GENERAL CIGAR COMPANY LIMITED..PLAINTIFF;

AND

ROMEO DESLONGCHAMP ET AL.....DEFENDANTS.

1927
Feb. 4.
May 2.

Trade-Marks—Expunging—Deception—General feature.

Plaintiff was the owner of a specific trade-mark to be applied to the sale of cigars, etc., consisting of a label containing a picture of General Stonewall Jackson and the words "Stonewall Jackson", the signature of "H. Jacobs & Co.," a printed impression of a five pointed star in a circle with the words "Stonewall Jackson, H. Jacobs & Co. Established 1858" in a ring around such circle, and also a second trade-mark used with respect to cigars and consisting of a ribbon inserted through the end of the cigar, at the tip, from side to side. The defendants own a trade-mark for the name "Madelon" and also an industrial design of a "cigare, traversé longitudinalement par un ruban dont les extrémités dépassent légèrement chaque bout du cigare." It is contended by plaintiff that the defendants infringe its trade-mark by the use of a ribbon in its cigars, as described in its industrial design.

Held, that as the main feature of each trade-mark was the name "Stonewall Jackson" and "Madelon" respectively, and as the use of a ribbon in the particular manner used by each could only be called a secondary feature of the trade-mark, the two marks were perfectly distinct and not liable to create deception, and the plaintiff's action was dismissed.

ACTION to restrain the defendants from infringing the plaintiff's trade-mark.

1927

GENERAL CIGAR CO., LTD. v. DESLONG-CHAMP.

The action was tried before the Honourable Mr. Justice Audette, at Montreal.

H. J. Hague, K.C., and *H. M. Hague* for plaintiff.

P. St. Germain, K.C., for defendants.

The facts are stated in the reasons for judgment.

AUDETTE J., this 2nd day of May, delivered judgment.

The plaintiff company is the owner, by assignment, of two Canadian Specific trade-marks.

The first one is a specific trade-mark of the 25th May, 1907, (Exhibit No. 1)

to be applied to the sale of cigars, cigarettes and tobacco; and which consists of a label containing a picture of General Stonewall Jackson, and the words: "Stonewall Jackson", the signature of "H. Jacobs & Co."; a printed impression of a five pointed star in a circle, with the words: "Stonewall Jackson, H. Jacobs & Co. Established, 1858" in a ring around such circle.

The second specific trade-mark, owned by the plaintiff, is one

to be applied to the sale of cigars; and consists of a ribbon inserted through each cigar from side to side,

as shown in exhibit No. 2.

Then the defendants, on the 9th August, 1920, registered as a Specific Trade-Mark the name "Madelon" to be used in connection with the sale of cigars.

And, on the 25th July, 1926, they also registered an Industrial Design of a:

CIGARE

traversé longitudinalement par un ruban dont les extrémités dépassent légèrement chaque bout du cigare,

tel qu'il appert par le patron y attaché.

Now, the present action is to restrain the defendants from an alleged infringement, by the use of the said industrial design on the plaintiff's second trade-mark of a ribbon inserted through the end of the cigar from side to side.

Each party has a trade-mark by name: "Stonewall Jackson" and "Madelon." The former has been in existence for a great many years and is well known, commending as it does very large sales which are on the increase. The word "Madelon" is in connection with a cigar of comparatively recent years. There is no controversy with respect to the use of these names, which as I may say are the main and paramount feature of their trade-marks; but

the conflict arises with respect to the use on the one hand of a bit of green and yellow ribbon of about half an inch in length by one fifth of an inch in width, running diametrically from side to side of the small end of the cigar;—and, on the other hand, as regards the use of a red, white and blue cotton ribbon of about the same width as the other, but running longitudinally the full length of the cigar and protruding slightly at each end, for a length of nearly five inches. The name of each party is respectively impressed upon the ribbon itself. The two cigars are somewhat different from one another—not being of quite the same length. The peg-top cigar, spoken to at trial, has a small piece of wood placed in identical position with the Stonewall Jackson.

Both cigars bear some ribbon, but in such a different manner, that so far as that feature is concerned, they have not the most remote resemblance to one another. Is it to be said that because the plaintiff's cigar is so sold with a half inch bit of ribbon, that the door to other makers will be closed, and that no more cigars can be sold with any kind of ribbon whatsoever, however differently used or disposed? Will the plaintiff under the circumstances acquire thereby the exclusive use of ribbon or ribbons in the sale of cigars? This is an unsound proposition. Stating the contention is answering it. That is no trade-mark; it would amount to trenching on the rest of the trade.

The essential particular of the plaintiff's trade-mark has not been imitated. The two marks are quite different.

The main feature of each trade-mark is the name. In one case the well-known name of "Stonewall Jackson" and in the other case "Madelon"; and the use of the ribbon, in the particular manner by each party, can only be called a secondary feature of the trade-mark used in the trade.

We are told that the plaintiff introduced the ribbon because it had been found out that some unscrupulous dealers were placing other cigars in the Stonewall Jackson boxes, and it was thought if the cigar bore some mark of identification it would be better. Hence the introduction of the plaintiff's ribbon.

The defendants received complaints that their cigars did not draw; they were too tightly rolled. That affected

1927

GENERAL CIGAR CO., LTD. v. DESLONG-CHAMP.

Audette J.

30,000 cigars. They then devised to pass a ribbon through the whole length, thereby opening, so to speak, a flue which would overcome the difficulty, and it did.

The special and particular use and arrangement of the ribbon in each case is different and has not been copied or used to create deception.

Distinctiveness is of the very essence and is the cardinal requirement of a trade-mark, which is used to distinguish the goods of one trader from the goods of all other traders. Distinctiveness means adoption to distinguish. Sebastian 5th ed. 55. The trade-mark does not lie in each of its particular parts, but "dans son ensemble." It is the appeal to the eye which is to be considered, and which must determine the difference or similarity in the "get up" of each cigar. And in the present case the eye could not be deceived in comparing two articles so entirely different in their "get up."

I find the two marks perfectly distinct and not liable to create deception. Having so found it is unnecessary to pass upon the other questions raised in this controversy.

There will be judgment, dismissing the action and with costs.

Judgment accordingly.

Solicitors for plaintiff: *Hague & Hague.*

Solicitors for defendants: *St. Germain, Guerin & Raymond.*