But the converse is not the case; there is no express provision in the rules authorizing the joinder of an action or claim for infringement of a trade-mark in a proceeding by petition to expunge the same. In my view the maxim *expressum facit cessare tacitum* applies in the circumstances, constraining me to hold that where the court has not seen fit to provide expressly for the converse right or privilege to that authorized by the terms of rule 38, no such application as that before me should be entertained. I therefore order that the summons in so far as it prays for an order to permit the petitioner to join a claim for infringement to the petition to expunge, must be dismissed.

Dealing with the summons in so far as it seeks to obtain an order authorizing the petitioner to amend his petition by adding a paragraph to the prayer of the petition to the effect that the entry of the trade-mark should be varied by expunging the word " Thermogene " therefrom, I think that the application *quoad hoc* should be allowed, and I so order. The respondent will be at liberty, if so advised, to amend its statement of objections to meet the prayer of the petition so amended; and I so order. * * * * *

An appeal was taken from this decision of the Registrar to a Judge in Chambers, and on the 29th day of September, 1925, the same was heard before the Honourable Mr. Justice Audette, and the decision of the Registrar was affirmed and the appeal dismissed, the learned judge observing that it would not be proper, under the circumstances, to permit the amendment asked.

Judgment accordingly.

(1) [1903] 1 Ch. D. 410 at p. 422.